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UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

In Re

ACACIA MEDIA TECHNOLOGIES CORPORATION

Case No. C-05-01114JW

ROUND 3 DEFENDANTS' REPLY MEMORANDUM IN SUPPORT OF THEIR MOTIONS FOR SUMMARY JUDGMENT OF INVALIDITY UNDER 35 U.S.C. § 112 OF THE '992, '863 AND '702 PATENTS

Date: TBD
Time: TBD
Courtroom: 8, 4th Floor
Judge: Honorable James Ware

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I. INTRODUCTION

The papers Acacia submitted in opposition to the Round 3 Defendants' ("Defendants") motions are voluminous – there is no denying that. The number of pages it submitted, however, does not correlate in any way to the number of core issues actually in dispute. For example, Acacia does not contend that any of the components that make up the claimed "transmission system" and "receiving system" (also referred to as a "reception system" in the specification)[1] were available off-the-shelf in January of 1991, the filing date of U.S. Patent No. 5,132,992 (the "'992 patent").[2] Nor can or does Acacia allege that the specification provides any details (the hardware and/or software) regarding what any one of these components actually ***is***. Instead, Acacia relies on a handful of fundamentally erroneous legal propositions which it says both (i) excuse the inventors' failure to describe any details about the transmission system and reception system that constitute their invention; and (ii) permitted the inventors to claim things that were not their invention. Its opposition papers are so voluminous only because Acacia repeats these misstatements of law *ad nauseam*. Once they are corrected, there is very little left to Acacia's opposition, and certainly no genuine issues of material fact. The following are the most often repeated of Acacia's mistakes.

First, Acacia says that all the Yurt specification needs to do to comply with the written description requirement is demonstrate that the inventors were "in possession" of each transmission system and reception system component. The inventors demonstrated such possession, Acacia says, by listing the capabilities they wanted each such component to have. Acacia is wrong on all counts. A demonstration that the inventors are in "possession" of the invention is ***not*** the ***test*** for compliance with the written description requirement; it is the ***purpose*** for having a written description requirement. To comply with the written description requirement, inventors are required to describe the "detailed identity" of their invention – in this case, the detailed identity of what every transmission system and reception system component ***is***. It is only by describing the detailed identity of the invention that an inventor can demonstrate that he was in "possession" of it; a mere recitation of the capabilities the inventor would like his novel device to have does not suffice. Because there is and can be no dispute that the Yurt specification does not provide a description of the "detailed identity" of any of the transmission system or reception system components, the asserted claims lack written description as a matter of law.

---

[1] The Court construed "receiving system" and "reception system" to be synonymous. Both terns refer to the receiving system depicted in Fig. 6. (3rd CCO at 11:21-22; 6th CCO at 11:19-22.) The Court's various claim construction orders are abbreviated herein as "__ CCO." (*See* Mot. at 3 n.3.)

[2] As used herein, "'863 patent" refers to U.S. Patent No. 5,550,863, and "'702 patent" refers to U.S. Patent No. 6,144,702. (*See* Mot. at 1 n.1.) As all five Yurt patents are substantively identical, all citations to the patents are to the columns and lines in the '992 patent, unless otherwise specified.

Second, Acacia extensively relies on its belief that if the (coined) name of a component or the functions it is supposed to perform were included in the originally-filed disclosure or originally-filed claims, that alone is sufficient to comply with the written description requirement. Again, Acacia is wrong. The standards for compliance with the written description requirement are the same for originally-filed claims as they are for all other claims, and the law is clear that inclusion of an inadequate description in the original disclosure or claims does not excuse the failure to comply with 35 U.S.C. § 112 ("§ 112").

Third, even though the inventors (improperly) attempted to define the components of the claimed "transmission system" and "receiving system" only by reference to what they are supposed to be capable of doing, Acacia asserts that unless a claim expressly requires a claimed component to perform its assigned functions, those functions were "not claimed" and the inventors were not obligated to disclose a component capable of performing them. This makes no sense. Because the inventors attempted to define these components only by reference to what they do, that definition must carry over into the claims if the claims are to have any meaning at all. Otherwise, the public would have no hint as to what is covered by the claims and what is not, because the structures of these allegedly novel components were not disclosed.

Fourth, Acacia believes that if the ***use*** of any transmission system (or reception system) capability is optional, a transmission system (or reception system) that has that capability is an optional embodiment that the inventors were not required to describe. Acacia is wrong for numerous reasons. First, because users of the transmission system (or reception system) have the option to use it in a certain way, the transmission system (or reception system) ***must*** have the capability to be used in that way. If a patent to a car disclosed that the car can be driven forward or backward at the option of the user, that would not mean that the car need not have the capability of being driven forward. A description of a car that can be driven forward would still have to be provided because the user has the option to use the car that way.

Acacia also overlooks the fact that § 112 law requires the scope of both the written description and enabling disclosure to be coextensive with the scope of the claims. Thus, even if the specification did disclose such optional embodiments, they would still have to be adequately described and enabled because the asserted claims are broad enough to cover those embodiments.

Fifth, Acacia relies on the conclusory and unsupported opinion of its expert, Mr. Weiss, that the inventors were "in possession" of each "transmission system" and "reception system" component, and that each such component could have been made without undue experimentation, as evidencing compliance with both the written description and enablement requirements. Such reliance is misplaced as a matter of law because:

> (i) "possession" is not the correct legal standard for compliance with the written description requirement. Mr. Weiss's declaration must disregarded because he relied on Acacia's misstatements of written description law;
>
> (ii) in view of the fact that the "transmission system" and "reception system" are the novel aspects of the invention, § 112 required that an enabling disclosure be provided *in the specification*. Acacia cannot justifiably rely on Mr. Weiss's opinion that skilled artisans had the ability to make them. Moreover, this opinion is not relevant to the written description inquiry, which requires a description of what a claimed component ***is***. A starting point for additional research and development is legally insufficient; and
>
> (iii) Mr. Weiss's opinions are conclusory and unsupported. He does not identify, by manufacturer name and model number or otherwise, any off-the-shelf device in 1991 that could have functioned as any of the components of the "transmission system" or "reception system." Nor does he explain specifically how any particular off-the-shelf device would be modified to function as such a component, or exactly how much time and effort such modification would take. Nor does he provide the "detailed identity" of any such component as he envisions it. Nor are the vague descriptions of the unidentified devices he claims to have worked with at various times in his career probative of anything, because he does not allege that these devices could function as the components of the "transmission system" or "reception system," and because he does not provide any product manuals or other corroboration specifically identifying

> these products, what they did or how they worked. His naked conclusions that the inventors were "in possession" of the "transmission system" and "reception system," and that those systems could have been made without undue experimentation, should be disregarded *in toto*.

Sixth, Acacia believes it is permissible to claim more broadly than the invention disclosed. It is not. Period. If a species is disclosed, for example, and the inventor wants to claim a genus, the inventor must include disclosure sufficient to teach that the entire genus is embraced by his invention.

Seventh, Acacia believes there is a separate written description requirement that applies only to computer-related inventions. Novel devices implemented with a computer, Acacia says, can be described only by reference to the capabilities the inventors wish those devices to have. That is simply not the law. The standards for compliance with the written description requirement are the same for computer-related inventions as they are for all other inventions.

Finally, Acacia believes the Court can remedy virtually every written description, enablement and indefiniteness problem either by judicially rewriting the claims to comport with what is disclosed, or by judicially adding disclosure to the specification. For example, under the guise of "inherency," Acacia asks the Court to judicially modify the specification: (i) to add claimed embodiments that were not disclosed; (ii) to add undisclosed components to the "transmission system" and "reception system"; and (iii) to add description about the allegedly novel "transmission system" and "reception system" that the inventors themselves did not provide. It also repeatedly asks the Court to judicially rewrite claims to cure their § 112 deficiencies. The Federal Circuit, as recently as its *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005), prohibited such judicial rewriting of claims. Furthermore, 35 U.S.C. § 132 precludes the judicial introduction of new matter into the specification.

The introductory discussion above responds to the bulk of Acacia's nearly 200-page opposition submission. Of course, Acacia does have other arguments that contradict the specification, contradict the claims, contradict the Court's claim construction Orders, contradict the stipulations into which it entered, contradict Mr. Weiss's testimony, contradict its own prior arguments to this Court, and/or contradict other arguments it makes in the very same opposition. All of these arguments are irrefutably rebutted below based on the law and the intrinsic record. There are no genuine issues of material fact in dispute.

All of Defendants' motions for summary judgment of invalidity under § 112 should be granted.

II. THE COURT'S PRIOR INDEFINITENESS RULINGS PROVIDE COMPELLING REASONS TO GRANT DEFENDANTS' MOTIONS

Acacia begins its opposition (Opp'n at 4:8-6:6)[3] with a last-ditch attempt to persuade the Court not to consider Defendants' motions at all, its *third* such attempt since Defendants advised Acacia on March 28, 2008 which motions they intended to make.[4] The Court denied Acacia's last two pleas for a stay of execution, and this latest request should be denied as well.

Although it was admittedly unable to find any supporting cases, Acacia urges on this Court the novel proposition that because all of the asserted claims have already been adjudged indefinite, this Court "cannot, as a matter of law, analyze any enablement or written description issues." (Opp'n at 4:10-12.) Acacia's logic is that indefinite claims cannot be "properly construed," and having a "properly construed claim" is a "prerequisite" to a written description and enablement determination. (*Id.* at 5:1-2.) The reason Acacia was unable to find any case law to support that proposition, of course, is that all of the relevant cases refute it.

In *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, for example (a case Acacia itself relies on), the Federal Circuit affirmed ***both*** the lower court's "contingent determination that the '933 patent is invalid under § 112 ¶ 1 [lack of written description]," 314 F.3d 1313, 1320 (Fed. Cir. 2003),[5] and its finding that the ’933 patent is “invalid for indefiniteness.” *Id.* at 1342. The fact is, the courts have squarely rejected Acacia’s proffered rule that claims must first be “properly construed” before a written description analysis can be performed. If construing claims will not assist with the written description analysis, claim construction need not be performed before invalidating the claims for failure to comply with the written description requirement. *Univ. of Rochester v. G.D. Searle & Co.*, 249 F. Supp. 2d 216, 221 n.2 (W.D.N.Y. 2003) (rejecting patentee’s argument “that the Court must first construe the claims . . . before deciding the written-description issue” because “a court need not decide the meaning of all disputed claims if the construction of the claims would have no bearing on the invalidity analysis”), *aff’d*, 358 F.3d 916 (Fed. Cir. 2004).

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[3] As used herein, "Opp'n" refers to Plaintiff Acacia Media Technologies Corporations' Memorandum of Points and Authorities in Opposition to Defendants' Motion for Summary Judgment of Invalidity Under 35 U.S.C. § 112 of the '992, '863 and '702 Patents, docket no. 323, filed Dec. 15, 2008.

[4] The procedural history regarding Acacia's first two attempts are set forth in docket nos. 304 and 309.

[5] *See Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 126 F. Supp. 2d 69, 155-56 (D. Mass.
(continued...)

Not only is there no prohibition against finding a claim to be invalid both because it is indefinite and because it is not adequately described and/or enabled, common-sense would dictate that if a coined term in a claim is indefinite, the term cannot *as a matter of law* be adequately described in the specification. If the term was adequately described in the specification, there would be no ambiguity as to what it means and it would not be indefinite. Not surprisingly, courts have recognized this common-sense proposition. *See, e.g.*, *Harrah’s Entm’t, Inc. v. Station Casinos, Inc.*, 321 F. Supp. 2d 1173, 1181 (D. Nev. 2004) (“the court agrees that the term theoretical win profile is indefinite” and “[a]ccordingly, the written description is inadequate as a matter of law”).

Because the cases on point do not support Acacia’s assertion that a court cannot entertain written description or enablement motions directed to indefinite claims, Acacia instead relies by analogy on *Honeywell Int’l, Inc. v. ITC*, 341 F.3d 1332 (Fed. Cir. 2003), which it suggests holds that a court cannot consider whether or not indefinite claims are infringed. (Opp’n at 5:10-15.) Even if that was the holding of *Honeywell*, of course, it would have no applicability here. The instant motions do not involve noninfringement. As discussed above, indefinite claims can be, and in certain instances may be required to be, adjudged as also failing to comply with the written

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[5] (...continued)
2001) (finding, in the alternative, “that all these asserted claims of the ‘933 patent are invalid for lack of written description”).

description and/or enablement requirements. In this case, for example, the Court determined that "identification encoder" is indefinite because, *inter alia*, it is not adequately described in the specification. (2nd CCO at 16:26-17:4.) Therefore, "written description is inadequate as a matter of law." *Harrah's*, 321 F. Supp. 2d at 1181.

In fact, however, *Honeywell* does not preclude a court from finding that an indefinite claim is not infringed. What prevented such a finding in *Honeywell* was that the very claim element held to be indefinite was "critical" to determining whether or not there was infringement. 341 F.3d at 1340. In other words, because the critical claim element was insolubly ambiguous, it was impossible to ascertain if it was satisfied by the accused product. The same would not be true if one element of a claim was indefinite and a *different* claim element was found not to be satisfied by the accused device, and nothing in *Honeywell* precludes a court from holding that a claim is both indefinite and not infringed in that circumstance. Certainly, nothing about the Court's determination that "sequence encoder" and "identification encoder" are indefinite precludes or, for that matter, affects in any way the Court's ability to determine that *other* claim limitations (*e.g.*, *other* components of the claimed "transmission system," such as the "source material library") fail to satisfy the written description and enablement requirements.

For all of these reasons, the Court should rule on Defendants' motions.

III. ACACIA FUNDAMENTALLY MISUNDERSTANDS THE WRITTEN DESCRIPTION REQUIREMENT

Acacia's opposition is largely predicated on a number of fundamental misunderstandings about the legal standards for compliance with the written description requirement of § 112. Each of Acacia's misstatements of the law of written description is separately discussed and corrected below. Acacia's extensive reliance on these misstatements renders large portions of its opposition irrelevant, leaving Defendants' written description motions substantially unopposed.

A. The "Detailed Identity" Of The Claimed Subject Matter Must Be Disclosed To Satisfy The Written Description Requirement – "Possession" Is Not The Legal Standard, And A Functional Description Is Insufficient

Acacia's opposition to Defendants' written description motions is predicated on its incorrect belief that the test for compliance with the written description requirement is whether the specification conveys to a skilled artisan that the "inventors were in possession of the invention (*i.e.*, the claimed subject matter)." (Opp'n at 17:5-18 (citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991)).) Although demonstrating that the inventors were in "possession" of the invention is the "purpose" of the written description requirement (*see, e.g., Vas-Cath*, 935 F.2d at 1563-64), the Federal Circuit has expressly clarified that "possession" is ***not*** the operative legal test. *See Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 323 F.3d 956, 969 (Fed. Cir. 2002) ("A showing of 'possession' is ancillary to the statutory mandate . . . and that requirement is not met if, despite a showing of possession, the specification does not adequately describe the claimed invention."). Rather, as explained in Defendants' opening brief, "[t]he disclosure must allow one skilled in the art to ***visualize or recognize the identity*** of the subject matter purportedly described." *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 923 (Fed. Cir. 2004) (quoting *Enzo*, 323 F.3d at 968 (emphasis added)). Indeed, what must be visualized or recognized is "the ***detailed identity***" of the claimed subject matter. *Rochester*, 358 F.3d at 923 (emphasis added).[6]

This misunderstanding of the written description requirement explains the false comfort Acacia repeatedly takes in its belief that merely describing claimed objects by the functions the inventor wishes them to perform satisfies the written description requirement. (Opp'n at 3:1-5, 8:19-21, *passim*.) The Federal Circuit has pointedly rejected this proposition. Where, as here, the claimed "transmission system" and "receiving system" and their constituent components are not known in the prior art (*i.e.*, are not available "off-the-shelf"), the "detailed identity" test is not satisfied merely by describing the functions those allegedly novel devices are supposed to perform. Rather, for

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[6] Although "the applicant does not have to utilize any particular form of disclosure to describe the subject matter claimed," *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1122 (Fed Cir. 2008), and can employ "such descriptive means as words, structures, figures, diagrams, formulas, etc." *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997), the "detailed identity" requirement nonetheless must be met. *See Rochester*, 348 F.3d at 922-23. Such "structures, figures, diagrams, formulas, etc." must "***fully set forth*** the claimed invention." *Lockwood*, 107 F.3d at 1572 (emphasis added).

"functional characteristics" to "meet the written description requirement," there must be "a known or disclosed correlation between function and structure . . . ." *Rochester*, 358 F.3d at 925 (quoting *Enzo*, 323 F.3d at 964). *See also, e.g., In re Wallach*, 378 F.3d 1330, 1335 (Fed. Cir. 2004) (a "functional description can be sufficient only if there is also a structure-function relationship known to those of ordinary skill in the art"); *Noelle v. Lederman*, 355 F.3d 1343, 1346 (Fed. Cir. 2004) (functional claims to antibodies were insufficiently described absent known or disclosed structure-function relationship with antigens to which they bind); *Regents of Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1568 (Fed. Cir. 2007) ("A definition by function, as we have previously indicated, does not suffice to define the genus because it is only an indication of what the gene does, rather than what it is.")

In sum, § 112 requires that the specification describe the ***detailed identity*** of what a claimed structure ***is,*** not merely what it ***does***. *Id.*

B. The Standards For Compliance With The Written Description Requirement Are The Same For Computer-Related Inventions As They Are For All Other Inventions

Acacia attempts to excuse the Yurt patents' total failure to provide any disclosure as to what the components of the claimed "transmission system" and "receiving system" ***are*** by arguing that such disclosure is not necessary for computer-related inventions. In other words, according to Acacia, all one need do in a patent specification is make up a name for a component represented only by a rectangle in a figure, ascribe to that component whatever wished-for functions the inventor wants to ascribe to it, and the written description requirement is satisfied so long as the function is to be accomplished with the aid of a computer. As Acacia would have it, the simple statement that the invention is a time-machine built with a computer would satisfy the written description requirement. That is simply not the law. The standards for compliance with the written description requirement are the same for computer-related inventions as they are for all other inventions.

In support of its position that claimed computer-related devices can be adequately described solely by listing the capabilities the inventors wish them to have, Acacia points to sections from the November 1989 edition of the Manual of Patent Examining Procedure ("MPEP") and refers to its alleged "express approval of the description of computer art inventions in the form of block diagrams describing the functions of various components." (Opp'n at 8:17-9:18; 12/15/08 Decl. of Alan P. Block in Supp. of Mem. in Opp'n to Round 3 Defs.' Mots. for Summary Judgment ("Block Decl.") Ex. 2, docket no. 324-2, at 11.) As MPEP § 2106.01 relied on by Acacia expressly says, however, "***[t]he requirements for sufficient disclosure of inventions involving computer programming is the same as for all inventions sought to be patented***." (Block Decl. Ex. 2, docket no. 324-2, at 17 (emphasis added).) As described in Section III(A) above, a description only of the functions a claimed device is supposed to perform does not comply with the written description requirement, and as the MPEP states, that is just as true for computer-related devices as it is for other devices and structures.

In fact, far from providing some blanket sanction of the use of block diagrams, the MPEP cautions that a critical and skeptical review of such block diagrams be performed to assure compliance with the written description requirement. The MPEP section Acacia relies upon even sets forth a number of tests that should be applied to such block diagrams, any one of which can alone demonstrate a failure to comply with § 112:

> "[T]he examiner should initiate a factual analysis of the system by focusing on each of the individual block element components. More specifically, such an inquiry should focus on the diverse functions attributed to each block element as well as the teachings in the specification as to how such component could be implemented."
>
> "[T]he examiner should determine whether certain of the hardware or software components depicted as block elements are themselves complex assemblages which have widely differing characteristics and which must be precisely coordinated with other complex assemblages."
>
> "[E]ven if the applicant has cited prior art patents or publications to demonstrate that particular block diagram hardware or software components are old, it should not always be considered as self evident how such components are to be interconnected to function in a disclosed complex manner."
>
> "[I]n a block diagram disclosure of a complex claimed system which includes a microprocessor and other system components controlled by the microprocessor, a mere reference to a prior art, commercially available microprocessor, without any description of the precise operations to be performed by the microprocessor, fails to disclose how such a microprocessor would be properly programmed to either perform any required calculations or to coordinate the other system components in the proper timed sequence to perform the functions disclosed and claimed."

(*Id.* at 17-18.) For the reasons set forth in Sections VII and VIII below, both the block diagram of Fig. 2[7] (the claimed "transmission system") and Fig. 6 (the claimed "reception system") of the Yurt patents are inadequate under all of these tests. For example, (i) the Yurt specification attributes many "diverse functions . . . to each block element" without providing any "teaching" whatsoever as to how to implement those elements; (ii) the Fig. 2 and Fig. 6 "block elements are themselves complex assemblages which have widely differing characteristics and which must be precisely coordinated with other complex assemblages," yet the specification contains no description of these elements or how they coordinate with each other; (iii) "it [cannot] be considered as self evident how such components are to be interconnected to function in [the] disclosed complex manner," because no structure is disclosed for any of the allegedly novel components of Fig. 2 or Fig. 6; and (iv) the Yurt specification contains no "description of the precise operations to be performed by the microprocessor [and] fails to disclose how such a microprocessor would be properly programmed to either perform any required calculations or to coordinate the other system components in the proper timed sequence to perform the functions disclosed and claimed."

Nor does *In re Hayes Microcomp. Prods., Inc. Patent Litig.*, 982 F.2d 1527 (Fed. Cir. 1992), stand for the proposition proffered by Acacia that there is a different written description requirement for "computer-related patents" that involve the "disclosure of a microprocessor capable of performing certain functions . . . ." (Opp'n at 18:15-24.) In *Hayes*, which preceded the Federal Circuit's decisions in *Rochester* and *Enzo,* the court held that disclosure of a microprocessor and its functions was sufficient because one skilled in the art "would know how to program a microprocessor to perform the necessary steps ***described in the specification***." 982 F.2d at 1534 (emphasis in original). The specification described the "**specific** function(s)," *id.* at 1534, that the microprocessor was to perform – a step-by-step software algorithm.[8] All that was left to do was to translate that algorithm from English into computer code. The detailed description of the steps of the algorithm therefore ***did*** "correlat[e]" with a known "structure," *Rochester*, 358 F.3d at 925, because skilled artisans could immediately visualize how a computer instruction written in English would look when translated into a programming language.[9]

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[7] Fig. 2 refers to both Fig. 2a and Fig. 2b.

[8] The patent at issue in *Hayes* disclosed ***how*** a modem could determine whether it should switch from normal (transparent) mode to a command mode, not simply the ***goal*** of achieving that function. To detect the escape sequence that would constitute the

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Finally, Acacia argues that the holdings in *Enzo* and *Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361 (Fed. Cir. 1997), are limited to the art of biotechnology, and that in *Enzo*, the "Court emphasized that its holding cannot apply to other arts." (Opp'n at 12:12-14, 20-22.) Nothing could be further from the truth. In fact, the Federal Circuit has expressly rejected the argument that "*Fiers . . . Lilly*, and *Enzo* are all distinguishable because they were limited to DNA-based [biotechnology] inventions." *Rochester*, 358 F.3d at 925. That these decisions involved DNA-based inventions, *Rochester* ruled, was "irrelevant" and provided "no reason for the rule to be any different when non-genetic materials are at issue." *Id*. While the type of inquiry that must be performed to determine if a specification discloses the "detailed identity" of the invention may vary depending on the nature of the invention, *Enzo*, 323 F.3d at 963 (cited by Acacia, Opp'n at 12:20-24), such an

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[8] (...continued)
instruction to change modes, the specification said that "a predetermined sequence of data bits is the escape command accepted at port 50 . . . . The preferred embodiment of the present invention must experience one full second of no data being provided as input to data port 50, followed by a predetermined escape command, followed by a second full second of no data in order to interpret that input as the escape sequence." *Id*. at 1535.

[9] As explained in the *In re Sherwood* case relied on by Acacia (Opp'n at 26:5-20), to require disclosure of software code when a step-by-step software algorithm is disclosed would be to unnecessarily "require disclosure of the menial tools [k]nown to all who practice th[e] art." 613 F.2d 809, 816-17 (C.C.P.A. 1980). Translating a "complete thought (as expressed in English and mathematics, i.e., the known input, the desired output, ***the mathematical expressions needed [to convert the input to the output] and the methods of using those expressions***) into the language a machine understands is necessarily a mere clerical function to a skilled programmer." *Id.* at 817 n.6 (emphasis added). Put differently, the descriptions of the input and the desired output without the "mathematical expressions" needed to convert one to the other is not sufficient.

inquiry must always be done, irrespective of the nature of the invention.[10]

C. Disclosure In The Originally Filed Specification Or Claims Does Not Alone Constitute Compliance With The Written Description Requirement

Acacia argues throughout its opposition that referencing a claimed component by name in the originally filed specification or claims, in conjunction with whatever little the original specification says about the desired capabilities of that component, constitutes its own written description of that component. Again, Acacia is incorrect. Disclosure of a component in the originally filed specification or claims ***does not*** constitute its own written description. As the Federal Circuit has said, the standard for compliance with the written description requirement is the same for claim terms that appear in the originally filed specification or claims as it is for all other claim terms, and the description of a claimed component in the originally filed specification must satisfy all of the standards for compliance with the written description requirement: "If a purported description of an invention does not meet the requirements of the statute, the fact that it appears as an original claim or in the specification does not save it. A claim does not become more descriptive by its repetition, or its longevity." *Enzo*, 323 F.3d at 968-69.

D. The Specification Must Adequately Describe (And Enable) The Full Scope Of A Claim, Including Optional Embodiments Within The Scope Of The Claim

The Yurt specification says that the claimed "transmission system" and "reception system" and their constituent components are capable of performing many functions. Even though the asserted claims are certainly broad enough to cover embodiments of transmission systems and receiving systems that perform most (if not all) of these functions, Acacia says the inventors were not required to adequately describe and enable devices capable of performing them. Instead, according to Acacia, the inventors were only required to adequately describe and enable devices that perform the specific functions that the claims themselves set forth as being performed. (Opp'n at 28:4-23; 73:2-11.) Acacia does not cite any cases in support of its assertion, because the law is to the contrary.

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[10] *Enzo* does say that a functional description of genetic material may be sufficient to satisfy the written description requirement. (Opp'n at 12:24-13:2.) However, that is only true when the description of the function permits visualization of a known, existing gene. *Enzo*, 323 F.3d at 964. A description of only the function is not a sufficient written description of a gene unless a gene is known to be available off-the-shelf to perform that function.

It is well settled that the specification must describe and enable the "full breadth" (or "full scope") of the claims. *See, e.g., LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336, 1345-46 (Fed. Cir. 2005); *ICU Med., Inc. v. Alaris Med. Sys.*, 2009 U.S. App. LEXIS 5271, at *12-19 (Fed. Cir. Mar. 13, 2009) (claims not limited to valves having spikes do not comply with the written description requirement because the "specification describes only medical valves with spikes"); *see also, e.g., Int'l Automated Sys. v. Digital Persona, Inc.*, 565 F. Supp. 2d 1276, 1306 (D. Utah 2008) (finding claims invalid "because the specification does not provide a written description of the full scope of the claimed invention"). When claim language is broad enough to cover different embodiments (*e.g.*, when disclosed embodiments would infringe the claim, even though the claim may not be limited to those embodiments), including so-called "optional" embodiments, the specification must contain a legally sufficient written description and enabling disclosure of those embodiments. *See, e.g., LizardTech*, 424 F.3d at 1346. Thus, for example, the "detailed identity" of a device capable of performing optional functions must be described in the specification if the claim is broad enough to cover such an optional embodiment, even if the claim does not require that those optional functions be performed and is not limited to the optional embodiment.

The facts and holding of *LizardTech* illustrate Acacia's misunderstanding of the law. In *LizardTech*, the claim was broad enough to encompass "all ways" of performing a particular process (DWT-based compression). 424 F.3d at 1344. However, the "specification provide[d] only one method of creating a seamless DWT," by "maintain[ing] updated sums of DWT coefficients," and did not disclose other methods. *Id.* The Federal Circuit ruled that the claims were neither adequately described nor enabled, because the disclosure did not describe "how to make a seamless DWT generically" and a skilled artisan "would not understand LizardTech to have invented a method for making a seamless DWT, except by 'maintaining updated sums of DWT coefficients.'" *Id.* at 1345. If Acacia's view of the law was correct, the LizardTech patent would still be valid, because the claim did not ***require*** performance of the undisclosed methods. However, because the claim was ***broad enough to cover*** those undisclosed methods, the Federal Circuit found it to be invalid. The scope of the claim was not coextensive with the scope of the written description as required by § 112. Neither are the asserted claims of the Yurt patents.

Finally, the fact that the specification must sufficiently describe "optional" embodiments falling within the scope of the claims does not, as Acacia suggests (Opp'n at 28:13-19), violate the principle that limitations should not be imported from the specification into the claims. If an optional capability were imported into the claim, the claim could not be infringed by devices that do not have that capability. That is not Defendants' position. Defendants' position is that unless a claim expressly excludes what the specification says is an optional embodiment of a claimed component, such optional embodiments are within the scope of the claim (even though the claim can be infringed by other embodiments as well), and must therefore be adequately described.[11]

E. Narrow Embodiments Do Not Adequately Describe Broad Claims Unless The Specification Provides Additional Disclosure That Teaches The Full Breadth Of The Invention

Acacia complains that Defendants are being overly critical of the Yurt specification because "there is no requirement that the original disclosure describe every conceivable embodiment of the claimed invention to comply with the written description requirement," and because "reciting claims that are more broad than the embodiments described in the specification is permissible, and is in fact, common." (Opp'n at 21:3-4, 8-9.) Unfortunately for Acacia, the Yurt patents do not even provide sufficient written description of the embodiments disclosed, much less a legally sufficient description of other, non-disclosed embodiments. For this reason alone, these principles are largely unavailing to Acacia.

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[11] *Vas-Cath*, 935 F.2d at 1563, which Acacia cites for the proposition that only the explicitly claimed functions to be performed by the claimed structure need be described (*e.g.*, Opp'n at 32:4-19), says no such thing. Similarly, in *Regents of Univ. of Cal. v. Micro Therapeutics, Inc.*, the court stated that "[t]he failure of the specification to describe expressly or inherently a single essential element is sufficient to invalidate a claim." 2007 WL 2580594, *2 (N.D. Cal. Aug. 17, 2007); *see also Lockwood*, 107 F.3d at 1572 ("Each application in the chain must describe the claimed features."). That is in no way inconsistent with the requirement that the specification provide support for the full scope of the claim, including every embodiment covered by the elements of the claim.

That problem with Acacia's complaint aside, it is true that, in some circumstances, it is permissible to claim more broadly than the specific embodiments disclosed. In order to do so, however, the specification must disclose the broader scope to which the patentee believes himself to be entitled. If the patentee is relying on disclosure of a species to support a genus, the disclosed species must be representative of that broader genus. A narrow description cannot support broader claims unless such disclosure is provided. *See, e.g.*, *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1479 (Fed. Cir. 1998) (claims that did not limit location of controller invalid because specification described the central console as the only location for the controls); *PIN/NIP, Inc. v. Platte Chem. Co,*, 304 F.3d 1235, 1248 (Fed. Cir. 2002) (applying *Gentry*; finding broadened method claim not adequately described by disclosure of specific methods); *Carnegie Mellon Univ.*, 541 F.3d at 1126 (affirming summary judgment of invalidity on the ground that disclosure of species did not suffice to describe broader genus claimed); *Enzo,* 323 F.3d at 967 (species sufficiently describes claims to broader genus if "representative of the scope of those claims"); *Eli Lilly*, 119 F.3d at 1567-68 (described species not representative of broader claimed genus); *see also O'Reilly v. Morse*, 56 U.S. 62, 121 (1853) (patentee "can lawfully claim only what he has invented and described, and if he claims more his patent is void").

In contrast, some of the cases cited by Acacia involve circumstances where the example disclosed in the specification is representative of, and thus supports, the broader claim. (*See*, *e.g.*, Opp'n at 21:20-24 (citing *Bilstad v. Wakalopulos,* 386 F.3d 1116, 1124 (Fed. Cir. 2004), which explains that a species can sometimes constitute sufficient disclosure of a broader genus.) To be sure, as Acacia notes (Opp'n at 21:22-26), *LizardTech* also instructs that "[a] claim will not be invalidated on section 112 grounds simply because the embodiments of the specification do not contain examples explicitly covering the full scope of the claim language." 424 F.3d at 1345. However, as *LizardTech*'s very holding illustrates, for a disclosed embodiment to sufficiently describe a broader claim's full breadth, the description of the disclosed embodiment must satisfy all of the standards for compliance with the written description requirement ***and*** be a representative species of a broader genus. *See id.* at 1346 ("The single embodiment would support such a generic claim only if the specification would reasonably convey to a person skilled in the art that [the inventor] had possession of the claimed subject matter at the time of filing . . . and would enable one of ordinary skill to practice the full scope of the claimed invention. . . . [T]he description of one method for [achieving a certain objective] does not entitle the inventor . . . to claim any and all means for achieving that objective.") (internal quotations omitted).

In re Smythe, also relied on by Acacia (*see, e.g.*, Opp'n at 21:17-20), provides an example of when the disclosure of a species is sufficient to support a claim to a genus. The court explained that a patent to the scales of justice which described the use of a 1-pound lead weight would probably provide sufficient disclosure to support a claim to the scales using any type of 1-pound weight. 480 F.2d 1376, 1384 (C.C.P.A. 1973) "[T]he ***description of the use and function*** of the lead weight as a scale counterbalance in the whole disclosure," the court explained, "would immediately convey to any person skilled in the scale art the knowledge that the applicant invented a scale with a 1-pound counterbalance weight, regardless of its composition." *Id.* (emphasis added). Because it is self-evident that any type of 1-pound weight is interchangeable with a 1-pound lead weight for purposes of the invention, the disclosed 1-pound lead weight is a species that is representative of the broad genus of 1-pound weights.

Unfortunately for Acacia, the principle articulated in *Smythe* does not apply to any of the asserted claims.

F. Summary Judgment Can Be Granted Without Expert Testimony – A Court Does Not Need An Expert To Tell It What The Specification Does Not Disclose

Although written description is a question of fact, courts frequently hold that a specification does not satisfy the written description requirement as a matter of law on summary judgment. *See, e.g., Rochester*, 358 F.3d at 929 (affirming summary judgment for lack of written description); *Lockwood*, 107 F.3d at 1572 (same); *Carnegie Mellon Univ.*, 541 F.3d at 1127 (same). "After all, it is in the patent specification where the written description requirement must be met." *Rochester*, 358 F.3d at 927. Where, as here, a specification is facially insufficient to meet the governing legal test, "the patent in suit proves its own invalidity," and summary judgment for lack of written description is appropriate. *See, e.g.*, *id.* at 930.

For this reason, Acacia's protestations notwithstanding (Opp'n at 13:15-24), summary judgment of failure to comply with the written description requirement most certainly can be granted in the absence of expert testimony that the specification is deficient. *A court does not need an expert to tell it what is not disclosed in the specification*. For example, the *Rochester* court granted summary judgment for lack of written description notwithstanding the fact that the moving party did not proffer expert testimony. *Rochester* explained that "[a]lthough section 282 of the Patent Act places the burden of proof on the party seeking to invalidate a patent" by clear and convincing evidence, the specification plainly did not disclose what the claimed material ***was*** (it disclosed only what the claimed material ***did***), and as such, "the patent in suit prove[d] its own invalidity." 358 F.3d at 930. In so holding, the court rejected the patentee's expert testimony as inapposite because it was not directed to the correct legal inquiry and was not a substitute for adequate disclosure in the specification. *See id.* at 925-26, 930.[12] *See also PIN/NIP*, 304 F.3d at 1247-48 (finding patent claim invalid for lack of written description based solely on language of the specification); *TurboCare Div. of Demag Delaval Turbomach. Corp. v. Gen. Elec. Co.*, 264 F.3d 1111, 1118-19 (Fed. Cir. 2001) (affirming summary judgment of invalidity for failure to satisfy written description requirement; basing decision solely on language of the specification and discounting non-moving party's expert's conclusory statements that, as of the original filing date, the written description requirement was satisfied); *Augustine Med., Inc. v. Gaymar Indus.*, 181 F.3d 1291, 1303 (Fed. Cir. 1999) (discounting as wholly conclusory non-moving party's expert testimony that language in the specification supported the claimed subject matter; the court considered only the specification in affirming summary judgment for failure to meet the written description requirement); *Lucent Tech. Inc. v. Gateway, Inc.*, 2007 WL 1449804, at *2 (S.D. Cal. May 15, 2007) ("Although invalidity for lack of

[12] Acacia's statement that "the Federal Circuit based its decision [in *Rochester*] on the patentee's failure to present expert testimony," (Opp'n at 13 n.6), is simply a misrepresentation of the facts of that case.

written description is a question of fact, expert testimony is not always required to prove invalidity."); *Poweroasis, Inc. v. T-Mobile USA, Inc.*, 2007 U.S. Dist. LEXIS 24175, at *25 (D.N.H. Mar. 30, 2007) ("The relevant evidence in this case consists solely of the Original Application and an affidavit from [non-moving party's expert witness]"; finding non-moving party's expert testimony unpersuasive and holding that moving party is entitled to summary judgment on its claim that the patent failed to satisfy the written description requirement), *aff'd*, 522 F.3d 1299 (Fed. Cir. 2008).[13]

G. The Alleged Failure Of The PTO To Issue Written Description (Or Enablement) Rejections Would Be Irrelevant If It Were True

Acacia says that this Court must somehow defer to the PTO because it allegedly "never once" issued a written description rejection in the course of examining five different Yurt applications. (Opp'n at 7:22-9:18.) Acacia's position contradicts the well-established law that the PTO is entitled to no deference beyond that reflected in the burden of proof placed on Defendants to overcome the presumption of validity. *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1329 (Fed. Cir. 2000) ("[T]he decision of the Patent and Trademark Office with respect to patentability is accorded deference in district court litigation, *deference that takes the form of the presumption of validity that is accorded to issued patents under 35 U.S.C. § 282*.") (emphasis added); *see also Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1359 (Fed. Cir. 2007) ("[A] court is never bound by an examiner's finding in an ex parte patent application proceeding."). Indeed, the Federal Circuit has flatly rejected Acacia's argument that because "never once did the Examiners reject any claim for any alleged written description or enablement violation" (Opp'n at 8:1-2), the usual presumption of validity becomes particularly weighty. *See AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1245 (Fed. Cir. 2003) ("[W]e dispel the notion that the failure of the PTO to issue an enablement rejection automatically creates an 'especially weighty presumption' of compliance with 35 U.S.C. § 112.").

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[13] Acacia's complaint (Opp'n at 9:20-26) that Defendants failed to present expert testimony on the level of skill in the art is a red herring. The Court has previously considered the level of ordinary skill in the art in connection with claim construction. (*See, e.g.*, 6th CCO at 3:16-18.) For purposes of the present motions, Defendants are willing to accept the level of skill Acacia's expert proposes.

In any event, this discussion is moot because the examiners of the Yurt patents ***did*** issue § 112 rejections, including written description rejections. See, for example, the 12/30/94 Office Action issued during prosecution of the '863 patent. (5/8/06 Decl. of David M. Hymas in Supp. of Satellite Defs.' Proposed Claim Construction, Ex. M, docket no. 158-6, at 2-3 (¶¶ 3-4) ("The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention, and the specification, as originally filed, does not provide support for the invention as is now claimed.").)

IV. ACACIA MISSTATES THE STANDARDS FOR COMPLIANCE WITH THE ENABLEMENT REQUIREMENT

Acacia's basis for asserting that the claimed "transmission system" and "reception system" are enabled is straightforward and easy to understand. Even though the specification does not describe the "detailed identity" of the components that make up the purportedly inventive "transmission system" and "reception system," and even though none of those components were available as off-the-shelf devices in 1991, its expert has opined that those of ordinary skill in the art could have made each of those components without undue experimentation. That, Acacia believes, is sufficient to create a genuine issue of material fact sufficient to defeat Defendants' summary judgment motions for lack of enablement.

Fortunately, it is just as easy to understand why Acacia's argument fails as a matter of law. As explained below, the specification itself must contain an enabling disclosure of the novel aspects of the claimed invention; the purported ability of those skilled in the art to make those novel components is not a substitute for such an enabling disclosure. Because none of the components of the allegedly novel "transmission system" and "receiving system" were available in 1991 as off-the-shelf components, they are all supposedly novel aspects of the invention.[14] Therefore, Acacia's allegation that those skilled in the art could have built each of those "transmission system" and

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[14] Any reference herein to "novel aspects," "novel components" or the like as used in connection with the Yurt patents should be read as preceded by the word "allegedly" if it is not already there. For convenience and ease of reading, Defendants will not always be so explicit.

"reception system" components is legally insufficient to create a genuine issue of material fact with respect to Defendants' enablement motions.

Acacia also asserts that Defendants' enablement motions should be denied because (i) they did not rely on an expert to tell the Court about the failings of the specification that are apparent on its face; (ii) the inventors were allegedly permitted to claim more broadly than the invention they disclosed in the specification; and (iii) Defendants' allegedly conflated written description and enablement because the same specification inadequacies require the claims to be invalidated on both grounds. Acacia is wrong on all counts.

A. The Specification Itself Must Teach How To Make The Novel Aspects Of The Claimed Invention

As Acacia concedes, enablement is a question of law. (Opp'n at 25 n.14.) Although (as Acacia points out) an enablement analysis, and in particular the issue of whether "undue experimentation" is required, sometimes turns on inquiries informed by facts (the so-called *In re Wands* factors, *see* Opp'n at 24:14-22), enablement can be – and often is – determined as a matter of law. *See, e.g., Auto. Techs. Int'l, Inc. v. BMW of N. Am., Inc.*, 501 F.3d 1274, 1276 (Fed. Cir. 2007) (affirming summary judgment for lack of enablement); *Sitrick v. Dreamworks, LLC*, 516 F.3d 993, 1002 (Fed. Cir. 2008) (same).

The Federal Circuit has repeatedly held that, as a matter of law, the enablement requirement is not satisfied unless information about how to make the novel aspects of the invention is provided in the specification itself. The knowledge of ordinarily skilled artisans ***cannot*** be relied on to supply the knowledge of how to make the novel aspects of an invention. In *Auto. Techs.*, for example, the Federal Circuit explicitly rejected the patentee's argument that "knowledge of one skilled in the art" could "suffic[e] to supply the missing information" regarding how to make an electronic side impact sensor (which the claim was broad enough to cover) where the specification provided only a "mere boxed figure" and "a few lines of description" of the sensor. *Id.* at 1283. Invoking *Genentech*, the Federal Circuit reasoned that: "'It is the specification, not the knowledge of one skilled in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement.'"

Auto. Techs., 501 F.3d at 1283 (quoting *Genentech*, 108 F.3d at 1366). Because "the novel aspect of the invention is side impact sensors," the court held, "it is insufficient to merely state that known technologies can be used to create an electronic sensor." *Auto. Techs.*, 501 F.3d at 1283. Although "what is well known in the art" may "supplement[]" the specification, the rule "of supplementation [is] not a substitute for a basic enabling disclosure." *Id.* (internal quotations omitted).[15] The Federal Circuit has repeatedly relied on this black-letter principle of enablement law. *See, e.g., Crown Operations Int'l, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1380 (Fed. Cir. 2002) ("[T]he novel aspects of the invention must be disclosed and not left to inference, that is, a patentee may not rely on the inference of a person of ordinary skill in the pertinent art to supply such novel aspects.").

This Federal Circuit mandate is fatal to the enablement of the asserted claims, because Acacia relies on knowledge of skill in the art to provide virtually ***all*** of the details about how to make ***all*** of the components of the supposedly novel "transmission system" and "receiving system." Acacia therefore resorts to misstating the holdings of these cases. For example, Acacia contends (Opp'n at 11:16-12:2) that the holding of *Auto. Techs.* turned on the inadequacies of the accused infringer's expert declaration. That is simply incorrect. The Federal Circuit squarely held that the specification was deficient as a matter of law for failing to teach how to make the invention's novel aspects. *See Auto. Techs.*, 501 F.3d at 1283-84. The inadequacy of the declaration of the patentee's expert, which stated in conclusory fashion that a skilled artisan "would know how to adapt then-existing technology" without explaining "any details on how," simply provided "additional support" for the district court's grant of summary judgment, *see id.* at 1284-85, as did the testimony of the moving party's expert.

Acacia similarly mischaracterizes *Genentech*, incorrectly stating that the court "found that the enablement requirement was not met, because one of ordinary skill in the art would have had to engage in undue experimentation." (Opp'n at 12:3-19.) Acacia ignores the ***reason*** the *Genentech* court reached this conclusion. The Court held that the specification's failure to teach how to make the novel aspects of the invention amounted to "a failure to meet the enablement requirement that ***cannot*** be rectified by asserting that all the disclosure related to the process is within the skill of the art." *Genentech*, 108 F.3d at 1366 (emphasis added).

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[15] The 1989 MPEP excerpt Acacia cites, which predates the Federal Circuit's decisions in *Genentech* and *Auto. Techs.*, is nonetheless consistent with their holdings. The MPEP calls for the examiner to "focus on the diverse functions attributed to each block element as well as the teachings in the specification as to how such a component could be implemented" and determine if "more than routine experimentation would be required . . . ." (Opp'n at 9:1-9.) The MPEP thus expressly contemplates that the specification itself can reveal the need for "undue experimentation."

Computer-related inventions are not excused from satisfying the above-stated standards for compliance with the enablement requirement, notwithstanding Acacia's assertion to the contrary. The cases Acacia cites (Opp'n at 25:18-26:20) merely explain that writing code can be "within the skill of the art," depending on how detailed the software algorithm is that is disclosed in the specification. *See, e.g., Fonar Corp. v. Gen. Elec. Co.*, 107 F.3d 1543, 1549 (Fed. Cir. 1997); *see also Sherwood*, 613 F.2d at 817 n.6. Thus, if a detailed software algorithm is disclosed that implements the novel aspects of the invention, the disclosure of code that embodies the algorithm may not be required in instances where translating from the English language into computer language is "a mere clerical function . . . ." (Opp'n at 26:15-19 (citing *Sherwood*, 613 F.2d at 817 n.6).) Obviously, given the sparsity of the disclosure in the Yurt patents, this authority is of no use to Acacia.

The Yurt specification discloses nothing about how to make any of the supposedly novel components of the claimed "transmission system" and "reception system," and the knowledge of those skilled in the art that Acacia relies on is not a substitute for such disclosure as a matter of law. Acacia has therefore failed to create a genuine issue of material fact sufficient to defeat Defendants' enablement motions.

B. Summary Judgment Of Non-Enablement Can Be Granted Without Expert Testimony

Although Acacia suggests that expert testimony is always "essential" to the enablement inquiry (Opp'n at 10:19-22), it provides no support for that proposition because it is simply not true. Here, for example, there is no dispute that the Yurt specification does not describe the specific hardware, software or software algorithms that constitute the components of the allegedly novel "transmission system" and "reception system," and there is no dispute that the specification does not describe how to make any of those components. Indeed, even if Acacia did dispute these things, the Court can read the specification for itself and see that those details are not disclosed. Therefore, because the law requires that the specification itself provide the details of how to make the novel aspects of the invention, the Court does not need an expert to put 2 and 2 together and to find that the claimed "transmission system" and "receiving system" are not enabled as a matter of law. Courts can and have granted summary judgment of non-enablement even when the movant has not submitted an expert opinion. *See, e.g., Rochester*, 249 F. Supp. 2d at 231-35 (granting summary judgment of non-enablement even without expert declaration by moving party), *aff'd on other grounds*, 358 F.3d 916; *Nat'l Recovery Techs., Inc. v. Magnetic Separation Sys., Inc.*, 1997 U.S. Dist. LEXIS 23291, at *17-18 (M.D. Tenn. Oct. 29, 1997) (holding that the specification failed to enable the full scope of the claimed invention without undue experimentation based on the language of the specification and the inventor's own testimony), *aff'd*, 166 F.3d 1190 (Fed. Cir. 1999).

That does not mean, however, that Defendants contend (as Acacia asserts they do, Opp'n at 11:8-11, 23:2-5) that expert testimony is always or inherently irrelevant, or that the specification must always include steps routine in the art (Opp'n at 36:7-10.) It simply means that in this case, because no detail is provided in the Yurt patents as to how to make any of the claimed components of the allegedly novel "transmission" and "receiving" systems, an expert declaration was unnecessary.[16]

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[16] That some courts affirming summary judgment of non-enablement relied on the additional support expert testimony provided (Opp'n at 13:3-14 (discussing *Sitrick*, 516 F.3d 993)) does not change the fact that the specification in those cases was deficient as a matter of law. In *Sitrick*, the court concluded that "[t]he patents do not teach how to implement" the invention "in the context of movies," 516 F.3d at 1000, and that the specification therefore did not satisfy the enablement requirement as a matter of law (a legal conclusion the patentee's expert declaration could not avoid). Although the court also considered the expert testimony presented by the moving party, the court did not hold that expert testimony is required to prove non-enablement. Moreover, courts have

(continued...)

C. Narrow Embodiments Do Not Enable Broad Claims Unless The Specification Provides Additional Disclosure That Enables The Full Breadth Of The Invention

Acacia argues that disclosure of a single embodiment enables a claim with a broader scope (Opp'n at 23:21-24:6.) That is only true, however, when (1) the single embodiment itself satisfies the standards for compliance with the enablement requirement; ***and*** (2) the disclosed example is "just another known specifies of a [broader] genus," *i.e.*, the species is representative of all the species within the claimed genus. *Auto. Techs.*, 501 F.3d at 1285 (rejecting argument that sufficient disclosure of mechanical side impact sensor enabled electronic side impact sensor, and explaining that "[i]n order to fulfill the enablement requirement, the specification must enable the full scope of the claims" which "the specification fails to do"). These concepts are inapplicable here, however, because even the disclosed embodiments of the "transmission system" and "reception system" are not enabled. Therefore, the disclosure cannot possibly enable broader claims.

D. Defendants Do Not Conflate The Written Description and Enablement Requirements

Acacia is wrong in asserting that Defendants "conflat[e]" the legal tests for written description and enablement. (Opp'n at 2:13-15, 16:8-21.) Defendants, in their motion papers (Mot. at 5:1-8:23),[17] and again below, separately address the distinct legal tests applicable to each § 112 requirement. And Defendants demonstrate that the specification, as a matter of law, satisfies neither. To be sure, Defendants contend that the very factors that demonstrate lack of written description for a claim or claim element also show lack of enablement. But that is hardly surprising. As Acacia itself concedes, "the written description and enablement requirements may rise or fall together."

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[16] (...continued)
granted an accused infringer's motion for summary judgment for lack of enablement based solely on the language of the specification. *See, e.g., Rochester,* 249 F. Supp. 2d at 231-35. Defendants here rely on the specification's own failings, Acacia's own expert declarations, and the Sarnoff research report, dated April 17, 1992 ("Sarnoff Report") commissioned by the patentees.

[17] As used herein, "Mot." refers to Round 3 Defendants' Notice Of Motions And Motions For Summary Judgment Of Invalidity Under 35 U.S.C. § 112 Of The '992, '863 And '702 Patents, docket no. 292, filed July 18, 2008.

(Opp'n at 16 n.8.) *See also LizardTech*, 424 F.3d at 1345 (explaining that "[w]hether the flaw in the specification is regarded as a failure to demonstrate that the patentee possessed the full scope of the invention . . . or a failure to enable the full breadth of the claim, the specification provides inadequate support for the claim under [§ 112].").

Ironically, it is Acacia, not Defendants, that conflates the written description and enablement requirements. For example, both Acacia and its expert, Mr. Weiss, repeatedly suggest that a claimed component satisfies the written description requirement because those skilled in the art would know how to make it or discover what it is using known design processes. While that is relevant in some circumstances to an enablement analysis, it is not relevant to a written description analysis. *See Rochester*, 358 F.3d at 927 (not sufficient to satisfy written description requirement where specification "describes in detail . . . assays for screening compounds . . . ***to identify*** those [molecules] that inhibit the expression or activity of the PGHS-2 gene product") (emphasis added). That one could use known design processes to develop a suitable component is not the same as, and is not a substitute for, disclosing what the component that would be developed by such design processes ***is***.

V. EXPERT DECLARATIONS THAT ARE BASED ON THE WRONG LEGAL STANDARDS, THAT ARE CONCLUSORY, OR THAT CONTRADICT THE SPECIFICATION SHOULD BE DISREGARDED

Mr. Weiss's declaration should be disregarded for many independent and sufficient reasons. It is based on the wrong legal standards for written description and enablement. It is conclusory. And it contradicts the specification and the Court's claim construction orders.

First, Mr. Weiss bases his entire declaration on a collection of assumptions provided to him by Acacia. Because Acacia itself misunderstood the standards for compliance with the written description and enablement requirements, it misadvised Mr. Weiss as to what those standards are, who in turn applied the wrong standards in forming his opinions. For example, Mr. Weiss was told by Acacia to assume that if he determined that the inventors were in "possession" of a claimed component, that was sufficient to satisfy the written description requirement. (12/15/08 Decl. of Merrill Weiss in Supp. of Pl. Acacia Media Techs. Corp.'s Opp'n to Round 3 Defs.' Mot. for

Summary Judgment ("Weiss Decl.") ¶ 34(4).) Mr. Weiss then repeatedly applied this test throughout his declaration. (*See id.* at ¶¶ 64, 68, 75, 80, 89, 95, 98, 102, 106, 111, 115, 120, 126, 128, 130, 133, 136, 139, 146, 151, 156, 161, 163.)

As explained in Section III(A) above, however, "possession" is ***not*** the test for compliance with the written description requirement. The fact that Mr. Weiss's opinions are based on the wrong legal standard alone requires that those opinions be disregarded. *Rochester*, 358 F.3d at 925-26, 930 (patentee's expert declaration ignored as inapposite because it was not directed to the correct legal inquiry); *Southard v. United Reg'l Health Care Sys.*, 2008 U.S. Dist. LEXIS 87599, at *5 (N.D. Tex. Aug. 5, 2008) ("Although a qualified expert is not necessarily prohibited from expressing an opinion on an ultimate issue of fact, where as here, the expert's opinion is based on an erroneous legal premise, it is appropriate to exclude such testimony."); *Loeffel Steel Prods., Inc. v. Delta Brands, Inc.*, 387 F. Supp. 2d 794, 806 (N.D. Ill. 2005) ("Expert opinions that are contrary to law are inadmissible."); *Straumann Co. v. Lifecore Biomed. Inc.*, 278 F. Supp. 2d 130, 135 (D. Mass. 2003) (finding that plaintiff's expert opinion "cannot defeat summary judgment" where it was "based on an erroneous legal standard"); *Carapellucci v. Winchester,* 707 F. Supp. 611, 619-20 (D. Mass. 1989) (affidavit of an expert who erroneously stated in his deposition that "accepted standards" were synonymous with "state of the art" creates a risk that the opinion is based on an erroneous legal premise, and, as a result, cannot defeat summary judgment).

Second, even when an expert does apply the correct legal standard, he must do more than simply state a conclusion; the expert must provide supporting facts. Where the opinion relates to written description, the expert must do more than state the conclusion that the specification allows a skilled artisan to envision the detailed identity of the claimed component; he must support that opinion and set forth what the detailed identity of the claimed component ***is***. Where the opinion relates to enablement, the expert must explain how the claimed device would be built without undue experimentation, such as by setting forth the identity of a known device and explaining how those skilled in the art would modify that device to achieve the invention. Otherwise, the expert's opinion is conclusory and should be disregarded. *Lockwood*, 107 F.3d at 1572 (expert declaration opinion that a skilled artisan would "envision" an essential element missing from an intervening application insufficient to create genuine issue of material fact to avoid summary judgment for lack of written description); *Sitrick*, 516 F.3d at 1001 (affirming holding that expert "opinion regarding enablement did not raise a triable issue of fact" when "'conclusory' and 'unsupported by any actual information'"); *Auto. Techs.*, 501 F.3d at 1284-85 (patentee's expert enablement declaration "failed to provide any detail regarding why no experimentation was necessary"); *In re Buchner*, 929 F.2d 660 (Fed. Cir. 1991) (affirming PTO rejection of declaration in support of enablement on the ground that "it was mere conclusion unsupported by factual documentation and that it provided inadequate indication that the technology concerning the comparator and divider was well-known.").

Third, it is axiomatic that an expert opinion on enablement and written description cannot contradict the specification or the Court's claim constructions. Mr. Weiss, however, frequently does just that. For example: (1) he frequently attempts to substitute components into the "transmission system" and "receiving system" for the ones that are actually supposed to be there; (2) he adds components to those systems that are not referenced in the specification at all; and (3) he construes the components of the "transmission system" and "reception system" differently than the Court has done. An expert does not create a genuine issue of material fact by ignoring or contradicting the specification. *See, e.g., Lockwood*, 107 F.3d at 1571 (expert declaration that contradicts claims and specification insufficient to support right to earlier priority date in written description context).

VI. THE COURT CAN AND SHOULD CONSIDER THE SARNOFF REPORT

Acacia is desperate for the Court not to consider the objective advice the inventors sought and received from the Sarnoff Institute ("Sarnoff") about the Yurt patent application. Acacia questions the qualifications of its authors, the motives of its authors, and the authority of the Court to consider the Sarnoff Report. (Opp'n at 14-15.) However, Acacia cannot avoid the simple fact that the inventors retained Sarnoff to opine on their specification because of Sarnoff's expertise. Nor can Acacia avoid Sarnoff's analysis and its ultimate verdict which, while diplomatic, is devastating – the Yurt specification lacks adequate description and does not enable the disclosed system. For example the following passage from the Sarnoff Report could just as easily have come from a court opinion finding that the Yurt patents are invalid for failing to satisfy the written description and enablement requirements:

> The general principles of the system outlined in the patent document appear to be technically correct, ***though lacking in specific details*** particularly at the subsystem level. ***While the document may serve as a useful starting point for further development, significant additional design/simulation/prototyping work will be required for a meaningful "proof-of-concept***".

(7/11/08 Decl. of David S. Benyacar in Supp. of Round 3 Defs.' Mots. for Summary Judgment ("Benyacar Decl.") Ex. A, docket no. 293-2, at 3 (emphasis added).)

This Court can and should consider the Sarnoff Report, which was commissioned around the time of the filing of the Yurt patents. The Federal Circuit has approved the use of similar evidence in determining whether the written description and enablement requirements have been satisfied. *See In re Goodman*, 11 F.3d 1046, 1050-51 (Fed. Cir. 1993) (finding the patent invalid for lack of enablement based on consideration of several articles published in the relevant field around the time of the filing date); *Plant Genetic Sys., N.V. v. DeKalb Genetics Corp.*, 175 F. Supp. 2d 246, 260-61 (D. Conn. 2001) (finding lack of enablement based on memo drafted by a steering committee commissioned by the patentee around the time of the filing date concluding that its attempts to use the claimed method had failed), *aff'd*, 315 F.3d 1335 (Fed. Cir. 2003).

In fact, the Federal Circuit has made clear on many occasions that it also approves of the use of *post-filing* documents as evidence of the state of the art existing on the filing date of an application. *See, e.g.*, *Plant Genetic Sys.*, 315 F.3d at 1343-44 (citing *In re Hogan*, 559 F.2d 595, 605 (C.C.P.A. 1977)); *Amgen*, 314 F.3d at 1336 (examining numerous post-filing publications to establish what one of skill in the art would have known); *In re Corneil*, 52 C.C.P.A. 1718, 1724 (1965) (where, for example, a later publication evidenced that, as of an application's filing date, undue experimentation would have been required).

Finally, notwithstanding Acacia's assertion to the contrary (Opp'n at 14:4-9), the Sarnoff Report is admissible under the Federal Rules of Evidence. It is clearly relevant – it is the opinion of the inventors' paid experts that the specification does not adequately describe or enable the invention, which is the subject of Defendants' motions. It is not "inadmissible hearsay" because it is a business record under Rule 803(6). Furthermore, the Sarnoff Report constitutes an admission,[18] and is therefore not hearsay at all under Rule 801.[19] Finally, Rule 702 does not apply because, *inter alia*, the Sarnoff Report is not "testimony by experts." *See* Fed. R. Evid. 702.

VII. EACH ASSERTED CLAIM IS INVALID BECAUSE THE SPECIFICATION FAILS TO ADEQUATELY DESCRIBE AND ENABLE THE CLAIMED "TRANSMISSION SYSTEM"

Defendants explained in their motion papers why *none* of the individual components of the claimed "transmission system" (construed by the court as the "configurable, interconnected assemblage of components" depicted in Figs. 2a and 2b (6th CCO at 11:13-22)) are sufficiently described or enabled. If the Court concludes that *even one* component of the transmission system is not adequately described or enabled, however, the entire claimed "transmission system" is not adequately described or enabled. (Mot. at 14:1-8.) Acacia does not dispute that the "transmission system" limitation is only as strong as its weakest component. Instead, notwithstanding the fact that the Court already found the "identification encoder" component of the claimed "transmission system" to be indefinite and has noted and invited motions on many of the specification's other failings, Acacia attempts to convince the Court that every component of the claimed "transmission system" complies with the written description and enablement requirements.

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[18] The Sarnoff Report is admissible as an admission of a party opponent under either Rule 801(d)(2)(C) ("statement by a person authorized by the party to make a statement concerning the subject") or 801(d)(2)(D) ("statement by the party's agent or servant concerning a matter within the scope of the agency or employment, made during the existence of the relationship"). *See Reid Bros. Logging Co. v. Ketchikan Pulp Co.*, 699 F.2d 1292, 1306 (9th Cir. 1983) (admitting under Rule 801(d)(2)(C) an investigative report prepared for defendant and offered by plaintiff); *Hoptowit v. Ray*, 682 F.2d 1237, 1262 (9th Cir. 1982) (admitting under Rule 801(d)(2)(D) an investigative report completed by a government agency at the request of the defendant, another government agency, because the statements in the report were within the scope of the agency of the preparer); *United States ex rel. Remtech, Inc. v. Nat'l Union Fire Ins. Co.*, 2000 U.S. App. LEXIS 21499, at *8-9 (9th Cir. Aug. 17, 2000) (unpublished opinion) (admitting under Rule 801(d)(2)(D) statements by a hired consultant concerning a matter related to the consultation during the time of his employment). Admissions of a party opponent are inherently trustworthy and thus no further "guarantee of trustworthiness is required." Fed. R. Evid. 801 advisory committee's note; *Hoptowit*, 682 F.2d at 1262 (noting that expertise of party or its agent need not be demonstrated in order to admit that party's admission).

[19] *See, e.g.*, *Evans v. Williams*, 238 F.R.D. 1, 2 (D.D.C. 2006) ("[I]nsofar as those reports [sought to be admitted by plaintiff] were created by the [defendant] or its agents, to include entities retained by it for a specific purpose, the reports are admissions of a party opponent and not hearsay.").

Acacia begins its futile mission with the remarkable proposition that because the Court construed "transmission system" to mean the components depicted in Figs. 2a and 2b, and because the components of Figs. 2a and 2b and the term "transmission system" appeared in the originally filed specification and claims, "transmission system" must, by necessity, comply with the written description requirement. (Opp'n at 28:24-29:11). In other words, Acacia argues that only material added in later filed claims can lack written description. However, the Federal Circuit has squarely rejected this argument. Written description requires disclosure that permits one to "recognize" or "visualize" the "detailed identity" of the invention. *See supra* at Section III(A). "If a purported description of an invention does not meet the requirements of the statute, the fact that it appears as an original claim or in the specification does not save it. A claim does not become more descriptive by its repetition, or its longevity." *Enzo*, 323 F.3d at 968-69.

Acacia complains that Defendants' written description and enablement analysis was too stringent because it "imbued each component [of the transmission system] with all of the features and functions described in the specification, whether claimed or not or whether described as optional or mandatory in the specification . . . ." (Opp'n at 28:6-8.) Acacia misunderstands Defendants' argument. Defendants are ***not*** saying that the claims are necessarily limited to whatever optional embodiments are disclosed. What Defendants ***are*** saying is that, as explained in Section III(D) above, if the claims are broad enough to cover those optional embodiments, the inventors were obligated to describe the "detailed identity" of those embodiments. Defendants are also saying that, because the inventors (improperly) attempted to define the components of the transmission system only by reference to what they do, that definition must carry over into the claims if the claims are to have any meaning at all.

Acacia attempts to save the '702 patent from the inevitable fate of its sister patents by arguing for the very first time that the Court's construction of "transmission system" does not apply to the system claims of the '702 patent. (Opp'n at 27 n.17.) This 11th-hour argument should also be rejected. As Acacia itself says, a claim term is presumed to have the same meaning in all of the claims in which it appears. (*Id.*) Moreover, if the Court's construction of "transmission system" does not apply to those system claims, those claims lack written description and enablement for a whole host of additional reasons. For example, the claims of the '702 patent that do not on their face require all of the components of Fig. 2 to be part of the claimed "transmission system" would lack written description because, as the Court has already determined (6th CCO at 10:20-11:12), there is no disclosure of a "transmission system" that contains less than all of the components of Fig. 2. Claim 1 of the '702 patent, for instance, does not expressly recite a "source material library" as being part of the "transmission system," but there is no support in the specification for a transmission system that does not contain a "source material library." Accordingly, if "transmission system" in the '702 patent claims is not construed to require a source material library and all of the other components of Fig. 2, the claims are invalid for failure to comply with the written description requirement. The specification does not describe a transmission system without a source material library or the other components of Fig. 2.

Moreover, if the Court's construction of "transmission system" as the "interconnected" components of Fig. 2 does not apply to the claims of the '702 patent, those claims also fail to comply with § 112 for the independent reason that they fail to require any connection or relationship between the identified components of the transmission system. Without the Court's construction, the mere existence in the world of the unconnected components recited in those claims, which could be separated by vast distances, would be part of Yurt's invention and covered by the claims. Judge Rich long ago rejected this ridiculous possibility. *See In re Collier*, 397 F.2d 1003, 1005 (C.C.P.A. 1968) (claim requiring "connector member" and "ground wire" without "recit[ing] structural relationships of the two elements . . . fails to comply with section 112, second paragraph . . . .").

Finally, as explained below, neither Acacia's misstatements of the law nor its expert's irrelevant and unsupported factual contentions raise any material factual issues regarding the specification's failure to adequately describe or enable the specific components of the claimed "transmission system."

A. "Source Material Library 111" Is Neither Adequately Described Nor Enabled As A Matter Of Law

As Defendants demonstrated in their motion papers (Mot. at 14:9-17:11), the Yurt specification does not provide a legally sufficient description of the transmission system's "source material library 111" ("SML"). The specification merely describes what a SML functioning as a component of a transmission system ***does***. The only description of what it ***is***, though, "a collection of original sources of information," would not work as a component of a "transmission system." Clearly, then, that is not an adequate written description or enabling disclosure.

1. The Specification Does Not Contain an Adequate Written Description of a "Source Material Library 111" as a Component of a "Transmission System"

a. The Specification Does Not Disclose the Detailed Identity of a Source Material Library that Functions as a Component of a "Transmission System"

Acacia's explanation of why it believes the SML component of the claimed "transmission system" satisfies the written description requirement is a study in contradiction. On the one hand, Acacia says the SML necessarily satisfies the written description requirement because the Court construed SML to mean "a collection of original sources of information," which is how it is described in the specification. (Opp'n at 29:20-30:6). Moreover, because a SML is "*nothing more* than 'a collection of original sources of information'" (Opp'n at 32:10-11 (emphasis added)), the inventors were not required to adequately describe a device that can perform the many functions associated with a SML in the specification. Those functions, which include:

(1) retrieval of information in items from the source material library (while "retrieval" is performed by the identification encoder,[20] the SM

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[20] The specification says the "identification encoding means [is] for retrieving the information for the items from the source material library" (col. 2:30-33), and the Court has already determined that "the function of the identification encoding means is to get (continued...)

L must be a structure capable of allowing this retrieval);

(2) retaining items having information in the source material library;

(3) communicating with the identification encoder;

(4) receiving and processing user requests; and

(5) communication between multiple source material libraries

(hereinafter the "FIVE SML FUNCTIONS"), were "not claimed" according to Acacia and therefore need not be described in the specification. (Opp'n at 32:4-19.)

On the other hand, Acacia recognizes that the claimed SML must function as a component of a "transmission system." As explained in Defendants' motion papers, "[a] collection of books, videotapes, computer disks, photographs, phonograph records and violins, all lying in one big heap on the floor, would qualify as a 'source material library' as construed by the Court, but such a pile of items could not possibly function as a component of 'transmission system 100.'" (Mot. at 14:19-22.) Acacia's response to this problem (which contradicts its other position set forth in the preceding paragraph) is that a SML is *not just* "a collection of original sources of information," but rather includes whatever it must for the source material library to function in the transmission system. (Opp'n at 30 n.19.) In fact, as support for the proposition that the inventors were "in possession" of such a device, Acacia relies on the capabilities ascribed to the SML in the specification, such as its being "interconnected with the 'identification encoding process 112,'" its capability "for temporary storage" and its "pass[ing]" of "information from the original sources of information" to the identification encoder. (Opp'n at 30:11-31:7.) None of these capabilities can be performed by a mere stack of film reels, videotapes or the like – that is, by a mere "collection of original sources of information."[21]

The contradiction in Acacia's two arguments arises from its misunderstanding of the Court's

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[20] (...continued)
back the information that is contained in the items which are stored in the source material library." (1st CCO 13:3-6.)

[21] Of course, Acacia never points to where in the specification a structure is disclosed which can perform these capabilities, because it is not there.

construction of the SML component of the claimed "transmission system." Although the Court defined a SML to be "a collection of original sources of information," the Court *also* held that a "transmission system" is a "configurable, ***interconnected***, assemblage of components." (6th CCO at 11:15-18 (emphasis added).) Thus, the Court did not determine, as Acacia suggests, that SML complies with the written description requirement because the specification describes it as "a collection of original sources of information." The exact opposite is true. The Court determined that because the specification describes a SML as simply "a collection of original sources of information," there is no structure disclosed to perform the functions a SML would have to perform as a component of a "transmission system." Therefore, SML does ***not*** satisfy the written description requirement.

For example, with respect to the function of "storing [construed by the Court to mean "retaining"] items having information in a source material library," the Court observed that:

> The specification is silent as to what component of the "transmission system" is capable of performing the "retaining" step. With respect to storing physical items having information, the only component discussed in the specification is the "source material library" itself. However, the "source material library" is only described as containing a collection of items having information.

(5th CCO at 17 n.17.) Similarly, a mere "collection of items having information" cannot be "interconnected" with other components of a transmission system, or perform the other functions the SML of a "transmission system" must perform. The Court expressly deferred ruling on the impact of the specification's deficient description of the SML until Defendants made the instant motion. (*Id*. at 17:5-6.) Because a SML that can function as a component of a "transmission system" is not described in the specification, the SML component of the claimed "transmission system" does not satisfy the written description requirement.[22]

Acacia also argues that Defendants are wrong to insist on disclosure of a SML that can perform the FIVE SML FUNCTIONS because some of these functions are allegedly described in the specification as "optional." (Opp'n at 32:13-16.) Other than communication between source material libraries, however, Acacia does not identify which of the FIVE SML FUNCTIONS it believes are optional. An examination of the asserted claims, however, reveals that at least three of the FIVE SML FUNCTIONS are explicitly required by the claims themselves:

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[22] It does not matter, as Acacia suggests (Opp'n at 30:7-10), that the Yurt patents' "original disclosure" contained this legally insufficient written description: "If a purported description of an invention does not meet the requirements of the statute, the fact that it appears as an original claim or in the specification does not save it." *Enzo*, 323 F.3d at 968-69. *See supra* at Section III(C).

- *retrieval of information in items from the SML*: The claims require the transmission system to perform the step of "retrieving the information in the items from the source material library." (*See*, *e.g.*, claim 41, col. 24:54-25:5).

- *retaining items having information in the SML*: The claims require the transmission system to perform the step of "storing items having information in a source material library." (*See*, *e.g.*, claim 41, col. 24:54-25:5). The Court defined "storing" to mean "retaining." (5th CCO at 17:10-11.)

- *communication with the Identification Encoding Means.* The claims require "retrieving the information in the items from the source material library," a function that is performed by the identification encoder (col. 2:30-32). Either the identification encoder or some other transmission system component on its behalf must communicate in some manner (the patent does not say how) with the source material library such that the identification encoding means can "retrieve" information in the items stored in the SML. (*See*, *e.g.*, claim 41, col. 24:54-25:5).

Not only do the claims require that these three functions be performed, it is self-evident that a "transmission system" cannot work unless the SML performs these functions. For example, unless the information stored in physical items retained in the SML can be retrieved, the transmission system cannot process that information.

Moreover, while the SML function of receiving and processing user requests is not called out specifically in the asserted claims, it is *not* described as an optional function in the specification. Indeed, the ***only*** disclosed method for triggering retrieval of information from an item in the SML is a user request to the SML. That is the reason the inventors repeatedly relied on user requests to the SML as being a patentable advance over the prior art. (Mot. at 16:4-17:4 (summarizing such statements).) Because receiving and processing user requests is a prerequisite to retrieving information from the physical items, a "transmission system" is inoperable unless the SML can receive and process user requests. This step, too, is therefore mandatory.

Thus, at least four of the FIVE SML FUNCTIONS are functions a SML ***must*** perform because the claims require it and/or because a "transmission system" cannot operate otherwise. However, even if Acacia was correct and, notwithstanding all of the above, a SML capable of performing these functions was described as an optional, *i.e.*, alternative, embodiment in the specification, the inventors were still obligated to provide an adequate description of this SML because the claims broadly cover "source material libraries." They are not limited to any of the allegedly different disclosed embodiments. Therefore, because the scope of the description must be coextensive with the scope of the claims (*see supra* at Section III(D)), the inventors were required to adequately describe all of the source material library embodiments covered by the claims.

For all of the above reasons, Acacia is plainly wrong that "there is no requirement that a written description . . . be provided" of a SML that can perform the FIVE SML FUNCTIONS. (Opp'n at 32:16-17.) Such a written description was required. For the reasons explained below, the inventors did not describe a SML capable of performing ***any*** of those functions.

b. The Specification Does Not Adequately Describe a Source Material Library that Can Perform Any of the FIVE SML FUNCTIONS

Because the asserted claims either expressly require that the SML be capable of performing the FIVE SML FUNCTIONS, or are broad enough to cover an embodiment of a SML that is capable of performing those functions, the inventors had an obligation to disclose the detailed identity of a SML capable of performing ***all*** of those functions. Put differently, the SML is not adequately described if even one of those functions is not adequately described in the specification. In fact, as explained in Defendants' motion papers (Mot. at 14:9-16:23), the inventors did not disclose a SML that can perform ***any*** of those functions. For the reasons detailed below, Acacia's opposition fails because it relies on attorney argument and expert opinions that contradict both the specification and the Court's claim constructions.

(i) retrieval of information in items from the source material library

Acacia says that the example of the digital telecine in the specification "describes how the

items in the source material library are converted[23] ***or recorded 'on a media*** format compatible to the digital and analog inputs of the system . . .' ***such as***, preferably, 'digital or analog audio and video ***tapes, laser disks, film images, optical disks, magnetic disks, computer tapes, disks, and cartridges***." (Opp'n at 32:26-33:2 (quoting col. 6:15-22).) This argument contradicts both the specification and the Court's construction of SML in numerous ways.

First, the cited passage from col. 6:15-22 does not describe the retrieval of information from the items in the source material library ***by the identification encoder***. Instead, this passage refers to the transfer of information from one medium to another within the source material library itself, such that the information is stored in the source material library on the new physical medium. The identification encoder does not perform this function – it does not store the retrieved information onto another physical object. Instead, it passes the information itself to converter 113. (Col. 6:58-62). Moreover, even if this function was somehow related to the "retrieving" step, the specification describes a SML as simply a "a collection of original sources of information," not a structure with a digital telecine. A mere stack of videotapes is not capable of converting itself into a stack of DVDs.[24]

Acacia's argument also contradicts the specification because, according to the specification, the telecine is *not* part of the SML. As the very passage from the specification relied on by Acacia says, the output of the "'digital telecine'" is "passed" to "digital input receiver 124," which is a component of ***converter 113***. (Opp'n at 33:9 (quoting col. 7:35-43).) The telecine therefore cannot be part of the SML, because the SML is not connected to converter 113. Acacia's own counsel has recognized that the telecine must therefore be located outside of the SML. (4/3/09 Reply Decl. of David S. Benyacar ("Benyacar Reply Decl.") Ex. A (9/7/06 Hr'g Tr.) at 162-166.) Acacia's argument that the telecine is part of the SML also contradicts the Court's construction that the SML is simply "a collection of original sources of information." (1st CCO at 25:14-16; 3rd CCO at 30:22-25.)

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[23] The use of "convert" here should not be confused with the conversion process performed by converter 113.

[24] Mr. Weiss's contention that the source material library "inherently includes the electro-mechanical equipment necessary to convert the contents of the various forms of media to, or to capture the essence of physical items on, media that are compatible with the various forms of input to the rest of the Transmission System" (Weiss Decl. ¶ 58) also contradicts the Court's construction of SML as a mere "a collection of original sources of information" that does not have any of this "electro-mechanical equipment." Moreover, because "source material library" is a coined term, Mr. Weiss lacks any basis for asserting that a source material library inherently contains anything. Something is "inherent" only if it is necessarily present, *Turbocare*, 264 F.3d at 1119; *In re Cortright*, 165 F.3d 1353, 1360 (Fed. Cir. 1999). Because SML is a coined term, nothing can be said to be an inherent component of one.

Acacia simply disregards the specification, which requires that the retrieval of information from the physical objects stored in the SML be performed by the identification encoder. Therefore, by necessity, there must be some mechanism in the transmission system for physically moving physical items from the source material library to the "identification encoding means," where "retriev[al] [of] the information" occurs. (Col. 2:30-33). Both Acacia and its expert mis-describe the source material library's output as being ***information***, when in fact it is ***physical items***. Somehow, videotapes, movie reels and the like must move out of the source material library to the identification encoder so the information in them can be retrieved. However, the specification does not describe any mechanism by which physical items are moved from the source material library to the identification encoder, how such a system would be automated, or what such a system would look like. Quite clearly, the SML, which is just a "collection of original sources of information," cannot perform this transfer function.

Perhaps because he recognizes that there is no disclosure of a SML that can accommodate "retrieval" or the other functions associated with the SML in the specification, Mr. Weiss says that human "system operators" would be required to perform any functions of the SML that could not be automated. For example, Mr. Weiss opines that humans must be "involved to load and unload the automated storage and content retrieval devices." (Weiss Decl. ¶ 62.) This opinion cannot create a genuine issue of fact because it, too, contradicts the specification and the Court's prior construction of SML.

As an initial matter, a transmission system cannot include humans. The "transmission system," this Court ruled, is "the configurable, interconnected, assemblage of components" depicted in Fig. 2. (6th CCO at 11:13-22.) Fig. 2 does not include humans, and humans do not constitute "components." In addition, the specification does not describe a human as constituting part of the SML (or of any other component of the transmission system for that matter), or as otherwise performing the "retrieving" function. In sum, the specification describes nothing, human or otherwise, that (1) reaches into the source material library, (2) retrieves whatever media must be retrieved (and the specification describes a multitude of different types of media, such as "digital or analog audio and video tapes, laser disks, film images, optical disks, magnetic disks, computer tapes, disks, and cartridges" (Opp'n at 32:26-33:2 (quoting col. 6:15-22)), (3) transfers the media to the identification encoder, and, after retrieval, (4) puts the item back into the source material library.[25] The structure for performing all these key prerequisites for the "retrieval" step are left to the imagination, and imagination does not constitute written description.

(ii) retaining items having information in the source material library

The specification says that the SML stores, *i.e.*, retains, the items having information (col. 5:67-68), and Acacia agrees (Opp'n at 31:1-3.) Yet, this Court has already determined that the SML disclosed in the specification, which is merely "a collection of items having information," is not capable of performing the retaining function. (5th CCO at 17 n.17.) In effect, the Court has already determined that the SML of the claimed "transmission system" does not satisfy the written description requirement.

Acacia and its expert try to manufacture a genuine issue of material fact by asserting that "one skilled in the art would have known how to store numerous types of items having information disclosed in the patent . . . ." (Opp'n at 34:5-8 (citing Weiss Decl. ¶ 59).) Even if true, it is not relevant. Neither Acacia nor Mr. Weiss allege that one skilled in the art would have known how to

[25] The specification says that the SML is for "temporary storage of items ***prior to conversion and storage in a compressed data library means***." (Col. 5:66-6:2). Therefore, after the information is retrieved from the item by the identification encoder, the item must be returned to the SML at least until storage in the compressed data library is completed.

store using a ***source material library***. Even more fundamentally, this assertion contradicts the Court's construction of SML. As Mr. Weiss has previously testified, "retaining" requires many different functions: "keeping content in storage ***requires active maintenance*** in order to avoid deterioration of the material. For film and tape, such maintenance often includes retaining the media in an environment having controlled temperature and humidity" and "appropriate transport devices." (5/18/07 Decl. of Merrill Weiss in Supp. of Pl. Acacia Media Techs. Corp.'s Mot. for Recons. of Certain Claim Construction Terms ("5/18/07 Weiss Decl."), docket no. 239, at ¶ 19 (emphasis added).) Moreover, "the maintenance process likely will involve the periodic movement of copies of the content from one medium to another as the medium on which the content is stored" is "superceded by more modern technology." (*Id.*) A mere "collection of items having information," such as a stack of videotapes on a shelf, is incapable of performing any of the "required" retaining functions identified by Mr. Weiss.

(iii) communicating with the identification encoder

The specification identifies ***no*** mechanism or interface for the SML and the identification encoder to "interconnect[]" as required by the Court's construction of "transmission system" (6th CCO at 11:16), and as depicted in Fig. 2. Acacia and Mr. Weiss's response that the two components would "communicate via any available method" (Opp'n at 33:25-34:2; Weiss Decl. ¶ 63) does not create a genuine issue of material fact; "any available method" does not allow one to "visualize or recognize" the "detailed identity" of the means for communicating.[26] For example, a "telephone line" is one means of communication, but a telephone line connected to a stack of videotapes (which constitutes a SML) cannot serve any useful purpose. Neither the specification, nor Acacia, nor Mr.

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[26] In fact, the specification ***does not*** even say that the SML and the identification encoder can communicate by "any available method." The passage relied on by Acacia (col. 6:33-34) only says that ***two SMLs*** can communicate ***with each other*** using "any available method." The passage has nothing to do with how a SML could communicate with an identification encoder. For the reasons discussed, however, this is the least of Acacia's problems.

Weiss explain how a mere pile of videotapes can communicate using "any available method." The legal insufficiency of the description of the SML is plain.

(iv) SML receipt and processing of user requests

Although the specification describes, and the asserted claims cover, a SML that receives and processes user requests, the specification comes nowhere close to providing a legally sufficient written description of this capability. While the specification states that the "first step" of the claimed methods involves "retrieving" information from items in the source material library "upon a request by a user" (col. 18:53-56), and that "the present invention comprises a receiving system responsive to a *user input identifying a choice of an item stored in a source material library* to be played back to the subscriber . . . ." (col. 2:62-65 (emphasis added)), the only information provided about this capability in the specification is that it "is analogous to taking books off a shelf at the local public library after the person has decided that he or she would like to read them." (Col. 18:57-59). No mechanism is disclosed for the "analogous" automated retrieval of information from the SML based on a user request sent to the SML. The SML is described in the specification only as a "collection of items having information," such as books on a shelf. One cannot send electronic user requests to books on a shelf and, even if one could, the books have no way to process or comply with the requests. For these reasons, Acacia's reliance on a SML's ability to communicate "via any available method" (Opp'n at 34:23) is again misplaced.[27] Books on a shelf simply have no way to communicate.[28]

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[27] In addition, as explained above at note 26, the "any available method" excerpt from the specification relied on by Acacia refers to communication between two SMLs, not communication of a user request to a SML, and is therefore of no help to Acacia for this additional reason.

[28] The opinion of Acacia's expert that "[t]here also would have to be system operators involved to decide what content to make available through the system" (Weiss Decl. ¶ 62) does not fill the gap in the specification. The specification says that ***user*** requests dictate what items are retrieved from the source material library, not system operators. (Col. 2:62-66). In addition, as explained above, human system operators cannot form part of the transmission system.

(v) communication between multiple source material libraries

Finally, the allegedly "optional" embodiment of a source material library that communicates with other source material libraries is insufficiently described for the same reason all communications by a SML are insufficiently described – a mere "collection of original sources of information," such as a pile of videotapes or a shelf full of books, cannot communicate. That the specification says such SMLs can communicate "via any available method" (Opp'n at 34:10-17 (quoting col. 6:28-34; *see also* Weiss Decl. ¶ 63)) is therefore insufficient written description as a matter of law.

For all of these reasons, the specification does not contain an adequate written description of the SML component of the claimed "transmission system."[29]

2. The Specification Does Not Contain an Enabling Disclosure of a "Source Material Library" that Can Function in a "Transmission System"

To satisfy the enablement requirement, an enabling disclosure of the novel aspects of the invention must be contained within the four corners of the specification. One cannot rely on the purported ability of skilled artisans to build such novel components. *See supra* at Section IV(A). As explained in Defendants' motion papers (Mot. at 13:19-22, n.11), the "transmission system" ***is*** the Yurt invention. In addition, Acacia does not allege that a SML that could function in the disclosed transmission system was available as an off-the-shelf component in 1991, which means the SML itself is novel. Finally, as also explained in Defendants' motion papers (Mot. at 16:16-17:4), during prosecution the inventors relied specifically on their incorporation of the SML into the "transmission system" as a distinguishing feature over the prior art. For all of these reasons, the

[29] Mr. Weiss's conclusion that "it is evident that the inventors disclosed sufficient information about such subsystems that one of ordinary skill in the art of the patent would have recognized that they were in possession of that portion of the of the Transmission System in January, 1991" (Weiss Decl. ¶ 64) is of no use to Acacia. "Possession" is not the correct legal standard for compliance with the written description requirement (*see supra* at Section III(A)), and for that reason alone Mr. Weiss's opinions must be disregarded. *See supra* at Section V. In addition, his opinions are unsupported – he fails to cite to any supporting documents or other corroborating evidence in support of his opinions. The conclusory nature of his opinions also requires that the Court disregard them. *Id.*

inventors were required to provide an enabling disclosure of the SML in the specification. They did not. The specification describes the SML as only a "collection of original sources of information" which cannot, as the Court already found, perform the functions required of it as a component of the "transmission system." The SML of the claimed "transmission system" is therefore not enabled.

Acacia does not have much of a response. Mr. Weiss opines that the specification "provided sufficient information about the inputs, functions, and outputs of [the SML's] subsystems that they could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, ***by applying the processes of system design that were normal for the development of such technological objects***." (Weiss Decl. ¶ 64 (emphasis added).) This cannot defeat summary judgment. The enabling disclosure of a SML must be in the specification itself because the SML is a novel aspect of the novel "transmission system." Moreover, Mr. Weiss's unsupported conclusion would not create a genuine issue of material fact even if the SML was not a novel aspect of the invention. *See supra* at Section V.

B. "Identification Encoder 112" Is Neither Adequately Described Nor Enabled As A Matter Of Law

The Court has already ruled that "identification encoder" is indefinite. The basis for the Court's conclusion was that the specification does not describe what an identification encoder ***is*** – it describes only what an identification encoder is supposed to do. (*See* Mot. at 18:3-23.) That inescapable conclusion not only supports the Court's indefiniteness ruling, it states a black-letter law failure to comply with the written description requirement. *See supra* at Section III(A). In view of the fact that Acacia not only acknowledges that the Court found "identification encoder" to be indefinite but actually moved for summary judgment against itself on that ground (*see*, *e.g.*, Opp'n at 4 n.2), it is inexplicable how Acacia could argue that the specification nonetheless adequately describes the identification encoder. To be sure, that argument is wrong.

1. The Specification Does Not Contain an Adequate Written Description Of "Identification Encoder 112"

Because the Court already determined that the Yurt specification describes only what the "identification encoder" ***does***, not what it ***is***, the Court has in effect already determined that "identification encoder" lacks written description. Other Courts have likewise found claims to be both indefinite and insufficiently described on similar grounds. *See Harrah's*, 321 F. Supp. 2d at 1181 ("[T]he court agrees that the term theoretical win profile is indefinite" and "[a]ccordingly, the written description is inadequate as a matter of law"); *see also Amgen*, 314 F.3d at 1320, 1341-42 (invalidity for indefiniteness and lack of written description).

Acacia points to nothing in the specification that gives rise to a factual issue with respect to Defendants' written description motion. Instead, Acacia contends (Opp'n at 37:21-38:22) that because the specification described the functions the identification encoder is supposed to perform in the "original disclosure," the written description requirement must, by necessity, be satisfied. The law is to the contrary. As explained in Sections III(A) and (C) above, § 112 requires description of the "detailed identity"of what a component ***is***, not just what it ***does***, and the fact that an inadequate description appeared in the "original disclosure" does not excuse the failure to comply with the statute. Moreover, even if the functions performed by the identification encoder were somehow relevant, Acacia incorrectly identifies those functions as including receipt of "audio and/or video information from the items in the source material library." (Opp'n at 38:4-5.) In fact, as explained in Section VII(A) above, the input to the identification encoder is the physical item itself. Obviously, one cannot rely on a mis-description of the specification in order to demonstrate that the specification's disclosure is sufficient.

Mr. Weiss's opinions are also insufficient to defeat summary judgment. Putting aside the fact that Mr. Weiss has no answer for how "identification encoder" can possibly comply with the written description requirement in view of the Court's finding that the specification does not describe what an identification encoder ***is***, his declaration also suffers from the following fatal defects:

> (i) Mr. Weiss states that the specification demonstrates "that one of ordinary skill in the art of the patent would have recognized that [the inventors] were in possession of [the Identification Encoder] in January, 1991." (Weiss Decl. ¶ 68.) However, as explained in Section III(A) above, "possession" is not the correct legal standard for compliance with the written description requirement. Rather, the standard is whether a skilled artisan can "visualize or recognize" the "detailed identity" of the claimed subject matter based on the patent's disclosure. His opinion should be disregarded because he applied the wrong legal standard. *See supra* at Section V.

(ii) Mr. Weiss does not even opine on facts that are pertinent to the written description inquiry. For example, his opinion that "[t]he functions of the Identification Encoder ***are not very different*** from some of the functionality that existed at the time of the invention . . . ." (Weiss Decl. ¶ 66 (emphasis added)) is wholly irrelevant, even if accepted as true. Mr. Weiss does not say that any existing systems could perform any of the ***exact*** functions required of the identification encoder (much less ***all*** of those functions), nor does he does describe or identify any actual device that could serve as an identification encoder. Therefore, unsurprisingly, he does not opine that a skilled artisan reading the specification would know what an identification encoder ***is***; and

(iii) His opinions are completely unsupported. He fails to cite to any supporting documents or other corroborating evidence in support of his opinions. Such conclusory opinions are entitled to no weight. *See supra* at Section V.

2. The Specification Does Not Contain an Enabling Disclosure of "Identification Encoder 112"

The Court has already determined that "a person of ordinary skill in the art would understand from the written description and Fig. 2a that 'identification encoding process 112' is an essential component of 'transmission system 100.'" (6^{th} CCO at 9:2-4.) Therefore, the inventors were required to provide an enabling disclosure of the identification encoder in the specification, because it is a novel, essential aspect of the novel "transmission system." *See supra* at Section IV(A). They did not.

As this Court has already held, the inventors did not disclose any "circuit, a computer operating a software algorithm, or other apparatus which performs the functions designated for the 'identification encoder'" (2^{nd} CCO at 16:26-17:3), a conclusion neither Acacia nor Mr. Weiss disputes. Therefore, Mr. Weiss's opinion that the specification "provided sufficient information" to permit a skilled artisan to build an identification encoder "without undue experimentation, ***by applying the processes of system design that were normal for the development of such technological objects***" (Weiss Decl. ¶ 68 (emphasis added)) cannot defeat summary judgment, because an enabling disclosure in the specification itself was required. Moreover, for the reasons described in Section V above, because Mr. Weiss's opinion is conclusory and unsupported, it would be insufficient to create a genuine issue of material fact even if the identification encoder was not a novel aspect of the invention.

C. The "Converter 113" Is Neither Adequately Described Nor Enabled As A Matter Of Law

The specification says that "converter 113" performs some very ambitious functions. (*See* Mot. at 19:1-20:5.) For example, it can recognize all of the information formats that can be stored on the different types of physical items in the source material library and convert all those formats into the transmission system's single "predetermined format." (Col. 6:55-62). It also has an "analog input receiver 127" and a "digital input receiver 124" which can both receive integrated audio and video information and separate the two for processing by audio and video format converters. (Col. 6:62-7:34; Fig. 2a). There is no description, however, of the "detailed identity" of "converter 113" or its sub-components. The specification discloses only what these novel devices are supposed to do, which is not a legally sufficient written description. Nor, as a matter of law, does the specification enable the disclosed "converter 113," which Acacia and its expert actually admit.

1. The Specification Does Not Contain an Adequate Written Description of "Converter 113"

a. The Specification Does Not Disclose the Detailed Identity of "Converter 113"

As it does with the other components of the claimed "transmission system," Acacia asserts that "converter 113" is sufficiently described in the specification because the "original disclosure" listed the functions the converter was supposed to perform. (Opp'n at 40:1-24.) As explained in Sections III(A) and (C) above, this argument fails because written description requires disclosure of what a component ***is***, not just what it ***does***. The mere fact that an inadequate description appeared in the "original disclosure" does not excuse the failure to comply with § 112.

In addition, Acacia contends that the inventors were not required to describe a converter capable of performing the functions ascribed to "converter 113" in the specification, including: (1) accepting, and separating, audio and video information provided to the same input receiver; (2) distinguishing between various input formats; and (3) converting to the predetermined format (the "3 CONVERTER FUNCTIONS"). The reason for this, Acacia says, is "[t]here is no limitation in the Court's construction for 'transmission system' or in any asserted claim which requires any of these features." (Opp'n at 39:15-21.) Acacia is wrong for several reasons. First of all, the claims ***do*** require the converter to perform the 3 CONVERTER FUNCTIONS:

> (i) the function of converting to a "predetermined format" is expressly required, for example, by claim 41 of the '992 patent, which calls for "placing the retrieved information into a predetermined format";[30]
>
> (ii) the function of distinguishing audio from video is expressly required, for example, by claim 17 of the '863 patent, which requires that the "transmission system" process "audio/video information";[31]
>
> (iii) Acacia's expert Mr. Weiss concedes that the very "purpose of the Converter is to accept at its inputs the analog or digital signals . . . ***in whatever formats they might be***, and to output that data to [the predetermined format]." (Weiss Decl. ¶ 69 (emphasis added).) Because distinguishing between various input formats is the *raison d'etre* of the converter, this function too must be performed by the converters of the claimed "transmission system."

Therefore, the inventors were required to disclose the "detailed identity" of a converter that can perform the 3 CONVERTER FUNCTIONS.

Moreover, even if the claims did not expressly require the converter to perform these functions, the converter is defined in the specification only by its performance of these functions. Because the structures which make up converter 113 were not disclosed, one cannot determine from the specification what a converter is without considering the functions ascribed it in the specification. For this reason, too, the inventors were required to describe a converter that can actually perform the 3 CONVERTER FUNCTIONS.

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[30] Just as it did with respect to the "source material library," Acacia contradicts itself by asserting that the claims do not require the converter to perform the very functions that Acacia says are sufficient to demonstrate that the disclosure teaches how to make one. For example, although Acacia says the claims do not require the converter to convert to a "predetermined format," Acacia also identifies the function of "plac[ing] retrieved information into a predetermined format" as demonstrating that the inventors were "in possession" of the converter and would know how to make one (Opp'n at 40:15-17; 42:26-27.) Acacia cannot have it both ways, and the fact that it is forced to repeatedly contradict itself convincingly demonstrates how flawed its positions are.

[31] Claim 17 of the '863 patent requires, *inter alia*, "formatting items of audio/video information . . . at a central processing location." The Court construed the "central processing location" to mean the "transmission system." (4th CCO at 6:18-21.)

Finally, Acacia does not dispute that the asserted claims are broad enough to cover converters that perform the 3 CONVERTER FUNCTIONS. All else aside, this alone required the inventors to provide an adequate written description of a converter that can perform those functions, because the scope of the claims must be coextensive with the scope of the description of the invention in the specification. *See supra* at Section III(D).

For the reasons explained below, the inventors did not comply with their obligation to describe a converter capable of performing the 3 CONVERTER FUNCTIONS.

b. The Specification Does Not Adequately Describe a Converter that Can Perform Any of the 3 CONVERTER FUNCTIONS

Because the asserted claims require performance of the 3 CONVERTER FUNCTIONS and/or are broad enough to cover converters that perform those functions, the inventors had an obligation to disclose the "detailed identity" of a converter that can perform ***all*** of those functions. Converter 113 is not adequately described if ***even one*** of those functions is not adequately described. In fact, as explained in Defendants' motion papers (Mot. at 19:1-20:5), the inventors did not adequately describe a converter that can perform ***any*** of those functions. Acacia's opposition actually admits that the converter 113 depicted in Fig. 2a could not be built at all, meaning it could not possibly be adequately described in the specification.

(i) accepting and separating audio and video information provided to the same analog input receiver

Acacia admits that the specification does not adequately describe a converter that can perform this function, and that such a converter could not be built. For example, Acacia says that in order for the converter 113 to operate, it would require separate analog audio and video inputs: "[O]ne skilled in the art would have known that separate analog inputs for video and audio ***would have been necessary*** . . . ." (Opp'n at 40:27-41:1 (emphasis added).) This is truly a striking admission in view of the fact that the converter Acacia imagines, which has separate analog audio and video inputs, is ***not*** the converter identified in the specification, which has a ***single*** analog input for both video and audio and which then separates the analog audio from the analog video. (*See* Fig. 2a (showing single input to analog receiver 127 and the separate audio and video outputs from that receiver); col. 7:12-26).[32] Where, as here, only a device different than the one referenced in the specification could actually be made, there can be no adequate written description as a matter of law.[33] *See supra* at Sections III(A) and V.

Moreover, even if it was possible to follow the specification and provide analog audio and video to the same converter 113 interface, the specification does not describe the "detailed identity" of a converter that can (1) recognize whether the input signal is audio or video; or (2) separate the signal, as shown in Fig. 2a, into separate audio and video streams. Nor does the specification describe how those functions could be performed. Although Acacia contends that Mr. Weiss believes that "components capable of distinguishing between analog and digital signals or audio and video signals" were well known to skilled artisans in 1991 (Opp'n at 43:13-16 (citing Weiss Decl. ¶¶ 69, 75)), Mr. Weiss in fact never renders such an opinion, either in the cited paragraphs of his declaration or otherwise. He certainly does not identify any off-the-shelf components that could perform this function.[34]

(ii) distinguishing between various input formats

"The purpose of the Converter is to accept at its inputs the analog or digital signals carrying the information data retrieved from items stored in one or more Source Material Libraries, ***in whatever formats they might be***, and to output that data in whatever format was selected for input to the Compression subsystem . . . .” (Weiss Decl. ¶ 69 (emphasis added).) Formats within the scope of the asserted claims include VHS, Betamax, CD, cassette, player piano music rolls phonograph record, reel-to-reel tape and laser disc formats and formats for other media (a list of exemplary media formats the converter must be capable of handling is provided at col. 6:10-22). There is nothing in the specification, and Acacia points to nothing in the specification, that discloses the identity of a device that can distinguish between this myriad of potential formats so that each can be converted to the “predetermined format.” Indeed, Acacia tacitly admits that there is no device that can perform this function, and that a human being would have to do this: “[C]omponents used to handle the different media types were known and were designed to operate with the specific types of media; ***interaction with a system operator would still be necessary***.” (Opp’n at 41:27-42:2 (citing Weiss Decl. ¶ 61-62) (emphasis added).) However, a human cannot be a component of the “transmission system” (*see supra* at Section VII(A)), and even if one could, the specification does not describe a human as performing this function. Acacia’s reliance on (undisclosed) humans constitutes an admission that the specification does not contain an adequate written description of a converter that can perform this function.

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[32] Although Acacia might argue that an analog input receiver is not required if the source material library only stores physical objects containing digital information (col. 6:66-68), none of the asserted claims are limited to that converter embodiment. Because the claims are broad enough to cover converter embodiments having analog input receivers, the inventors were obligated to adequately describe such embodiments. *See supra* at Section III(D).

[33] Acacia's contention that the claims can cover what is inherently disclosed (Opp'n at 41:5-7) misses the point. Subject matter that is ***different from*** and ***contradicts*** what is actually disclosed is not inherently disclosed by virtue of the fact that what is actually disclosed would not work and could not be made.

[34] By stating that "[a]ll of the components necessary to construct the Converter . . . were readily available at the start of 1991" (Weiss Decl. ¶ 71), Mr. Weiss is admitting that such a converter was not available off-the-shelf. His statement is also not probative of anything, because all new devices are made from components that are known.

Although Acacia also relies on the specification’s discussion of a digital telecine (Opp’n at 41:10-19), as Defendants already explained in their motion papers (Mot. at 20 n.16), a telecine cannot recognize and distinguish between input signals in “whatever formats they might be.” The telecine can only work on motion picture film. Moreover, the telecine is described in the specification as operating *before* conversion by converter 113 begins, such that the output of the telecine is input to the “digital input receiver 124” of the “converter 113.” (Col. 7:37-39). Because the functions of the telecine are explicitly described in the specification as ***not*** being performed by converter 113, Acacia’s reliance on it is yet another example of how it contradicts the specification to manufacture a description that the inventors did not provide.

(iii) converting to a “predetermined format”

The specification does not describe the “detailed identity” of a device that can convert information in “whatever formats [it] might be” into a “predetermined format.” Therefore, even if

Acacia is correct that Fig. 8 is an example of the predetermined format (Opp'n at 44:1-5), such disclosure is not sufficient to enable one skilled in the art to "recognize" the detailed identity of the mechanism by which the converter translates a myriad of potential input formats into that predetermined format. Mr. Weiss does nothing more than repeat the converter's function (to translate the input format, "whatever formats they might be, and to output that data in whatever format was selected for input to the Compression subsystem" (Weiss Decl. ¶ 69)) and then simply conclude that one could be built. For the reasons described in Section IV(D) above, that conclusion is not pertinent to the written description inquiry.

The specification does not describe any hardware, software or software algorithms capable of determining the format of the input to the converter and, for each possible input format, converting it into the format of Fig. 8. The specification does not even describe hardware or software for converting *any single* type of input format into the format of Fig. 8. Neither Acacia nor Mr. Weiss disagrees. Accordingly, there is no written description of a converter that can perform the function of converting to a predetermined format.

2. The Specification Does Not Contain an Enabling Disclosure of "Converter 113"

To satisfy the enablement requirement, an enabling disclosure of the novel aspects of the invention must be contained within the four corners of the specification. One cannot rely on the purported ability of skilled artisans to build such novel components. *See supra* at Section IV(A). As explained in Defendants' motion papers (Mot. at 13:19-22 and n.11), the "transmission system" ***is*** the Yurt invention. In addition, Acacia does not allege that a converter that could function in the disclosed transmission system was available as an off-the-shelf component in 1991, which means the "converter 113" itself is novel. Finally, the converter is the component of the "transmission system" that converts information stored on physical items in the "source material library," in whatever format it may be, into a format that can be processed by the transmission system. As such, the converter is critical to the inventors' incorporation of a "source material library" into the transmission system. As discussed above (*see supra* at Section VII(A)(2)), the inventors relied on their incorporation of a "source material library" into the "transmission system" to distinguish prior art during prosecution. For all of these reasons, the inventors were required to provide an enabling disclosure of the "converter 113" in the specification itself because it is a novel aspect of the invention. They did not.

Mr. Weiss opines that the specification "provided sufficient information about the inputs, functions, and outputs of [the converter's] subsystems that they could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, ***by applying the processes of system design that were normal for the development of such technological objects***." (Weiss Decl. ¶ 75 (emphasis added).) This cannot defeat summary judgment. The enabling disclosure of "converter 113" must be in the specification itself because that converter is a novel aspect of the novel "transmission system." Moreover, Mr. Weiss's unsupported conclusion would not create a genuine issue of material fact even if the "converter 113" was not a novel aspect of the invention. *See supra* at Section V.

D. The "Time Encoder 114" Is Neither Adequately Described Nor Enabled As A Matter Of Law

The specification does not disclose the "detailed identity" of "time encoder 114" or of any other device capable of performing the functions ascribed to the time encoder in the specification. (*See* Mot. at 20:6-22:18.) In past testimony, Acacia's expert Mr. Weiss asserted that the time encoder was the one component of the Fig. 2 "transmission system" that could have been obtained off-the-shelf in 1991. It is, he previously said, a device that was known as a "time code generator." (Benyacar Decl. Ex. F, docket no. 293-7, at 86:1-10.)

As Defendants explained in their motion papers, however, an off-the-shelf time code generator could not perform the functions ascribed to the "time encoder" in the specification. For example, a "time code generator" could not assign time codes to raw data passing through electronic components of a transmission system as is required of "time encoder 114." Rather, it applied time codes only to physical objects such as videotapes. (*See* Mot. at 20 n.17.) Nor could a "time code generator" create a "group of addressable data blocks" like time encoder 114 does. (*See id.* at 21:18-

22:15.) Mr. Weiss does not disagree. In his declaration in support of Acacia's opposition, he no longer takes the position that "time encoder 114" was an off-the-shelf device.

"Time encoder 114," then, is just another component described only by reference to the wish-list of functions the inventors wanted it to perform. That does not satisfy either the written description or enablement requirements.

1. The Specification Does Not Contain an Adequate Written Description of "Time Encoder 114"

Acacia starts, as it does with other components of the "transmission system," with the assertion that "time encoder 114" is sufficiently described in the specification because the "original disclosure" listed the functions the time encoder is supposed to perform. (Opp'n at 44:8-25.) As explained in Sections III(A) and (C) above, this argument fails because written description requires disclosure of what a component ***is***, not just what it ***does***. The mere fact that an inadequate description appeared in the "original disclosure" does not excuse the failure to comply with § 112.

Neither Acacia nor Mr. Weiss alleges that the specification describes the "detailed identity" of a device that will perform the functions associated with the "time encoder 114," and, as described above, they have both abandoned their position that a "time encoder" was an off-the-shelf "time code generator." Instead, Mr. Weiss now says there were known "***methods***" for incorporating time codes "into data structures of video and audio content . . . ." (Weiss Decl. ¶ 78.) Note, however, he does not say there was a ***device*** in existence that could actually do this, nor can he provide any corroborating documentation. In an effort to create the illusion that there might be a factual issue, Mr. Weiss carefully chooses his words to give the impression that equipment that could function as a "time encoder" *could have possibly* existed; for example, he opines that those skilled in the art could "adapt the existing time encoding methods and to construct an appropriate time encoder ***if*** off the shelf hardware then available were not exactly what was required . . . ." (*Id.* at ¶ 79 (emphasis added).) However, he never says such equipment did exist, and never identifies an actual off the shelf device that could be used as the "time encoder" of the disclosed "transmission system." His opinion is therefore legally insufficient to raise a factual question with respect to Defendants' motion that "time encoder 114" is not adequately described.

Defendants also described in their motion papers that the specification does not disclose how time codes are associated, for example, with frames of video. (Mot. at 21:14-15.) Acacia responds only with the irrelevant observation that the asserted claims are not limited to any particular way to do that association. (Opp'n at 44:26-45:5.) This is not an infringement analysis; it is a written description analysis. Section 112 required the inventors to provide a sufficient description of a time encoder that can perform the functions ascribed to it in the specification, including how the device associates time codes to frames of video, even if claims are not limited to that device or that association technique. *Rochester*, 358 F.3d at 923, 927 (goal of finding a COX-2 selective inhibitor insufficient disclosure; patent needed to disclose actual compound that performed this function); *Enzo*, 323 F.3d at 968.

Finally, as described in Defendants' motion papers, the "time encoder 114" generates a "group of addressable data blocks," which Mr. Weiss admits requires more than time encoding. (Mot. at 21:18-22:15; col. 7:66-8:1.) The specification, however, does not say how or why these groups are formed, or what the characteristics are of data blocks that are in the same group. Nor does the specification describe the "detailed identity" of a device that can perform this ambiguous group creation function.

Acacia responds that creation of a group of addressable data blocks is not a limitation of the asserted claims (Opp'n at 45:16-18), but as discussed extensively above, that is irrelevant. "Time encoder" is a coined term that the inventors (improperly) attempted to define only by reference to what it does, not by what it is. That definition must therefore carry over into the claims if the claims are to have any meaning at all. Moreover, Acacia does not dispute that time encoders that create such groups are within the scope of the asserted claims. Because § 112 requires the scope of the written description to be coextensive with the scope of the claims (*see supra* at Section III(D)), that alone required the inventors to adequately describe this function and the detailed identity of a device capable of performing it. They did not.

Acacia also responds that the specification's bare statement that a group of addressable data blocks is created constitutes its own written description. (Opp'n at 45:20-23.) That is nonsense. Not only would one not know from that disclosure what a time encoder that can create such groups ***is***, in this instance, no one would know even what a time encoder is supposed to do. How should the groups be created? What constitutes a group? How are the groupings to be used? The specification provides no answers.[35]

For all of these reasons, the specification does not provide an adequate written description of "time encoder 114."

2. The Specification Does Not Contain an Enabling Disclosure of "Time Encoder 114"

The "time encoder 114" is a component of the claimed "transmission system," which ***is*** the Yurt invention. In addition, because a time encoder that could function in a "transmission system" was not available off-the-shelf in 1991, "time encoder 114" itself is novel. For both these reasons, the inventors were required to provide an enabling disclosure of the "time encoder 114" in the specification itself because it is a novel aspect of the invention. *See supra* at Section IV(A). They did not.

Mr. Weiss opines that the specification "provided sufficient information about the inputs, functions, and outputs of [the time encoder's] subsystems that they could have been built and used by one of ordinary skill in the art, at the start of 1991, without undue experimentation, ***by applying the processes of system design that were normal for the development of such technological objects.***" (Weiss Decl. ¶ 80 (emphasis added).) This cannot defeat summary judgment. The enabling disclosure of time encoder 114 must be in the specification itself because it is a novel aspect of the novel “transmission system.” Moreover, Mr. Weiss’s unsupported conclusion would not create a genuine issue of material fact even if the “time encoder 114" was not a novel aspect of the intention. *See supra* at Section V.

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[35] Acacia also cites the Weiss declaration for the proposition that "one of ordinary skill in the art, reading the specification, would have understood how the 'time encoder' can create a 'group' of addressable data blocks." (Opp'n at 45:19-20 (citing Weiss Decl. ¶ 79).) To the contrary, Mr. Weiss said no such thing, and has testified that something more than time encoding is required to create these groups. (*See* Mot. at 21:18-22:9.) Even if such a conclusory opinion were given, however, it is just as ambiguous as the specification as to what constitutes a "group" and would be meaningless.

It would not have been possible for Mr. Weiss to give anything other than a conclusory opinion. Because the specification does not disclose what the time encoder is supposed to do, building one is an intractable problem. For example, a system developer would not know what exactly it is that constitutes a group. Or how groups are created. Or how groups are used. Or what the characteristics are of data blocks that are part of the same group. The specification does not answer any of these questions, so it is simply not possible to know how to build a time encoder to do these things.

E. The “Precompression Processor 115” And “Compressor 116” Are Neither Adequately Described Nor Enabled As A Matter Of Law

As the inventors’ paid experts at the Sarnoff Institute (“Sarnoff”) candidly told them, compression was a “key enabling technology” with respect to which their specification “is relatively weak.” (*See* Mot. at 22:19-23:16.) For example, the specification discloses nothing about what the “precompression processor 115” ***is***, and no party contends it was available off-the-shelf in 1991. It is another component the inventors improperly tried to define only by reference to a wish-list of functions, and it is therefore neither adequately described nor enabled.

While generic compressors *were* available off the shelf in 1991, there is no dispute that those could not function as “compressor 116.” Acacia’s expert Mr. Weiss agrees with the inventors’ experts at Sarnoff that compressors capable of compressing for broadcast were not available in 1991, and further admits that, at best, the specification provides information “that ***could*** lead to embodiments” of “compressor 116.” (Weiss Decl. ¶ 93 (emphasis added).) Such description does not comply with either the written description or enablement requirements. Although Mr. Weiss asserts that a *different*, undisclosed compressor was available in 1991, the availability of *different* components than those that are part of the invention does not satisfy § 112.

Acacia's principal response with respect to both the "precompression processor 115" and "compressor 116" is that a list of the functions those devices are supposed to perform appears in the "original disclosure." (Opp'n at 47:1-48:11; 48:21-26.) As explained in Sections III(A) and (C) above, this argument fails because written description requires disclosure of what a component ***is***, not just what it ***does***. The mere fact that an inadequate description appeared in the "original disclosure" does not excuse the failure to comply with § 112.

For this and the other reasons set forth below, neither component of the claimed "transmission system" is adequately described or enabled.

1. The Specification Does Not Contain an Adequate Written Description of "Precompression Processor 115"

Acacia says the inventors were not required to disclose a device capable of performing the functions ascribed to "precompression processor 115 " because "nothing in the claims or the Court's construction for 'transmission system' places any limitation on 'how' the precompression processor performs its function (*i.e.*, the specific structure or circuitry)." (Opp'n at 48:12-20.) For the reasons already explained many times above, that is legally irrelevant. Section 112 required the inventors to describe the "detailed identity" of a device capable of performing the functions ascribed to "precompression processor 115" in the specification, even if the claims are not limited to that particular device. *Rochester*, 358 F.3d at 923, 927; *Enzo*, 323 F.3d at 968. One cannot claim a time machine without describing the structure of a time machine simply because the claims are not limited to any particular time machine structure or method of operation.

Mr. Weiss's unsupported opinions are similarly of no help to Acacia. Even assuming all of the uncorroborated facts recited by Mr. Weiss are true, they are irrelevant. Mr. Weiss admits that there were no off-the-shelf devices that could function as the "precompression processor 115." Instead, he says, one of ordinary skill in the art would have been aware of the "equipment and components available in the marketplace . . . that would enable implementation of both the Audio Precompression Processor and the Video Precompression Processor, that is, the Precompression

Processor in its entirety." (Weiss Decl ¶ 88.)[36] This is probative of nothing, because every novel device is made from available components. Moreover, the assertion that the claimed invention could be made is pertinent only to the enablement inquiry, not the written description inquiry. Mr. Weiss never opines that one skilled in art would know the "detailed identity" of the "precompression processor 115", and he certainly does not set forth that "detailed identity" in his declaration. For all these reasons, Mr. Weiss's testimony does not create a genuine issue of material fact with respect to the specification's failure to adequately describe "precompression processor 115" – that is, its failure to describe the "detailed identity" of what the precompression processor ***is***.

Acacia seems to recognize these defects with Mr. Weiss's declaration, as evidenced by the fact that it relies on the declaration only for the proposition that the specification demonstrates that the inventors were "in possession" of the invention. (Opp'n at 48:21-24.) Even that is of no help to Acacia, because that is not the legal standard for compliance with the written description requirement. *See supra* at Section III(A).

2. The Specification Does Not Contain an Enabling Disclosure of "Precompression Processor 115"

The "precompression processor 115" is a component of the claimed "transmission system," which ***is*** the Yurt invention. In addition, because such a precompression processor was not available off-the-shelf in 1991, the "precompression processor 115" itself is novel. For both these reasons, the inventors were required to provide an enabling disclosure of the "precompression processor 115" in the specification itself because it is a novel aspect of the invention. *See supra* at Section IV(A). They did not.

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[36] Mr. Weiss does not even identify the equipment or components that could be put together to form the precompression processor. Instead, he simply identifies a carefully selected subset of the functions ascribed to the precompression processor and asserts that, for each, there was a device that could have performed that "sort of function" in isolation. (Weiss Decl. ¶¶ 83-84, 86-87.) Among the precompression processor functions Mr. Weiss ignores is "block[ing] the audio data into frames." (Opp'n at 47:22; col. 9:37-40.) For example, Mr. Weiss does not explain why the precompression processor is creating frames when he testified that the data is already in frames when it enters the time encoder. (Weiss Decl. ¶ 76 ("[The time encoder] affixes to the frames of video and audio data that traverse it values representing time that individually identify each frame . . . .").) Nor does he allege that there were any off-the-shelf devices that could perform the ambiguous function of "blocking . . . into frames."

Mr. Weiss opines that the specification "provided sufficient information about the inputs, functions, and outputs of [the precompression processor's] subsystems that they could have been built and used by one of ordinary skill in the art, at the start of 1991, without undue experimentation, ***by applying the processes of system design that were normal for the development of such technological objects***." (Weiss Decl. ¶ 89 (emphasis added).) This cannot defeat summary judgment. The enabling disclosure of "precompression processor 115" must be in the specification itself because it is a novel aspect of the novel "transmission system." Moreover, Mr. Weiss's unsupported conclusion would not create a genuine issue of material fact even if the precompression processor was not a novel aspect of the invention.

3. The Specification Does Not Contain an Adequate Written Description of "Compressor 116"

In 1992, the inventors retained experts at Sarnoff to provide an objective opinion about their specification. Among Sarnoff's conclusions: compression is a "key ***enabling*** technology" for video-on-demand systems, with respect to which the Yurt specification is "relatively weak." (*See* Mot. at 22:19-23:16 (emphasis added).) Sarnoff issued the blunt verdict that "[f]or both audio and video, a concrete video-on-demand system architecture ***must*** identify [compression] algorithms and associated bit-rate/performance choices more clearly than has been done here." (*Id*. (emphasis added).) Acacia's litigation expert, Mr. Weiss, previously testified in general accordance with the Sarnoff Report, stating that "[t]here were at that time [i.e. the filing date] compression systems that were not quite at the level that, that you would ***need for broadcast***." (*Id*. (emphasis added).) Thus, there was unanimous agreement among both the inventors' and Acacia's experts that compressors that could function as "compressor 116" of the claimed "transmission system" were not available in 1991, and that the Yurt specification did not describe one. As a matter of law, then, "compressor 116" is not adequately described or enabled.

Acacia's response is that the claims do not require that "compressor 116" be a compressor at the level that "you would need for broadcast." (Opp'n at 48:27-49:15.) In other words, even though the specification discloses delivery of requested information using satellite broadcasting (col. 4:61-63, 17:12-13), even though Acacia believes the claims are broad enough to cover broadcast transmissions (the major satellite television broadcasters are defendants in this action), and even though the "compressor 116" is described in the specification as being a compressor for broadcast, Acacia argues that the inventors were not required to disclose such a compressor because the claims do not expressly require one. Instead, Acacia says, there were known compressors that compressed at "VHS quality," and those types of compressors could have been used in the "transmission system." (Opp'n at 49:9-12.) The problem with this argument is that it both squarely contradicts the specification and ignores the requirement that the scope of the claims be coextensive with the scope of the description of the invention.

According to the specification, the "compressor 116" employs the compression processes described in an article by Artieri and Colavin (the "Artieri article"). (Col. 10:7-16). Consistent with the specification's repeated disclosure of broadcast transmission of requested information, the Artieri article is directed to compression suitable for television broadcast, repeatedly referring to compression for "TV Transmission," "Cable TV" and "HDTV." (Weiss Decl. Ex. D at 395, 400, 402.) Thus, the "compressor 116," which the specification says performs the Artieri processes, performs broadcast-compression. Acacia itself agrees. That is why, for example, Acacia relies on Mr. Weiss's statement that "compressor 116" could have been built without undue experimentation as support for its assertion that a *broadcast-quality compressor* could have been built. (Opp'n at 50:24-51:5.)

As Mr. Weiss admits, however, there were no compressors at the time of Yurt's filing that could actually carry out the processes set forth in the Artieri article. As Mr. Weiss says, the specification's disclosure provided only the hope that the disclosed embodiment "could" be developed:

> [C]ommercial products for video compression at a so-called "broadcast quality" level were not yet available off the shelf in January, 1991 [but] the patent provided information on techniques[37] ***that could lead to embodiments*** that not only produced broadcast quality signals but that could produce signals for the next generation of broadcast quality – HDTV . . . .

(Weiss Decl. ¶ 93 (emphasis added).) Providing only information "that ***could*** lead to embodiments" of the claimed device is not a legally sufficient written description. Rather, the specification must teach what that device ***is***, not just provide hope that someday someone will be able to make it. Even if true, Acacia's allegation that something ***different*** than what is disclosed in the specification was available at the time of Yurt's filing – *i.e.*, something that was not the compressor 116, that could not compress information for broadcast and that did not employ the processes of the Artieri article – does not as a matter of law satisfy § 112.

Moreover, claims are presumed to cover the "preferred embodiment." *See Primos Inc. v. Hunter's Specialties Inc.*, 451 F.3d 841, 848 (Fed. Cir. 2006) ("[W]e . . . should not normally interpret a claim term to exclude a preferred embodiment."); *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996) (stating that a construction that excludes the preferred embodiment "is rarely, if ever correct and would require highly persuasive evidentiary support"). The preferred and only embodiment disclosed of compressor 116 is a compressor that performs the Artieri processes and that compresses in a manner suitable for broadcast. Such a broadcast-compressor is therefore covered by the claims. Indeed, Acacia must believe broadcast-compression to be within the scope of the asserted claims, because it sued the major satellite television broadcasters. Because, as explained in Section III(D) above, the scope of the written description must be coextensive with the scope of the claims, the inventors were obligated to describe the "detailed identity" of a compressor that compresses in a manner suitable for broadcast. They did not, because neither the inventors nor the industry knew how to make such a compressor in 1991.

For all of these reasons, Acacia's opposition does not create a genuine issue of material fact regarding the inventors' failure to adequately describe compressor 116.

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[37] The "techniques" to which Mr. Weiss refers are those set forth in the Artieri article. (Opp'n at 49:16-24.)

4. The Specification Does Not Contain an Enabling Disclosure of "Compressor 116"

As the inventors' experts at Sarnoff told them, compression was a "key ***enabling*** technology" about which the specification provides insufficient detail. Mr. Weiss admits that the compression technique the industry ultimately developed for broadcast, called "MPEG," was not available in 1991. (*See* Mot. at 23 n.20.) In fact, as reported by Sarnoff, even by April of 1992, over a year after Yurt's filing, MPEG was still only in its experimental stages. (*Id.* at 23:10-16, n.20.) Thus, all of the evidence contradicts Mr. Weiss's opinion that the broadcast-compressor 116 could have been built without undue experimentation (Opp'n at 50:24-51:5 (citing Weiss Decl. ¶ 94)), an opinion that must be disregarded in any event because it is conclusory and unsupported. *See supra* at Section V.

Even if such a compressor could have been built without undue experimentation, however, § 112 requires that the enabling disclosure be in the specification itself. The "compressor 116" is a component of the claimed "transmission system," which ***is*** the Yurt invention. In addition, there is no dispute that such broadcast-compressors were not available off-the-shelf in 1991, which means "compressor 116" is itself novel. For both of these reasons, the inventors were required to provide an enabling disclosure of the compressor in the specification itself. *See supra* at Section IV(A). They did not. As Mr. Weiss himself says, the specification only describes techniques "that ***could*** lead to embodiments" of the compressor. (Weiss Decl. ¶ 93 (emphasis added).)

F. The "Compressed Data Formatting Section 117" Is Neither Adequately Described Nor Enabled As A Matter Of Law

As Defendants explained in their motion papers, not only is the "compressed data formatting section 117" not adequately described or enabled, the specification's description of even what it is supposed to do is hopelessly ambiguous. (Mot. at 24:1-25:11.) Acacia's response is predicated almost entirely on misrepresentations of the Court's prior claim construction orders and misstatements and misapplications of written description law.

1. The Specification Does Not Contain an Adequate Written Description of "Compressed Data Formatting Section 117"

First, Acacia contends (Opp'n at 51:8-24, 52:21-25) that the Court already determined that the "compressed data formatter 117" is adequately described because the Court identified that component as the structure corresponding to the '992 claim 1 "compressed data storing means" pursuant to 35 U.S.C. § 112 ¶ 6. It is difficult to fathom how Acacia can say this in view of the fact that the Court expressly said it was ***not*** making that determination: "The Court ***does not address*** in this Order whether the specification of the '992 patent discloses sufficient structure for any term, in particular the 'compressed data formatter.'" (1st CCO at 23 n.18 (emphasis added).) Just because a means-plus-function claim element corresponds to a structure referred to in the specification does not automatically mean that structure is adequately described or enabled. *See In re Donaldson Co.*, 16 F.3d 1189, 1195 (Fed. Cir. 1994) ("We agree with the general principle . . . that the sixth paragraph of section 112 does not exempt an applicant from the requirements of the first two paragraphs of that section. . . . Therefore, if one employs means-plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language."); *In re Knowlton*, 481 F.2d 1357, 1366 (C.C.P.A. 1973) (finding that while § 112, P6 states that a means-plus-function claim "'shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof' . . . it cannot be read as creating an exception . . . to the description requirement of the first paragraph."); Manual of Patent Examining Procedure (8th ed. rev. July 2008) § 2181 ("[T]he invocation of 35 U.S.C. 112, sixth paragraph, does not exempt an applicant from compliance with 35 U.S.C. 112, first and second paragraphs.")

Next, Acacia says that because the "original disclosure" contained a list of the functions that the "compressed data formatter 117" is supposed to perform, the specification must by necessity comply with the written description requirement. (Opp'n at 51:25-52:20.) As explained in Sections III(A) and (C) above, this argument fails because written description requires disclosure of what a component ***is***, not just what it ***does***. The mere fact that an inadequate description appeared in the "original disclosure" does not excuse the failure to comply with § 112. Acacia does not and cannot dispute the allegation in Defendants' motion papers that "nothing in the specification discloses what apparatus and/or software can carry out" the functions of the compressed data formatter. (Mot. at 24:15-18).

Even if, contrary to law, a list of the functions the compressed data formatter is supposed to perform did constitute an adequate written description, the Yurt patents would still not comply with § 112 because they do not even clearly describe what the data formatter is supposed to do. For example, although the specification says this component performs various kinds of "formatting," "processing" and "forming" functions, the specification does not describe what these functions consist of, much less how to carry out such undefined functions. (Mot. at 24:3-18.) Acacia has absolutely no explanation for these ambiguities in the specification, and responds only that because the Court decided that the compressed data formatter corresponds to the claimed "compressed data storing means," it must of necessity be adequately described. (Opp'n at 52:21-25.) That being Acacia's best response probably says all that needs to be said about the adequacy of the specification's description of the compressed data formatter.

While the specification also says that the compressed data formatter determines whether the format of received material is compatible or incompatible with the compressed data library, it gives no clue as to how this is accomplished or, more, fundamentally what constitutes "compatibility." (Mot. at 24:26-26:2.) Acacia's first response – that this feature relates only to the "optional" capability of "inter-library transfers" and thus need not be described (Opp'n at 53:1-15) – is unavailing for several reasons. First, the specification does ***not*** say that ability to handle information received via inter-library transfer is an optional capability of the compressed data formatter. It is only the ***use*** of that capability of the compressed data formatter that is optional. The capability must be there in the event an inter-library transfer is received. Moreover, even if this capability had been described as optional, the "detailed identity" of a compressed data formatter embodiment capable of performing that function would still have to be described in the specification because the asserted claims are broad enough to cover that embodiment. *See supra* at Section III(D).

Acacia also says that if the inventors were required to disclose a compressed data formatter capable of determining whether the format of received material is compatible or incompatible with the compressed data library, the inventors did provide such disclosure. According to Acacia, the compressed data formatter's undisclosed and undescribed software "would have been capable of recognizing whether data from inter-library transfers is compatible with the data format and structure in use on the local system and converting it to the appropriate format if it is not already compatible . . . ." (Opp'n at 53:11-5 (quoting Weiss Decl. ¶ 97).) In other words, the specification says the compressed data formatter performs these functions, so it must have software capable of performing them. This is just a reformulation of Acacia's misconceived argument that the compressed data formatter is adequately described because the specification lists functions it is supposed to perform. Neither Acacia nor Mr. Weiss explain ***how*** the compressed data formatter determines whether the format of received material is compatible or incompatible with the compressed data library, or even what constitutes "compatibility," and neither they nor the specification set forth the "detailed identity" of a device that can perform these functions.

Finally, the specification is facially ambiguous as to whether the data formatter reformats retrieved items or item database records. (Mot. at 25:3-7.) Acacia says this ambiguity is resolved by the fact that those skilled in the art would understand it is the item database records that are reformatted. (Opp'n at 53:16-26.) However, neither Acacia nor Mr. Weiss can answer the corresponding question Defendants asked in their motion papers: If that is the case, "what if anything does block 117 do to the 'retrieved items' themselves"? (Mot. at 25:5-7.) There is simply no way to know.[38]

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[38] Acacia also argues, as it did with respect to the function of determining whether received material is compatible or incompatible with the compressed data library, that an adequate description of a compressed data formatter that can reformat was not required because it relates only to "optional" inter-library transfers. (Opp'n at 53:19-20.) Acacia is wrong for the same reasons detailed above. This capability of a compressed data formatter is not described as optional in the specification; it is only the use of the capability that is optional. Moreover, even if this had been described as an optional compressed data formatter embodiment, that embodiment would still be covered by the claims, which

(continued...)

2. The Specification Does Not Contain an Enabling Disclosure of "Compressed Data Formatting Section 117"

The "compressed data formatter 117" is a component of the claimed "transmission system," which ***is*** the Yurt invention. In addition, because such a compressed data formatter was not available off-the-shelf in 1991, the "compressed data formatter 117" itself is novel. For both these reasons, the inventors were required to provide an enabling disclosure of the "compressed data formatter 117" in the specification itself because it is a novel aspect of the invention. *See supra* at Section IV(A). They did not.

Mr. Weiss opines that the specification "provided sufficient information about the inputs, functions, and outputs of [the compressed data formatter's] subsystems that they could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, ***by applying the processes of system design that were normal for the development of such technological objects***." (Weiss Decl. ¶ 98 (emphasis added).) This cannot defeat summary judgment. The enabling disclosure of "compressed data formatter 117" must be in the specification itself because it is a novel aspect of the novel "transmission system." Moreover, Mr. Weiss's unsupported conclusion would not create a genuine issue of material fact even if the compressed data formatter was not a novel aspect of the invention.

It would not have been possible for Mr. Weiss to give anything other than a conclusory opinion. Because the specification does not disclose what the compressed data formatter is supposed to do, building one is an intractable problem. What "formatting," "processing" and "forming" functions does it perform? How does it determine whether the format of received material is compatible or incompatible with the compressed data library? What constitutes "compatibility"? What does it do with the "retrieved items"? The specification does not answer any of these questions, so it is not possible to know how to build a "compressed data formatter" to perform these functions.

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[38] (...continued)
alone required that it be adequately described.

G. The "Compressed Data Library 118" Is Neither Adequately Described Nor Enabled As A Matter Of Law

As explained in Defendants' motion papers, the "compressed data library 118" is described in the specification as being much more than a simple computer memory. (Mot. at 25:12-26.) It is preferably "a network of mass storage devices connected together via a high speed network" (col. 10:39-42) that is capable of "dynamically moving" information from one type of storage media to another based on how frequently users access the information. (Col. 12:35-57). Because the specification does not adequately describe a device with the intelligence and agility to perform such "dynamic movement," the compressed data library was neither adequately described nor enabled.

1. The Specification Does Not Contain an Adequate Written Description of "Compressed Data Library 118"

Neither Acacia nor Mr. Weiss dispute the fact that the specification does not adequately describe a device that is capable of performing the "dynamic movement" function, nor do they allege that such devices were known in the art.[39] Instead, Acacia provides a number of reasons why it believes the inventors were not obligated to adequately describe such a compressed data library. First, of course, is its old standby argument, *i.e.*, the list of the functions the "compressed data library 118" is supposed to perform as set forth in the "original disclosure" is allegedly a sufficient written description. (Opp'n at 55:1-22, 56:19-22, 57:8-9.) This argument fails for all the reasons already explained above. Written description requires disclosure of what a component ***is***, not just what it ***does***, and the fact that an inadequate description appeared in the "original disclosure" does not excuse the failure to comply with § 112.

Next, Acacia says that an adequate description of the dynamic movement function was not required because it is optional. (Opp'n at 56:2-13.) Because the compressed data library dynamically moves information from one media type to another based on the popularity code, Acacia's logic goes, and because users of the transmission system are not required to assign popularity codes, no description of a compressed data library that can "dynamically move" information was required. Acacia is wrong for at least two reasons. First, the specification does ***not*** say that the capability of accommodating popularity codes is optional. It is only the ***use*** of popularity codes that is optional. Because users of the transmission system have the option to assign popularity codes, the compressed data library ***must*** have the ability to accommodate them in the event that the user of the transmission system decides to use them.

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[39] The fact that "[e]xamples are given in the patent specification of the types of devices that could be used for both high popularity and low popularity content items" (Weiss Decl. ¶ 101) is irrelevant. A compressed data library must be capable of "dynamically moving" information between these different types of "devices." The specification does not describe the "detailed identity" of a "compressed data library" or of any other device capable of performing such dynamic movement.

Second, even if "dynamically moving" was described in the specification as an optional capability of the compressed data library, all of the asserted claims are broad enough to cover compressed data library embodiments that have that capability. Therefore, because the scope of the written description must be coextensive with the scope of the claims, the specification would still have to contain an adequate written description of a compressed data library that can perform the "dynamically moving" function. *See supra* at Section III(D).[40]

Finally, with respect to Defendants' observation that there is no hardware or software disclosed for storing, controlling, tracking, locating, and retrieving data that is stored on the multiplicity of different storage devices which make up the compressed data library (Mot. at 26:3-9), Acacia responds that it is the "library system control computer" of the transmission system, rather than the compressed data library, that performs those functions. (Opp'n at 57:2-8; Weiss Decl. ¶ 100.) Even if true, it is of no use to Acacia, because the specification does not describe hardware or software capable of performing these functions in connection with the library system control computer either.

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[40] Defendants do not understand what Acacia means when it says that the compressed data library only "allows" dynamic movement of information from one type of storage device to another, but that it does not require it. (Opp'n at 56:14-19.) If the compressed data library "allows" such dynamic movement, it must be a structure capable of performing that function. Because the specification does not describe the "detailed identity" of a device that "allows" such dynamic movement, the specification does not adequately describe the compressed data library.

2. The Specification Does Not Contain an Enabling Disclosure of "Compressed Data Library 118"

The "compressed data library 118" is a component of the claimed "transmission system," which ***is*** the Yurt invention. In addition, because a compressed data library capable of performing the functions of "compressed data library 118" was not available off-the-shelf in 1991, the "compressed data library 118" itself is novel. For both these reasons, the inventors were required to provide an enabling disclosure of the "compressed data library 118" in the specification itself because it is a novel aspect of the invention. *See supra* at Section IV(A). They did not.

Mr. Weiss opines that the specification "provided sufficient information about the inputs, functions, and outputs of [the compressed data library's] subsystems that they could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, ***by applying the processes of system design that were normal for the development of such technological objects***." (Weiss Decl. ¶ 102 (emphasis added).) This cannot defeat summary judgment. The enabling disclosure of "compressed data library 118" must be in the specification itself because it is a novel aspect of the novel "transmission system." Moreover Mr. Weiss's unsupported conclusion would not create a genuine issue of material fact even if the compressed data library was not a novel aspect of the invention.

Finally, although Acacia says that allegedly optional embodiments of the compressed data library need not be enabled (Opp'n at 58:3-7, 58:12-15), for the reasons discussed above, the "dynamically moving" and associated capabilities are not optional. Again, however, even if they were, that is of no help to Acacia because the claims are broad enough to cover compressed data libraries that can perform these functions, and the scope of the enablement must be commensurate with the scope of the claims. *See supra* at Section III(D).

H. The "Transmission Format Conversion CPUs 119" Are Neither Adequately Described Nor Enabled As A Matter Of Law

The specification says the "transmission format conversion CPUs 119" ("TFCCs") perform three functions: (a) "receives the [user transmission] request"; (b) "retrieves the composite formatted data block of the requested item stored in compressed data library 118"; and (c) "converts the compressed formatted data block into a format suitable for transmission." (Col. 13:40-45). As described in Defendants' motion papers (Mot. at 26:20-27:5), the specification does not describe the "detailed identity" of a device that can perform these functions. Acacia does not disagree with that, nor does it allege that such devices were known in the art. Instead, it again offers inadequate excuses for why the inventors were not required to comply with the written description and enablement requirements.

1. The Specification Does Not Contain an Adequate Written Description of "Transmission Format Conversion CPUs 119"

Acacia says that the inventors were not required to adequately describe TFCCs capable of performing the above-identified functions, or any other functions for that matter, because the claims themselves do not require that the TFCCs perform any functions. (Opp'n at 59:3-17.) What Acacia ignores, however, is that "transmission format conversion CPUs" is a coined term that the inventors (improperly) attempted to define only by reference to what they do, not by what they are. Because the structures of the TFCCs were not disclosed, that definition must carry over into the claims if the claims are to have any meaning at all. Indeed, because these are the only three functions ascribed to the TFCCs in the specification, a TFCC that cannot perform any of them would not be capable of doing anything at all, and could not be called a TFCC any more than a rock, a stick or other non-functioning object.

Moreover, Acacia does not dispute that TFCCs that perform the three above-identified functions are within the scope of the asserted claims. Because § 112 requires the scope of the written description to be coextensive with the scope of the claims (*see supra* at Section III(D)), that alone required the inventors to adequately describe these functions and the detailed identity of devices which can perform them.

In fact, Acacia's argument that TFCCs need not be capable of doing anything for purposes of the asserted claims is so nonsensical that even Acacia was forced to contradict it. With respect to its now familiar (and legally erroneous) argument that each component of the transmission system must, by necessity, be adequately described because a list of what it was supposed to do was included in the "original disclosure," Acacia relies on the specification's recitation of the three above-identified functions – receiving user requests, retrieving requested information from the compressed data library, and converting the retrieved information into a format suitable for transmission – as evidencing compliance with § 112. (Opp'n at 59:24-60:19.) Obviously, Acacia cannot credibly contend that the inventors were not required to describe TFCCs capable of performing these three functions when, at the same time, it is arguing that the specification's recitation of these functions in the "original disclosure" is alone an adequate description of the TFCCs.[41]

Defendants' motion papers also exposed a number of other deficiencies with the specification's description of the TFCCs, none of which Acacia was able to adequately explain or excuse:

> (i) The specification does not explain what format is suitable for each of the different types of transmission channels depicted in Fig. 2b, much less structures for all of the different TFCCs required to convert the "predetermined format" of the specification into all of these different communication formats. (Mot. at 26:23-27:1.) Acacia relies on Mr. Weiss's declaration to respond that "one of ordinary skill in the art would have known what the specific format was required [sic] for any particular communication channel." (Opp'n at 61:8-9 (citing Weiss Decl. ¶¶ 104-105).) In fact, Mr. Weiss says no such thing in the cited paragraphs. Even if he had, however, neither he nor Acacia assert that the specification discloses the "detailed identity" of devices for accomplishing these conversions, or that such devices were known. Merely stating that a non-existent and undescribed device will somehow magically "convert the information [in the specification's "predetermined format"] into a format suitable for transmission" (Opp'n at 61:4) does not satisfy the written description requirement.
>
> (ii) The specification shows one TFCC, the third one down from the top in Fig. 2b, that is capable of formatting for both satellite and cable television mediums (the output from the transmitter connected to that TFCC transmits over both satellite and cable). Yet the specification does not explain how that one TFCC is able to convert from the "predetermined format" into both satellite and cable televison formats, how that TFCC knows whether to convert into the satellite format or the cable format, or how the TFCC, which has only one output line, tells the transmitter whether the information is to be transmitted over cable or satellite. (Mot. at 27:2-5.) Acacia has no answers. Its only response – that the specification's depiction of a black box ***transmitter*** having two output lines (one for satellite and one for cable) somehow

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[41] Of course, the list of the three functions the TFCCs are supposed to perform is ***not*** an adequate description of the TFCCs because written description requires disclosure of what a component ***is***, not just what it ***does.*** The fact that an inadequate description appeared in the "original disclosure" does not excuse the failure to comply with § 112. *See supra* at Section III(C).

constitutes a sufficient written description of the ***TFCC*** (Opp'n at 62:1-5) – is prattle.[42]

(iii) The specification says that formatting for transmission is done by the TFCCs 119 and that other formatting for transmission is done by the "transmitter[s] 122," but the specification does not specify what kind of formatting is done by each. (Mot. at 26:26-27:2.) Acacia responds that those skilled in the art would have understood that the described formatting "could be" done by TFCCs 119, transmitters 122 or by both. (Opp'n at 61:14-27 (citing Weiss Decl. ¶¶ 184-185).) This is yet another admission that is fatal to Acacia. Here, it admits that there is no way to even know what the TFCCs do, as contrasted with what the transmitters do. All Acacia can ascertain from the specification is that one or the other of them, or both, perform the described formatting functions. For this additional reason, one cannot even determine from the specification what the TFCCs do, much less what they are as required by § 112.[43]

2. The Specification Does Not Contain an Enabling Disclosure of "Transmission Format Conversion CPUs 119"

The "transmission format conversion CPUs 119" are components of the claimed "transmission system," which ***is*** the Yurt invention. In addition, because these TFCCs were not available off-the-shelf in 1991, the TFCCs themselves are novel. For both these reasons, the inventors were obligated to provide an enabling disclosure of the TFCCs in the specification itself because they are a novel aspect of the invention. *See supra* at Section IV(A). They breached this obligation.

Mr. Weiss opines that the specification "provided sufficient information about the inputs, functions, and outputs of [the TFCC's] subsystems that they could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, ***by applying the processes of system design that were normal for the development of such technological objects***." (Weiss Decl. ¶ 106 (emphasis added).) This cannot defeat summary judgment. The enabling disclosure of

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[42] Although Acacia says that the ability to format for satellite and cable is an "unclaimed feature" (Opp'n at 62:4), Acacia must believe the claims are broad enough to cover satellite and cable transmissions because it sued all of the major satellite and cable television operators. Because the claims are broad enough to cover satellite and cable television transmissions, the inventors were required to adequately describe the satellite and cable embodiments. *See supra* at Section III(D).

[43] For this same reason, as described in Defendants' motion papers (Mot. at 27 n.21), the transmitters 122 also fail to satisfy the written description and enablement requirements. That motion is unrebutted by Acacia.

"transmission format conversion CPUs 119" must be in the specification itself because they are a novel aspect of the novel "transmission system." Moreover, Mr. Weiss's unsupported conclusion would not create a genuine issue of material fact even if the TFCCs were not a novel aspect of the invention. *See supra* at Section V.

It would not have been possible for Mr. Weiss to give anything other than a conclusory opinion. Because the specification does not even unambiguously disclose what the "transmission format conversion CPUs 119" are supposed to do, building them is an intractable problem.

I. The "Library System Control Computer 1123" Is Neither Adequately Described Nor Enabled As A Matter Of Law

1. The Specification Does Not Contain an Adequate Written Description of "Library System Control Computer 1123"

As explained in Defendants' motion papers, the "library system control computer 1123" ("LSCC") is described in the specification as a sophisticated device that performs many complex functions:

> (1) it has a "distribution manager program" that receives user requests for information that include the user-selected time and place where the user would like playback of the information, and it complies with those requests. (Mot. at 27:14-28:6);
>
> (2) it has a "queue manager program" that (a) controls distribution of the requested items to the requesting users in such a way that it "makes best use of the available distribution channels and media for efficient transmission and storage of the requested items"; (b) manages the file transmission process when several users request the same one file to "optimize access to the compressed data library 118" such that "wherever possible it will place the data on multiple outputs for simultaneous transmission to more than one requesting user"; and (c) confirms that a reception system to which information is sent has received the information (Mot. at 28:7-20; 29:11-14);
>
> (3) it has an "item database master" that is "kept current to the contents of the compressed data library" and an "application program[]" that interacts with another application program running on reception system 200 to allow users to access the item database master (Mot. at 29:1-6); and
>
> (4) it sends titles to the "title window" in the "library access interface 121 in the reception system 200." (Mot. at 29:7-10.)

As Defendants also explained in their motion papers, however, the specification does not describe any hardware, software or software algorithms for the referenced "distribution manager," "queue manager program," "item database master" or "application programs," nor does it otherwise describe any hardware, software or software algorithms that perform any of the functions that the specification attributes to the LSCC. Acacia does not disagree with that, nor does it allege that an LSCC was available off-the-shelf in 1991.[44]

Acacia responds instead, as it has for many of the other "transmission system" components, that the inventors were not required to describe an LSCC capable of performing any of the above functions because none of those functions are expressly required by any of the asserted claims. (Opp'n at 63:27-64:11.) However, Acacia again ignores the fact that the inventors (improperly) attempted to define the LSCC only by reference to what it does, not by what it ***is.*** Because no structural information about the LSCC was disclosed, that definition must carry over into the claims if the claims are to have any meaning at all.

Moreover, both Acacia and Mr. Weiss admit that the LSCC only exists to perform these functions. Mr. Weiss, for example, describes the functions of receiving user requests for information, sending the information to the users that requested the information, and confirming that the user received the information as the "purpose" of the LSCC. (Weiss Decl. ¶ 107.)[45] Acacia also relies on these functions in support of its (legally erroneous) position that their recitation in the "original disclosure" constitutes an adequate written description. (Opp'n at 64:16-65:11.)[46] For all of these reasons, an LSCC must perform the above-described functions in order to be a LSCC, and the inventors were therefore required to set forth the "detailed identity" of a device that can perform these functions. They did not.

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[44] Mr. Weiss's assertion that "***[m]any*** of the functions" ascribed to the LSCC are "***comparable to*** functions that had been performed in television automation systems" is irrelevant. (Weiss Decl. ¶ 109 (emphasis added).) The transportation functions of a car and a bicycle are also "comparable," but a car and a bicycle are two very different structures, and the two are not interchangeable. Mr. Weiss cannot and does not allege that an LSCC was an off-the-shelf device. Moreover, while Acacia relies on Mr. Weiss's declaration for the proposition that "[q]ueue manager programs were well-known to one of ordinary skill in the art in 1991" (Opp'n at 65:24-25 (citing Weiss Decl. ¶¶ 109-110)), Mr. Weiss admits that those programs could not function as the queue manager programs of the LSCC, stating that such programs could at best be used "as models for the sorts of solutions needed in building a system to implement the methods of the '992 patent." (Weiss Decl. ¶ 110.) The mere ability to make a claimed component is not sufficient, as a matter of law, to comply with the written description requirement. *See supra* at Section IV(D).

In any event, Mr. Weiss's declaration with respect to the LSCC should be disregarded for several reasons. First, he relied on the "possession" test (Weiss Decl. ¶ 115), which is not the correct standard for compliance with the written description requirement. *See supra* at Section III(A). In addition, his opinions are unsupported – he fails to cite to any supporting documents or other corroborating evidence in support of his opinions. *See supra* at Section V.

Acacia also complains that two of the LSCC functions listed above are optional. (Opp'n at 64:11-15.) Even assuming *arguendo* that statement is true, all of the asserted claims are broad enough to cover LSCC embodiments that perform all of the above functions, including the two allegedly optional ones. For example, one of these two allegedly optional functions is the reception confirmation function (*id*.), which the specification says must be performed "[w]hen item distribution occurs through a broadcasting method such as a communications satellite . . . ." (Col. 17:12-24). Obviously, Acacia thinks the claims are broad enough to cover satellite distribution, because it has sued the major satellite television companies. Therefore, because the scope of the written description must be coextensive with the scope of the claims, the inventors were still required to provide a legally sufficient description of an LSCC that can perform the above-listed functions, including the two allegedly optional ones. *See supra* at Section III(D).

Finally, Acacia fancifully suggests that Defendants' recitation in their motion papers of the list of functions ascribed to the LSCC in the specification amounts to an "acknowledgment" that the specification discloses an LSCC that can perform those functions. (Opp'n at 65:16-67:16.) Obviously, nothing could be further from the truth. What Defendants said in their motion papers, and what Defendants repeat again here, is that the specification's laundry list of functions the LSCC is supposed to perform is ***not*** sufficient because written description requires disclosure of what a claimed component ***is***, not just what it ***does***. The Yurt specification does not describe the hardware, software or software algorithms that define what the LSCC ***is***, and therefore the inventors did not comply with the written description requirement as a matter of law.

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[45] Mr. Weiss associates those functions with the "queue manager program" of the LSCC. (*Id*.)

[46] As explained in Sections III(A) and (C) above, written description requires disclosure of what a component ***is***, not just what it ***does***. The fact that an inadequate description appeared in the "original disclosure" does not excuse the failure to comply with § 112.

2. The Specification Does Not Contain An Enabling Disclosure Of "Library System Control Computer 1123"

The "library system control computer 1123" is a component of the claimed "transmission system," which ***is*** the Yurt invention. In addition, because a device capable of performing the functions ascribed to the LSCC was not available off-the-shelf in 1991, the LSCC itself is novel. For both these reasons, the inventors were required to provide an enabling disclosure of the LSCC in the specification itself because it is a novel aspect of the invention. *See supra* at Section IV(A). They did not.

Mr. Weiss opines that the specification "provided sufficient information about the inputs, functions, and outputs of [the LSCC's] subsystems that they could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, ***by applying the processes of system design that were normal for the development of such technological objects***." (Weiss Decl. ¶ 111 (emphasis added).) This cannot defeat summary judgment. The enabling disclosure of "library system control computer 1123" must be in the specification itself because it is a novel aspect of the novel "transmission system." Moreover, Mr. Weiss's unsupported conclusion would not create a genuine issue of material fact even if the LSCC was not a novel aspect of the invention. *See supra* at Section V.

J. The "Library Access Interface 121" Is Neither Adequately Described Nor Enabled As A Matter Of Law

1. The Specification Does Not Contain an Adequate Written Description of "Library Access Interface 121"

In their motion papers, Defendants explained that the specification does not say what the "library access interface 121" ("LAI") is, nor does it even say much about what it is supposed to do other than function as some kind of intermediary in responding to user requests. (Mot. at 29:16-25.) While Mr. Weiss purports to have been able to discern a number of things the LAI must do based on his reading of the specification, it is apparent that even Mr. Weiss recognizes that the LAI must perform functions that are not described in or discernable from the specification:

> The purpose of a Library Access Interface is to provide to users access to the information about items stored in the Compressed Data Library as well as to transfer blocks of audio and video data, to receive transmission requests directly from users or indirectly through Remote Order Processing & Item Database subsystems, ***to enable various sorts of access to items for customers of a system operator***, and to communicate a list of available titles for alphabetical display in a title window on reception systems.

(Weiss Decl. ¶ 112 (emphasis added).) Mr. Weiss does not explain how anyone could know what an LAI ***is*** based on the requirement that it "enable ***various sorts*** of access to items . . . ." That is not sufficient to even constitute a description of what the LAI is supposed to do, much less what it is. Therefore, Acacia's argument that the LAI is sufficiently described in the specification because the "original disclosure" listed the functions it is supposed to perform (Opp'n at 69:23-70:20) fails for two reasons: (i) written description requires disclosure of what a component ***is***, not just what it ***does***, and the fact that the inadequate description appeared in the "original disclosure" does not excuse the failure to comply with § 112 (*see supra* at Sections III(A) and (C)); and (ii) the specification does ***not*** even list exactly what functions the LAI is supposed to perform.

Neither Mr. Weiss nor Acacia argues that LAIs that could function in the claimed "transmission system" were available off-the-shelf in 1991, and neither of them contend that the hardware, software or software algorithms that constitute the LAI are disclosed in the specification. Instead, Acacia argues that generic "[i]nterfaces were well-known" (Opp'n at 70:25-26) based on Mr. Weiss's conclusory and unsupported testimony that "[t]here were examples of user access and ordering systems ***similar*** to those described in the '992 patent" in the prior art. (Weiss Decl. ¶ 114 (emphasis added).)[47] While Mr. Weiss refers to "[a]utomatic [n]umber [i]dentification" and similar equipment (*id.*), he does not explain why he thinks it is "similar," because it obviously has no applicability to the claimed "transmission system." For example, the "transmission system" is not described in the specification as doing anything with respect to "[a]utomatic [n]umber [i]dentification."

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[47] Mr. Weiss's testimony should be disregarded *in toto* because it is unsubstantiated and conclusory (*e.g.*, he does not provide or cite to any product manuals or other evidence to corroborate his testimony), (*see supra* at Section V), and because he again relies on the "possession" test (Weiss Decl. ¶ 115), which is not the correct standard for compliance with the written description requirement. *See supra* at Section III(A).

The bottom line, however, is that Mr. Weiss does not contend that there was any equipment available off-the-shelf that could function as the LAI of the transmission system in 1991, nor does he explain how then-existing equipment would have to be modified to become an LAI. In fact, Mr. Weiss provides no testimony whatsoever about the "detailed identity" of an LAI that one could visualize from reading the specification. For all of these reasons, his testimony does not create a genuine issue of material fact with respect to Defendants' motion that the LAI is not adequately described in the specification. *See supra* at Section V.

Finally, as Defendants described in their motion papers (Mot. at 29:26-30:6), the specification is ambiguous as to whether the LAI even functions as a component of the transmission system or the reception system. According to Fig. 2b and col. 13:29-34, it is a component of the transmission system, but according to col. 17:44-46 it is a component of the receiving system. While Acacia responds that the Court's construction of "transmission system" resolves this ambiguity by placing the LAI in the "transmission system" (Opp'n at 71:6-11), that misses the point. Even though the Court has resolved the ambiguity as to ***where the LAI is***, it has not resolved the concomitant ambiguity with respect to ***what it is*** and ***what it does***.

For example, the specification states that "[t]he library access interface 121 in the reception system 200 preferably includes a title window . . . ." (Col. 17:44-45). If the LAI is actually part of the transmission system, does it still have a "title window," or is the title window actually part of a different component in the reception system? Acacia concludes that this ambiguity should be resolved by placing the title window in the receiving system. Thus, contrary to what the specification states, the LAI does not have a title window according to Acacia. (Opp'n at 71:12-17.) However, this conclusion is based on nothing more than Mr. Weiss's conclusory opinion that one skilled in the art would resolve the specification's ambiguity in that manner, an opinion which is entitled to no weight. *See supra* at Section V. In truth, there is simply no way to tell whether the

LAI includes a title window or not. There is therefore still no way to tell what the LAI is or even what it does. For all of these reasons, the specification does not adequately describe the LAI as a matter of law.

2. The Specification Does Not Contain an Enabling Disclosure of "Library Access Interface 121"

The "library access interface 121" is a component of the claimed "transmission system," which ***is*** the Yurt invention. In addition, because a device capable of performing the functions ascribed to the LAI in the specification was not available off-the-shelf in 1991, the LAI itself is novel. For both these reasons, the inventors were required to provide an enabling disclosure of the LAI in the specification itself because it is a novel aspect of the invention. *See supra* at Section IV(A). They did not.

Mr. Weiss opines that the specification "provided sufficient information about the inputs, functions, and outputs of [the LAI's] subsystems that they could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, ***by applying the processes of system design that were normal for the development of such technological objects***." (Weiss Decl. ¶ 115 (emphasis added).) This cannot defeat summary judgment. The enabling disclosure of "library access interface 121" must be in the specification itself because it is a novel aspect of the novel "transmission system." Moreover, Mr. Weiss's unsupported conclusion would not create a genuine issue of material fact even if the LAI was not a novel aspect of the invention. *See supra* at Section V.

It would not have been possible for Mr. Weiss to give anything other than a conclusory opinion. Because the specification does not even unambiguously disclose what the "library access interface 121" is supposed to do, building one is an intractable problem.

VIII. THE SPECIFICATION FAILS TO ADEQUATELY DESCRIBE AND ENABLE THE "RECEPTION SYSTEM" (OR SYNONYMOUS STRUCTURE) OF CLAIMS 1-42 OF THE '702 PATENT AND CLAIMS 17-19 OF THE '863 PATENT

Acacia's introductory arguments with respect to the claimed "reception system" (Opp'n at 72:13-74:6) are basically identical to its introductory arguments with respect to the claimed "transmission system." And they fail for the same reasons. *See supra* at Section VII.

The Court has held that the terms "receiving system," "reception system," and "local distribution system" refer to the same structure (3rd CCO at 10:4-5; 4th CCO at 8:1-2), namely "the configurable, interconnected, assemblage of components labeled and described in the specification as 'receiving system 200,' a detailed block diagram of which is shown on Figure 6." (6th CCO at 11.) Acacia says that "reception system" must of necessity be adequately described because the interconnected components of Fig. 6 which constitute it, and the term "receiving system" itself, appeared in the originally filed specification and/or claims. (Opp'n at 73:18-74:3.) As explained in Sections III(A), III(C), and VII above, the Federal Circuit has squarely rejected this argument. A description, even if it appears in an original claim or specification, must still be sufficient to permit one to "recognize or visualize" the "detailed identity" of the invention.

Acacia's statement that Defendants are "imbu[ing] each component [of the receiving system] with all of the features and functions described in the specification" including optional features and functions (Opp'n at 73:2-11), misrepresents Defendants' position. Defendants are ***not*** saying that every claim is necessarily limited to a reception system embodiment that has all of the capabilities the specification allegedly describes as optional, such that to infringe the claims, one must use that optional reception system embodiment. What Defendants ***are*** saying is that the scope of the written description and enabling disclosure must be coextensive with the scope of the claims. If a reception system embodiment is within the scope of the claims, the specification must provide an adequate written description and enabling disclosure for it, even if it is an optional embodiment to which the claims are not limited. *See supra* at Section III(D).

Moreover, because the inventors improperly attempted to define the components of the receiving system only by reference to a list of the functions they are supposed to perform,[48] each such component must of necessity have the capabilities ascribed to it in the specification (with the exception of capabilities expressly stated to be optional.) It is only by reference to those capabilities that one could even try to guess as to whether one was employing one of these components.

Finally, Acacia's contention (Opp'n at 72 n.28) that the Court's construction of "reception system" does not apply to the claims of the '702 patent must be rejected. As Acacia itself says, a claim term is presumed to have the same meaning in all of the claims in which it appears. (Opp'n at 27 n.17.) Moreover, if the Court's construction of "reception system" does not apply to the system claims of the '702 patent, those claims lack written description and enablement for a whole host of additional reasons. For example, the claims of the '702 patent that do not on their face require all of the components of Fig. 6 to be part of the claimed "reception system" would lack written description because, as the Court has already determined (6th CCO at 10:26-11:22), there is no disclosure of a "reception system" that contains less than all of the components of Fig. 6. Moreover, if the Court's construction of "reception system" as the "interconnected" components of Fig. 6 does not apply to the '702 patent, the claims of that patent also fail to comply with § 112 for the independent reason that they do not require any connection or relationship between the identified components of the reception system. *See Collier*, 397 F.2d at 1005-06.

For the reasons explained in Defendants' motion papers and in this Section VIII, *none* of the individual components of the claimed "reception system"are sufficiently described or enabled. However, if the Court concludes that *even one* reception system component is not adequately described or enabled, the claimed "reception system" is not adequately described or enabled.

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[48] In all events, describing only what a component ***does***, rather than what it ***is***, does not satisfy the written description requirement as a matter of law. *See supra* at Section III(A).

A. "Receiver Format Converter 202" Is Neither Sufficiently Described Nor Enabled As A Matter Of Law

1. The Specification Does Not Contain an Adequate Written Description of "Receiver Format Converter 202"

As Defendants explained in their motion papers (Mot. at 31:17-23), the specification does not explain what the "receiver format converter 202" ("RFC") ***is*** – the specification does not disclose any hardware, software or software algorithms for a device capable of performing the function ascribed to the RFC in the specification. Neither Acacia nor Mr. Weiss dispute this, nor do they contend that an RFC that could function in the claimed "reception system" was available as an off-the-shelf device in 1991.

Instead, Acacia asserts that the RFC is sufficiently described in the specification because the "original disclosure" described the function of the RFC: It "converts the compressed formatted data blocks ***into a format suitable for playback by the user in real time***." (Opp'n at 74:7-27 (citing col. 18:10-13).) As explained in Sections III(A) and III(C) above, this argument fails because written description requires disclosure of what a component ***is***, not just what it ***does***. The fact that an inadequate description appeared in the "original disclosure" does not excuse the failure to comply with § 112.

Moreover, it is evident from the specification that the RFC ***cannot*** perform even that one function ascribed to it. Fig. 6 demonstrates that the output of the RFC ***is not*** in "a format suitable for playback." As Acacia explains (Opp'n at 76:2-4), the specification defines a "format suitable for playback" as a format that can be "output to a playback system such as an audio amplifier and/or television." (Col. 17:25-26, 18:36-37). The output from the RFC clearly cannot be output to a television or other playback device. The output of the RFC must first be processed by the "data formatter 204," the "decompressor 205," and an "output format converter 206." As the specification says, it is only after all of this additional processing that the information is in a format that can be output to a "playback system" such as a television. (Col. 18:22-37). Thus, the specification's description of the RFC as the component that "converts the compressed formatted data blocks into a format suitable for playback by the user in real time" is clearly wrong. Because that is the only function ascribed to the RFC in the specification, there is actually no description in the specification at all of what the RFC is supposed to do.

Acacia agrees with all of the facts set forth above. It agrees that converting the information into a format suitable for playback by the user in real time is the function ascribed to the RFC in the specification (Opp'n at 74:20-21, 75:11-14, 75:15-18), and it agrees that this format "suitable for playback" is a format that "can be output to a playback system for playback in real time, such as a television or an audio amplifier." (Opp'n at 76:2-4 (citing col. 18:36-37).) Yet, almost in passing and without acknowledging its implications, Acacia also agrees that "the output from the receiver format converter is compressed audio-video information ***which must be separated, decompressed, and converted to an appropriate analog or digital format to be viewed or heard***." (Opp'n at 75:9-11.) Thus, there is no dispute that the RFC cannot possibly perform the only function ascribed to it in the specification. A more inadequate description of a claimed device is difficult to imagine.

Finally, Acacia says that the inventors were not required to describe the RFC in the specification because "[n]othing in the claims or the Court's construction for 'transmission system' [sic][49] places any limitation on the specific format for the information or 'how' to implement the format conversion." (Opp'n at 75:25-26.) Acacia's reliance on this fact is misplaced, because it is irrelevant to the written description analysis. Section 112 required the inventors to describe the "detailed identity" of a device capable of performing the functions ascribed to the RFC in the specification, even if the claims are not limited to that particular device. *Rochester*, 358 F.3d at 923, 927; *Enzo*, 323 F.3d at 968. One cannot claim a time machine without describing the structure of a time machine simply because the claims are not limited to any particular time machine structure or method of operation.

2. The Specification Does Not Contain an Enabling Disclosure of "Receiver Format Converter 202"

The "receiver format converter 202" is a component of the claimed "reception system," which ***is*** the Yurt invention. (*See* Mot. at 13:19-22, n.11.) In addition, because a device capable of performing the function ascribed to the RFC was not available off-the-shelf in 1991, the RFC itself is novel. For both these reasons, the inventors were required to provide an enabling disclosure of the RFC in the specification itself because it is a novel aspect of the invention. *See supra* at Section IV(A). They did not.

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[49] Acacia ostensibly meant to refer to the "reception system" here.

Mr. Weiss opines that the specification "provided sufficient information about the inputs, functions, and outputs of [the RFC's] subsystems that they could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation*, **by applying the processes of system design that were normal for the development of such technological objects.***" (Weiss Decl. ¶ 120 (emphasis added).) This cannot defeat summary judgment. The enabling disclosure of the RFC must be in the specification itself because it is a novel aspect of the novel "reception system." Moreover, Mr. Weiss's unsupported conclusion would not create a genuine issue of material fact even if the RFC was not a novel aspect of the invention. *See supra* at Section V.

Finally, even if the RFC was not a novel aspect of the invention, the basis for Acacia's assertion that those skilled in the art could have made one in 1991 is the specification's description of its function as "convert[ing] the compressed formatted data blocks into a format suitable for playback by the user in real time." (Opp'n at 76:12-77:12 (referencing 74:19-23).) As described above, the RFC cannot possibly perform that function, because it is inconsistent with the rest of the specification's description of the reception system. Because those skilled in the art would not have known either what the RFC is or what it does, they could not possibly have made one.

B. "Storage 203" Is Neither Sufficiently Described Nor Enabled As A Matter Of Law

The Defendants do not dispute that generic storage devices were known and available off-the-shelf in 1991. The problem is, the claimed reception system must perform functions with or on "storage 203" that cannot be performed by a generic storage device or with any other component of the Fig. 6 reception system. For example, the disclosed reception system does not even include any component capable of retrieving information from "storage 203," much less components that can perform the ambitious functions described in the specification of (i) temporarily storing information in "storage 203" ***only if*** the user specified a later playback time in his information request to the transmission system; and (ii) playing back the information to the user at that time. (*See* Mot. at 32:1-17.) Neither Acacia nor Mr. Weiss contends that "storage 203" itself can perform these functions, and they agree that none of the other components of the Fig. 6 reception system are capable of performing these functions either. Indeed, they agree that for a "reception system" to work, it must include components in addition to those depicted in Fig. 6, components not mentioned at all in the specification. For all these reasons, "storage 203" is not adequately described or enabled.

Acacia's response is simple. It says the inventors were not required to adequately describe a reception system capable of performing these functions, they were not required to adequately describe all the components that would be required for a "reception system" to work, and they were not even required to disclose the fact that components in addition to those depicted in Fig. 6 would be necessary to allow the reception system to work. It is wrong on all counts.

1. The Specification Does Not Contain an Adequate Written Description of "Storage 203"

First, Acacia asserts that "storage 203" is sufficiently described in the specification because the "original disclosure" lists the functions it is supposed to perform. (Opp'n at 77:14-78:4.) This argument fails because written description requires disclosure of what this component ***is***, not just what it ***does***. The fact that the inadequate description appeared in the "original disclosure" does not excuse the failure to comply with § 112. *See supra* at Sections III(A) and (C).

Acacia then turns to each of the specific functions that must be performed on or with "storage 203," and separately attempts to justify the inventors' failure to adequately describe a reception system that can perform those functions. None of these excuses withstand scrutiny.

(i) retrieval of information from storage 203

Relying on Mr. Weiss's testimony, Acacia asserts that those skilled in the art would have understood that a receiving device would have to have a "control component" that is not described, depicted or even referenced in the specification text or Fig. 6. According to Mr. Weiss, this undisclosed "embedded controller" performs whatever specialized retrieval functions must be performed for a reception system to have the unique capabilities ascribed to it in the specification:

> (i) "The controller further is needed to enable the function described in the '992 patent in which a user can request a song by its identifier and have it sent from the Transmission System or played back locally if it already is buffered on the Reception System" (Weiss Decl. ¶ 123);
>
> (ii) "Yet a further function of the embedded controller is supporting the playback controls described in the '992 patent to permit the choice of play, play slow, pause, stop, fast forward, and rewind functions, which would involve controlling the Storage subsystem and, depending on design choices, such capabilities as remote control operation of the playback controls" (*Id.*);
>
> (iii) The "embedded controller would control the Storage subsystem, support the playback control functions, support the User/Computer Interface, ***and carry out all the other housekeeping necessary to manage a complex consumer device***" (Weiss Decl. ¶ 125 (emphasis added).)

Neither Acacia nor Mr. Weiss contends that hardware, software or software algorithms for this so-called "embedded controller" is disclosed in the specification, and neither contends that a controller capable of performing the functions described by Mr. Weiss was available off-the-shelf in 1991.[50] Not only doesn't the specification provide the "detailed identity" of a controller capable of performing these functions and "carry[ing] out all the other housekeeping necessary to manage [the] complex consumer device" the "reception system" is, the specification does not even teach that such a controller is part of the "reception system" or explain how it interconnects with the other components of the receiving system. The specification therefore does not adequately describe "storage 203" or the receiving system of Fig. 6 as a matter of law. *See supra* at Section III(A).

Acacia says the inventors were not required to describe the sophisticated controller that the receiving system must have, or to even to disclose its existence, because "such a controller" is "inherent[ly]" required to be used with a storage device. (Opp'n at 79:21-80:3; *see also* Weiss Decl.

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[50] Mr. Weiss's conclusory and unsupported opinion that "[c]ontrollers ***of the sort*** described were well known by the start of 1991" (Weiss Decl. ¶ 124 (emphasis added)) is irrelevant. The functions Mr. Weiss describes as being performed by those alleged controllers are not the functions he describes as being performed by the controller of the reception system.

¶¶ 123-124.) In other words, "storage 203" and the purportedly novel "reception system" as a whole must "inherently" include whatever would be necessary in order for them to perform the functions ascribed to them in the specification. This is just a reformulation of Acacia's misconceived argument that "storage 203" is adequately described because the specification lists functions to be performed with or on it. The inherency doctrine does not vitiate the statutory written description requirement in this way.

In order for a component to be inherently present, ordinarily skilled artisans must visualize the detailed identity of the missing component from the specification AND that missing component must necessarily be present. *See TurboCare,* 264 F.3d at 1119; *Cortright,* 165 F.3d at 1360. Acacia never gets to the second step, because the "detailed identity" of the undisclosed controller cannot be visualized from the specification. According to Mr. Weiss, this undisclosed controller is the brains of the allegedly novel reception system – hardly "minutia" or a "trivial detail" as Acacia contends (Opp'n at 79:24; 81:10) – and it therefore cannot have been available as an off-the-shelf device. Thus, there was no existing structure that one skilled in the art could have visualized as corresponding to the functions associated with "storage 203." Certainly, Mr. Weiss's speculation that the undescribed but essential "embedded controller" "was likely to be a microprocessor along with its attendant memory and other peripheral devices" (Weiss Decl. ¶ 123) is legally insufficient to constitute the "detailed identity" of this undisclosed controller.

Nor could Acacia satisfy the "necessarily present" test of the inherency doctrine if the analysis ever did get that far. Because the "reception system" ***is*** the invention, nothing can be said to be "inherently present" in one. For example, if one discloses the presence of a car in a specification, a gas pedal may be inherently disclosed because everyone knows cars necessarily have gas pedals. In contrast, because the "reception system" is the Yurt invention, no one knows anything about it *a priori*. The inventors must tell us what is in it – it does not inherently contain anything.

Acacia cites no cases for its proposition that disclosing only a list of functions a novel device is supposed to perform satisfies the written description requirement because everything and anything, known and unknown, required to perform those functions is "inherently present" in the device. That is simply not the law. Indeed, it cannot be. The court-developed inherency doctrine cannot vitiate the statutory written description requirement in this way.

ii) storing only if the user specified a later playback time in his information request to the transmission system, and playing back the information at that time

Acacia says that the inventors were not required to describe a reception system that (a) stores information only when a later playback time was specified in the user request to the transmission system; and (b) plays the information back at that user-selected time, because "there is no requirement in the specification . . . that the storage function of the storage 203 only occurs when the user included a playback time in their initial request." (Opp'n at 79:13-14.) Acacia is wrong. The specification requires exactly that:

> In the reception system 200 of the present invention, the user may want to play back the requested item from the source material library 111 at a time later than when initially requested. ***If that is the case***, the compressed formatted data blocks from receiver format converter 202 are stored in storage 203. Storage 203 allows for temporary storage of the requested item until playback is requested.

(Col. 18:14-21). As this Court observed, the specification also requires the reception system to be capable of "automatically" playing back the information from "storage 203" at the time the user specified in his request to the transmission system. (3rd CCO at 23:2-10.)

The specification, however, does not describe a mechanism for doing any of this. There is no component of the reception system of Fig. 6 that is capable of checking whether the user requested a later time for playback in his request to the transmission system, and, if so, storing the information in storage device 203. Similarly, there is no component disclosed for complying with that user request by retrieving the information from the storage device at the time the user specified in his request to the transmission system.

Acacia cites to a number of passages from the specification which it says demonstrate that these capabilities are "optional." (Opp'n at 78:17-79:13.) Not a single one of these passages actually says that these capabilities are optional, however, nor do any of these passages contain a single example of storing in "storage 203" when the user request to the transmission system did not request a later time for playback. In fact, when discussing the receiver format converter, Acacia itself admitted that the above-referenced passage (col. 18:14-21) means that information "is passed from the 'receiver format converter 202' to the 'storage 203,' ***depending upon whether the information is to be played back immediately or at some later time***." (Opp'n at 74:24-27.) Thus, these are mandatory capabilities of the only reception system disclosed in the specification, a system the inventors (improperly) attempted to define in large part by the functions it is supposed to be capable of performing. The inventors were therefore obligated to describe the "detailed identity" of a reception system that can perform these functions. They did not, and, therefore, they did not comply with the written description requirement.

Nonetheless, even if these had been described as optional capabilities of the reception system, all of the asserted claims directed to a "reception system" are broad enough to cover this allegedly optional embodiment. Therefore, because the scope of the written description must be coextensive with the scope of the claims, the inventors would still have been required to adequately describe this reception system embodiment. *See supra* at Section III(D).

2. The Specification Does Not Contain an Enabling Disclosure of "Storage 203"

"Storage 203" and any associated undisclosed components (be they the "controller component" referred to be Acacia or otherwise) are components of the claimed "reception system," which ***is*** the Yurt invention. In addition, whatever combination of components Acacia alleges would perform the functions the specification says are performed on or with "storage 203" were not available off-the-shelf in 1991, meaning those components themselves are novel. For both these reasons, the inventors were obligated to provide an enabling disclosure of those components in the specification, because they are novel aspects of the invention. *See supra* at Section IV(A). The inventors breached that obligation.

Mr. Weiss opines that the specification "provided sufficient information about the inputs, functions, and outputs of such subsystems that they could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, ***by applying the processes of system design that were normal for the development of such technological objects***." (Weiss Decl.

¶ 126 (emphasis added).) This cannot defeat summary judgment. The enabling disclosure of "storage 203" and associated components must be in the specification itself because they are novel aspects of the novel "reception system." Moreover, Mr. Weiss's unsupported conclusion would not create a genuine issue of material fact even if storage 203 and its associated components were not novel aspects of the invention. *See supra* at Section V.

Finally, Acacia says that the "optional feature" of storing only if the user specified a later playback time in his information request to the transmission system, and playing back the information at that time, need not be enabled. (Opp'n at 80:18-81:4.) For the reasons discussed above, however, these capabilities are not optional. Even if they were, that would be of no help to Acacia because the claims are broad enough to cover the allegedly optional embodiment that has these capabilities. Because the scope of the enabling disclosure must be commensurate with the scope of the claims, the inventors would still have been required to adequately describe that "optional" embodiment. *See supra* at Section III(D).

C. "Data Formatter 204" Is Neither Sufficiently Described Nor Enabled As A Matter Of Law

The specification ascribes two functions to the "data formatter 204" ("DF") – it both "processes the compressed formatted data blocks and distinguishes audio information from video information." (Col. 18:22-26). The problem with this, as Defendants explained in their motion papers (Mot. at 32:18-33:2), is that the specification does not describe what the DF ***is***, how audio information is distinguished from video information or what additional "processing" it does. Therefore, it is neither adequately described nor enabled.

1. The Specification Does Not Contain an Adequate Written Description of "Data Formatter 204"

Neither Acacia nor Mr. Weiss alleges that the specification discloses the hardware, software, or software algorithms that constitute the DF, and neither alleges that the DF was available off-the-shelf in 1991. Moreover, Acacia has no answer to the question posed in Defendants' motion papers (*id.*) as to what "processing," other than distinguishing audio from video, the DF performs. Instead, Acacia just ignores the fact that the specification ascribes such additional processing to the DF and hopes that the problem will somehow go away.[51]

Mr. Weiss, on the other hand, suggests that the additional processing involves "revers[ing] what took place in the Compressed Data Formatter of the Transmission System." (Weiss Decl. ¶ 127.) Even if this were true (and there is no way to tell, because the specification discloses nothing of the kind), the specification does not set forth what functions or steps would have to be performed to reverse what the Compressed Data Formatter did, much less how to perform those functions. In fact, because the specification fails to even adequately describe what "formatting," "processing," "forming" and other functions the Compressed Data Formatter performs (*see supra* at Section VII(F)), there would be no way to even speculate as to how to reverse those ambiguously-described functions. For all of these reasons, not only does the specification not adequately describe what the DF ***is***, it does not even adequately describe what it does.

Mr. Weiss also testified that the DF could not even perform the function of separating audio information from video information unless an unidentified component of the transmission system or reception system performed yet some additional undisclosed and undescribed processing:

> Implicit in the ability of the Data Formatter to separate the audio and video data from one another is either a known data structure within the stored or played out data, in which the audio and video data are placed in a predetermined arrangement that can be depended upon by the process of the Data Formatter, or the use of identifiers within the data to separately identify audio data and video data so that the Data Formatter can determine which is which.

(Weiss Decl. ¶ 127.) Neither Mr. Weiss nor the specification explain which component of the transmission system or receiving system creates the "known data structure" or assigns the "identifiers" that the DF would have to rely on, how those functions would be performed, or any other information about them. This is far from the type of description required to satisfy § 112.

Notwithstanding all of the above, Acacia asserts that the DF is sufficiently described in the specification because the "original disclosure" lists the functions it is supposed to perform. (Opp'n at 81:16-82:6.) This argument fails because written description requires disclosure of what a component ***is***, not just what it ***does***, and the fact that the inadequate description appeared in the "original disclosure" does not excuse the failure to comply with § 112. In that regard, while Defendants do acknowledge, as Acacia says (Opp'n at 82:16-18), that the above-identified two functions are ascribed to the DF (*see* col. 18:22-26), Defendants do not "acknowledge" that this satisfies the written description requirement as Acacia suggests.

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[51] Acacia refers only to the DF function of "distinguish[ing] audio information from video information." (Opp'n at 82:1-3.)

Finally, Acacia says that the inventors were not required to provide an adequate description of a data formatter capable of performing the functions ascribed to it in the specification because "[n]othing in the Court's construction of 'receiving system' limits the 'data formatter 204' to any specific apparatus or requires any particular method for distinguishing video information from audio information." (Opp'n at 82:11-13.) For all the reasons described above with respect to other components of the claimed "transmission system" and "receiving system," that is legally irrelevant. Section 112 required the inventors to describe the "detailed identity" of a device capable of performing the functions ascribed to the DF in the specification, even if the claims are not limited to that particular device. *Rochester*, 358 F.3d at 923, 927; *Enzo*, 323 F.3d at 968.

2. The Specification Does Not Contain an Enabling Disclosure of "Data Formatter 204"

The "data formatter 204" is a component of the claimed "reception system," which ***is*** the Yurt invention. In addition, because a device capable of performing the functions ascribed to the DF was not available off-the-shelf in 1991, the DF itself is novel. For both these reasons, the inventors were required to provide an enabling disclosure of the DF in the specification itself because it is a novel aspect of the invention. *See supra* at Section IV(A). They did not.

Mr. Weiss opines that the specification "provided sufficient information about the inputs, functions, and outputs of [the DF's] subsystems that they could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, ***by applying the processes of system design that were normal for the development of such technological objects***." (Weiss Decl. ¶ 128 (emphasis added).) This cannot defeat summary judgment. The enabling disclosure of "data formatter 204" must be in the specification itself because it is a novel aspect of the novel "reception system." Moreover, Mr. Weiss's unsupported conclusion would not create a genuine issue of material fact even if the DF was not a novel aspect of the invention. *See supra* at Section V.

D. Decompression Block 205 (Decompressors 208 and 209) Is Neither Sufficiently Described Nor Enabled As A Matter Of Law

1. The Specification Does Not Contain an Adequate Written Description of Decompressors 205

As Defendants explained in their motion papers (Mot. at 33:3-10), the specification does not describe the "detailed identity" of the two decompressors that make up decompression block 205.[52] The only information the specification provides about these decompressors is that they perform the function of decompressing the information that was compressed in the transmission system. Not only is that not a description of what the decompressors ***are*** as required by § 112, it is not even a meaningful description of what they do. Because the "compression" performed by the transmission system is not adequately described (*see supra* at Section VII(E)), the bare statement that the decompressors reverse the inadequately described compression process is an inadequate description of the decompression performed by the decompressors.

Neither Acacia nor Mr. Weiss alleges that the specification discloses the hardware, software or software algorithms for decompressors 205, and neither alleges that such decompressors were available off-the-shelf in 1991. Instead, Acacia asserts that the decompressors are sufficiently described in the specification because the "original disclosure" says that they perform decompression. (Opp'n at 83:10-84:6.) This argument fails because written description requires disclosure of what a component ***is***, not just what it ***does***, and the fact that the inadequate description appeared in the "original disclosure" does not excuse the failure to comply with § 112. *See supra* at Sections III(A) and (C).

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[52] Acacia complains that "Figure 6 does not include a 'decompression block 205'; Figure 6 depicts two decompressors, 208 and 209." (Opp'n at 83:12-14.) Because Fig. 6 clearly *does* collectively label decompressors 208 and 209 as a single block "205," and because this issue is not pertinent to the substance of Defendants' motion, there was no need for Acacia to bother the Court with such caviling.

However, even if, contrary to law, a broad statement of the function to be performed by a novel device was alone sufficient to comply with the written description requirement, the decompressors 205 would still not be adequately described. Because the compression performed by the transmission system is inadequately described (*see supra* at Section VII(E)), the statement that the decompressors 205 reverse the inadequately described compression process is perforce an inadequate description of the decompression process.

For all of these reasons, the description of decompressors 205 does not comply with the written description requirement as a matter of law.

2. The Specification Does Not Contain an Enabling Disclosure of Decompressors 205

The decompressors 205 are components of the claimed "reception system," which ***is*** the Yurt invention. In addition, because decompressors capable of performing the functions ascribed to them were not available off-the-shelf in 1991, the decompressors themselves are novel. For both these reasons, the inventors were obligated to provide an enabling disclosure of the decompressors 205 in the specification itself because they are novel aspects of the invention. *See supra* at Section IV(A). The inventors breached that obligation.

Mr. Weiss opines that the specification "provided sufficient information about the inputs, functions, and outputs of [the decompressors'] subsystems that they could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, ***by applying the processes of system design that were normal for the development of such technological objects***." (Weiss Decl. ¶ 130 (emphasis added).) This cannot defeat summary judgment. The enabling disclosure of decompressors 205 must be in the specification itself because they are a novel aspect of the novel "reception system." Moreover, Mr. Weiss's unsupported conclusion would not create a genuine issue of material fact even if the decompressors 205 were not a novel aspect of the invention. *See supra* at Section V.

Finally, because the function of decompressors 205 is to undo what the compressors 116 of the transmission system did, the decompressors are not enabled for the same reasons the compressors 116 are not enabled. *See supra* at Section VII(E).

E. "Output Converters 206" Are Neither Sufficiently Described Nor Enabled As A Matter Of Law

1. The Specification Does Not Contain an Adequate Written Description of "Output Converters 206"

The specification does not identify the hardware, software or software algorithms that constitute any of the five discrete converters that make up "output converters 206."[53] All the inventors provide in the specification is a list of broad, ambitious functions they would like these converters to perform. For example, the converters are responsible for (i) determining whether information is "copy protected" and, if so, scrambling it (col. 17:28-34); (ii) implementing the fast forward, rewind and other VCR-like features the reception system is said to be capable of providing (col. 18:36-45, 17:35-43); and (iii) according to Mr. Weiss, they "reverse what took place in the Converter of the Transmission System." (Weiss Decl. ¶ 131.) Neither Acacia nor Mr. Weiss asserts that converters that could perform all of these functions were available off-the-shelf in 1991.[54] Instead, Acacia asserts that providing this bare list of high-level functions in the "original disclosure" satisfies the written description requirement. (Opp'n at 85:19-86:13, 86:26-87:4.) This argument fails because written description requires disclosure of what a component ***is***, not just what it ***does***, and the fact that the inadequate description appeared in the "original disclosure" does not excuse the failure to comply with § 112. *See supra* at Sections III(A) and (C).

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[53] Fig. 6 shows a "digital video output converter 211," "analog video output converter 213," "digital audio output converter 212," "analog audio output converter 214," and an unnumbered output for compressed data.

[54] Mr. Weiss's conclusory and unsupported opinion that converters available in 1991 could have been adopted to perform the one basic function of "provid[ing] signals to output interfaces" (Weiss Decl. ¶ 132) is irrelevant. Aside from the fact that he does not identify any such converters or explain how they would have to be adopted, he does not even allege that these converters would, after modification, perform all the functions ascribed to "output converters 206" in the specification. Moreover, the ability to make a claimed component is not the test for written description. For these reasons, and because Mr. Weiss does not submit a single product manual or other evidence to support his opinion as to what converters available off-the-shelf in 1991 were capable of, his opinion must be disregarded. *See supra* at Section V.

As explained in Defendants' motion papers (Mot. at 33:18-21), notwithstanding the inventors' failure to adequately describe any device having the converters 206's capability of providing VCR-like functions, the inventors relied on these functions to distinguish prior art. Acacia's one-line response that "[n]o playback controls are depicted in Figure 6" (Opp'n at 86:25) contradicts the specification. The specification explicitly says that "[t]he reception system 200 has playback controls" (col. 17:35), and it associates those controls with the converters 206 (col. 18:27-45). While the inventors knew their reception system was supposed to have these VCR-like capabilities, they did not actually know how to make one.

Mr. Weiss agrees that it is the "output converters 206" that somehow implement copy protection. (Weiss Decl. ¶ 131.) Nonetheless, Acacia says that the inventors were not obligated to adequately describe such converters because the "specification states that copy protection is an optional feature of the system." (Opp'n at 86:22-23.) That is simply untrue. The "statement" in the specification relied on by Acacia says that "the requested material may be copy protected." (Opp'n at 86:22-25 (citing col. 5:34-35).) What is optional is copy protecting specific information – it is not optional for the reception system to be capable of enforcing copy protection in the event the information requested by the user is in fact copy protected. Because the **requested material *may*** be copy protected, **the converters *must*** have the capability of enforcing this copy protection in the event that the requested material is copy protected.

Nonetheless, even if copy protection had been described as an optional capability of a reception system, all of the asserted claims directed to a "reception system" are broad enough to cover this allegedly optional reception system embodiment. Therefore, because the scope of the written description must be coextensive with the scope of the claims, the inventors would still have been required to adequately describe this reception system embodiment. *See supra* at Section III(D).

With respect to the third function "output converters 206" are supposed to perform, the specification cannot possibly adequately describe converters capable of "revers[ing] what took place in the Converter of the Transmission System" (Weiss Decl. ¶ 131), because the specification does not adequately describe the "converter 113" of the transmission system. *See supra* at Section VII(C). For example, the specification does not describe how that "converter 113" distinguishes between all of the various input formats and converts each into a single predetermined format. Thus, there can be no way to know how to reverse that process – how to convert the predetermined format back into the original format of the information, whatever that format might have been. Certainly, the specification does not describe either how to perform this function or the "detailed identity" of converters capable of performing this function.

Finally, the specification says nothing about what Acacia refers to as the "unnumbered output for compressed data." (Opp'n at 85:25.) The specification is silent about when this component is used, what causes information to be sent to there, what it actually does, etc. In fact, the specification discloses nothing about it at all, and the inventors did not even make the effort to assign a number to it in Fig. 6.

For all of these reasons, the specification does not contain an adequate written description of "output converters 206."

2. The Specification Does Not Contain an Enabling Disclosure of "Output Converters 206"

The "output converters 206" are components of the claimed "receiving system," which ***is*** the Yurt invention. In addition, because converters capable of performing the functions ascribed to them in the specification were not available off-the-shelf in 1991, the "output converters 206" themselves were novel. For both these reasons, the inventors were obligated to provide an enabling disclosure of converters 206 in the specification itself because they are a novel aspect of the invention. *See supra* at Section IV(A). The inventors breached that obligation.

Mr. Weiss opines that the specification "provided sufficient information about the inputs, functions, and outputs of [the converters'] subsystems that they could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, ***by applying the processes of system design that were normal for the development of such technological objects***."

(Weiss Decl. ¶ 133 (emphasis added).) This cannot defeat summary judgment. The enabling disclosure of "output converters 206" must be in the specification itself because they are a novel aspect of the novel "reception system." Moreover, Mr. Weiss's unsupported conclusion would not create a genuine issue of material fact even if the "output converters 206" were not a novel aspect of the invention. *See supra* at Section V.

Finally, Acacia is wrong when it says that "[n]othing in the claims, the specification, or the Court's construction of 'receiving system' requires the 'converters 206' or the 'receiving system' to output copy protected information or to include playback controls." (Opp'n at 87:17-19). The specification (improperly) attempts to define the converters only by the functions they are supposed to perform. It is only by reference to these functions that one could even try to guess as to what the claims mean, and the purported definition of these converters must therefore carry over into the claims. Moreover, these functions are not described as optional capabilities of the converters; it is only the *use* of these mandatory capabilities that is optional. Finally, even if these capabilities had been described as optional, the claims are broad enough to cover such an optional converter embodiment. An adequate description of this "optional" embodiment would therefore still have been required. *See supra* at Section III(D).

F. "User/Computer Interface 207" Is Neither Sufficiently Described Nor Enabled As A Matter Of Law

1. The Specification Does Not Contain an Adequate Written Description of "User/Computer Interface 207"

As Defendants explained in their motion papers (Mot. at 33:26-34:4), the specification cannot describe the "detailed identity" of the "user/computer interface 207" depicted in Fig. 6 because that interface is not so much as mentioned in the specification text. Acacia acknowledges this deficiency, but answers that the "***use***" of such an interface is described in the specification. (Opp'n at 88:27-89:3.) Even if true, that is insufficient to comply with the written description requirement, which commands disclosure of what the "user/computer interface 207" ***is***, not just the wish-list of things the inventor would like users to be able to do with it. *See supra* at Section

III(A).[55] The only thing the specification discloses about a structure that could implement these wished-for capabilities is that "specialized interfaces built into the reception system 200" would be required. (Col. 14:66-67). Because such "specialized" interfaces were not disclosed and, by definition, were not available off-the-shelf in 1991, the inventors did not disclose anything about what the "user/computer interface 207" ***is***. This is a textbook failure to comply with § 112.

Mr. Weiss has nothing pertinent to say on this subject. His opinion that "[i]nterfaces ***of the sort*** described" in the specification were known and that ordinarily skilled artisans "would have known about the ***sort of interfaces*** described and would have ***understood how to design and program them***" (Weiss Decl. ¶ 135 (emphasis added)) is irrelevant even if true. The fact that a design and development program might eventually lead to the claimed component is not a description of what that component is. *See supra* at Section IV(D).

Finally, while Acacia and Mr. Weiss purport to know what functions the "user/computer interface 207" performs notwithstanding the fact it is not mentioned in the specification, these functions are contradicted by other portions of the specification or are otherwise so vague as to be meaningless. For example:

> (i) Mr. Weiss says that "[t]he User/Computer Interface effectively serves as a terminal in the Reception System for interaction between a user and the system," and analogizes it to other known interfaces that "controlled the operation of the remainder of the consumer product of which they are part . . . ." (Weiss Decl. ¶¶ 134-135.) As is evident from Fig. 6, however, the "user/computer interface 207" is not connected to any other component of the receiving system, and thus cannot possibly provide for interaction with the receiving system or control of its operation;
>
> (ii) Both Acacia and Mr. Weiss rely heavily on the description of the "title window" (*see* col. 17:44-53) as if it was describing the capabilities of the "user/computer interface 207." (Opp'n at 88:27-89:3, Weiss Decl. ¶ 134.) The referenced passage from the specification, however, refers ***by name*** to the capabilities of the "library access interface 121" of the transmission system, ***not*** to the "user/computer interface 207" of the receiving system. Acacia and Mr. Weiss are relying on Mr. Weiss's own unilateral rewriting of the specification (already discussed and discredited in Section VII(J) above); and

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[55] The fact that the inadequate disclosure appears in the "original disclosure" does not cure this statutory defect. *See supra* at Section III(C).

> (iii) Acacia describes a function of the "user/computer interface 207" to be receipt of "input from the user via a viewer control interface, depicted in Figure 6 . . . ." (Opp'n at 88:12-13.) The text of the specification, however, makes no reference to this "viewer control interface" at all, and neither Acacia nor Mr. Weiss have any explanation of what it is. It is therefore impossible to know what "user/computer interface 207" would have to do (or would have to ***be***) to interact with it.

For all of these reasons, the specification does not contain an adequate written description of "user/computer interface 207."

2. The Specification Does Not Contain an Enabling Disclosure of "User/Computer Interface 207"

The "user/computer interface 207" is a component of the claimed "reception system," which ***is*** the Yurt invention. In addition, because a device capable of performing the functions ascribed to the "user/computer interface 207" was not available off-the-shelf in 1991, this interface itself is novel. For both these reasons, the inventors were required to provide an enabling disclosure of the "user/computer interface 207" in the specification itself because it is a novel aspect of the invention. *See supra* at Section IV(A). They did not.

Mr. Weiss opines that the specification "provided sufficient information about the inputs, functions, and outputs of [the interface 207's] subsystems that they could have been built and used by one of ordinary skill in the art, in early 1991, without undue experimentation, ***by applying the processes of system design that were normal for the development of such technological objects.***" (Weiss Decl. ¶ 136 (emphasis added).) This cannot defeat summary judgment. The enabling disclosure of "user/computer interface 207" must be in the specification itself because it is a novel aspect of the novel "reception system." Moreover, Mr. Weiss's unsupported conclusion would not create a genuine issue of material fact even if the "user/computer interface 207" was not a novel aspect of the invention. *See supra* at Section V.

The specification text does not so much as reference the "user/computer interface 207," much less describe what it is or even what it does. Consequently, one skilled in the art could not possibly make one.

G. The Receiving System's Reception Confirmation Capability Is Neither Sufficiently Described Nor Enabled As A Matter Of Law

1. The Specification Does Not Contain an Adequate Written Description of the Receiving System's Reception Confirmation Capability

As Defendants explained in their motion papers, the reception system 200 confirms to the transmission system that it received the information that was sent. (Mot. at 34:5-10.) This reception confirmation function is not optional (col. 17:1-7; 12-23; Weiss Decl ¶¶ 137-138.) The specification, however, does not teach (a) how the reception system performs this reception confirmation function; (b) which component of the reception system performs this reception confirmation function; or (c) the "detailed identity" of any device capable of performing this reception confirmation function. The specification therefore does not contain an adequate written description of the receiving system.

Acacia says that the inventors were not required to describe a reception system capable of performing the reception confirmation function because "Figure 6 (the Court's construction of 'receiving system') does not depict the 'reception confirmation function.'" (Opp'n at 90:6-10.) This makes no sense – a figure depicting a device cannot depict a "function." If what Acacia means is that the specification does not ascribe the reception confirmation function to any component of Fig. 6, then it is correct. Indeed, that itself is compelling proof that the specification does not adequately describe the reception system, because the specification teaches that the reception system of Fig. 6 can and must perform that function.

Acacia asserts that a receiving system that can perform the reception confirmation function is sufficiently described because the "original disclosure" says that the receiving system performs that function. (Opp'n at 90:4-5, 11-19.) This argument fails because written description requires disclosure of what a claimed device ***is***, not just what it ***does***, and the fact that the inadequate description appeared in the "original disclosure" does not excuse the failure to comply with § 112. *See supra* at Sections III(A) and (C).

Finally, Mr. Weiss's opinion that the reception confirmation function could have been implemented using the "software writing capability" ordinarily skilled artisans had in 1991 (Weiss

Decl. ¶ 138) is irrelevant even if true. The fact that a design and development program might eventually lead to the claimed device is not a description of what that device is. *See supra* at Section IV(D).

For all of these reasons, the specification does not contain an adequate written description of a receiving system that can perform the reception confirmation function.

2. The Specification Does Not Contain an Enabling Disclosure of the Receiving System's Reception Confirmation Capability

The reception system ***is*** the Yurt invention and, according to the specification, it must perform the reception confirmation function. Therefore, the inventors were required to provide an enabling disclosure of a reception system that can perform the reception confirmation function in the specification itself. *See supra* at Section IV(A). They did not.

Mr. Weiss opines that the specification "provided sufficient information about the inputs, functions, and outputs of such software systems that they could have been written and used by one of ordinary skill in the art, in early 1991, without undue experimentation, ***by applying the processes of system and software design that were normal for the development of such functions***." (Weiss Decl. ¶ 139 (emphasis added).) This cannot defeat summary judgment, because the enabling disclosure was required in the specification itself. Moreover, Mr. Weiss's unsupported conclusion would not create a genuine issue of material fact even if the reception system was not the Yurt invention itself.

Finally, Acacia misinformed Mr. Weiss when it told him that a description of the inputs, functions, and outputs of "software functionality" creates a "presumption of enablement." (Weiss Decl. ¶ 139); *see supra* at Section IV(A); *cf. Sherwood*, 613 F.2d at 816-17 (explaining that "a computer program may be a task requiring the most sublime of the inventive faculty"). This application of the wrong legal standard is yet another reason why Mr. Weiss's opinion should be disregarded.

IX. EACH ASSERTED CLAIM OF THE '992 AND '863 PATENTS IS INVALID FOR CLAIMING MORE BROADLY THAN THE SPECIFICATION DISCLOSES

A. Claim Scope Cannot Permissibly Exceed The Scope Of The Invention Disclosed In The Specification

As explained in Defendants' motion papers (Mot. at 35:1-36:27) and in Section III(D) above, the scope of the written description must be coextensive with the scope of the claims. When claims are broader than the scope of the written description, courts do not hesitate to grant summary judgment for lack of written description, lack of enablement, or both. *See, e.g.*, *LizardTech*, 424 F.3d at 1345, 1347 (affirming summary judgment for lack of written description and lack of enablement); *Auto. Techs.*, 501 F.3d at 1285 (affirming summary judgment for lack of enablement); *Sitrick*, 516 F.3d at 1002 (same).

Acacia "reminds" the Court of its legally erroneous position "that there is no rule that a claim has to be of equal or narrower scope than the specification," a position it says follows logically from the fact that claims are "frequently" broader than the disclosed embodiments. (Opp'n at 91:17-21.) This logic is flawed, as the one does not follow from the other. Claims ***can*** be permissibly broader than the disclosed embodiment, ***but*** that is only true if it is apparent from the specification that the disclosed species is representative of the claimed genus, such as when all members of the genus are interchangeable for purposes of the invention. If one member of a genus is disclosed as the preferred embodiment even though it is clear that any member of the genus would have worked, it might be possible to claim the entire genus. Otherwise, a claim to the genus is invalid because it is broader than the scope of the written description. *See supra* at Section III(E); *see also, e.g.*, *Auto. Techs.*, 501 F.3d at 1285 (affirming summary judgment for non-enablement because disclosed sensor "not just another known species of a genus consisting of sensors"); *Micro Therapeutics*, 2007 WL 2580594 at *2-3 ("narrow disclosure" supports "broader claim" only when the disclosed "species" "cover[s] the genus").[56]

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[56] *Micro Therapeutics* is one of the cases Acacia cites in support of its legally erroneous position that an inventor can claim more broadly than the scope of the invention

(continued...)

For the reasons explained below and in their motion papers, Defendants' summary judgment motions directed to the different ways the asserted claims are invalid as being impermissibly broader than the written description should be granted. Acacia does not demonstrate that any of the disclosed embodiments are representative species of a broadly claimed genus. In fact, Acacia ignores this legal test completely.

B. Each Asserted Claim Of The '992 And '863 Patents Is Invalid Because The Specification Does Not Disclose The Addressing Of Data Blocks Other Than Addressing Based On Time

As Defendants explained in their motion papers (Mot. at 37:1-9), this Court held that the claim element "sequence of addressable data blocks" ("SOADB") is not limited to time encoding, but is instead "a very broad limitation which could include time encoding, as well as other ways of generating addressable data blocks." (3rd CCO at 27:20-22.) Because Acacia knew, and stated many times (*see* Mot. at 37:13-39:1) that the Yurt specification does not disclose or suggest any addressing schemes other than "time encoding," Acacia knew that the Court's construction was the death knell for all of the asserted claims of the '992 and '863 patents, which all contain the SOADB limitation. Therefore, it moved for reconsideration, and again tried to convince the Court to limit SOADB to "time encoding." It failed – the Court reaffirmed its claim construction. (5th CCO at 14:23-25.)

In view of this history, there is no colorable argument that the claimed SOADB (which the Court twice held is broader than "time encoding") is commensurate in scope with the specification (which Acacia admits contemplates only "time encoding") as § 112 requires. Therefore, Acacia's front-line response to Defendants' motion is, in effect, another reconsideration motion – it argues, for the third time now, that SOADB is limited to time encoding. Granting this renewed motion would violate the rule prohibiting courts from redrafting claims to preserve validity. *See Phillips*, 415 F.3d at 1327-28 (court cannot redraft a claim to correct a § 112 violation); *Rhine v. Casio, Inc.*, 183 F.3d

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[56] (...continued) disclosed. (Opp'n at 93:12-14, n.32.) However, neither *Micro Therapeutics* nor any of the other cases cited by Acacia support that position. Indeed, all are consistent with Defendants' summary of § 112 law as articulated herein and in their motion papers.

1342, 1345 (Fed. Cir. 1999) (claims should not be interpreted to preserve their validity if such an interpretation is contrary to the claim's language and written description).

The claim limitations of the '992 and '863 patents directed to creating a SOADB must of necessity be limited to "time encoding," Acacia says, because the steps of these claims must be performed by a "transmission system," and a "transmission system" is only capable of time encoding. (Opp'n at 92:1-93:5.)[57] This turns the written description requirement on its head. It is precisely ***because*** a transmission system can only perform "time encoding," while the claims are broad enough to cover other ways of sequencing and addressing, that the claims fail to comply with the written description requirement. A claim that is broad enough to cover driving a car on the ground or flying it through the air cannot be judicially rewritten to cover only ground transportation simply because cars are not capable of flying – such a claim would be invalid for failure to comply with the written description requirement. *See Phillips*, 415 F.3d at 1327-28. So it is with the asserted claims of the '992 and '863 patents. Claim 41 of the '992 patent, for example, covers the transmission method, "performed by a transmission system, of . . . placing the formatted data into a sequence of addressable data blocks." Because a "transmission system" can only place data into a sequence of addressable data blocks by using time encoding, the claims are invalid because they impermissibly cover any method for creating a sequence of addressable data blocks.

If creating a SOADB is broader than time encoding, Acacia says, it is still adequately described because it is "exactly like" the example provided in *In re Smythe*, "where the court described the hypothetical situation of a specification which narrowly describes only a 1-pound 'lead weight,' as a counterbalance to determine the weight of a pound of flesh, as providing adequate written description for a" claim broad enough to cover use of "a pound of feathers" instead of the 1-

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[57] Ironically, when it suited Acacia to take the contrary position, it argued that the creation of a SOADB in the claims of the '863 patent need not be performed by a "transmission system," going so far as to try to repudiate its stipulation that the steps of those claims ***are*** performed with a "transmission system." (Opp'n at 104 n. 40.)

pound lead weight. (Opp'n at 93:10-94:2 (citing *Smythe*, 480 F.2d at 1384).) Not only is the SOADB limitation not "exactly like" the *Smythe* example, the contrast between them powerfully demonstrates the difference between those situations where it is and is not proper to claim more broadly than the preferred embodiment. The *Smythe* hypothetical is a perfect example of disclosure of a species (a one pound *lead* weight) that is representative of the broad genus (one pound weights) – all types of one pound weights are interchangeable for use as a counterbalance to determine the weight of a pound of flesh.

In contrast, all ways of sequencing and addressing are ***not*** interchangeable, as Acacia itself has argued many times. For example, in its brief in support of its motion for reconsideration, Acacia said that "[t]he patent specification describes many different addressability functions that are achieved using time encoding. Not only is there no statement or suggestion in the specification that all of these functions (let alone any of these functions) could be achieved using a method for addressability other than time encoding, ***the language of the specification indicates time encoding is required***." (5/18/07 Acacia Mem. of Points and Authorities in Supp. of its Motion for Recons. of Certain Claim Construction Terms ("5/18/07 Acacia Br."), docket no. 237, at 17:8-12, n.22 (emphasis added).) Thus, not only is the species of "time encoding" not representative of the broad genus of "sequencing" and "addressing," according to Acacia, the specification teaches that ***only*** time encoding would work.[58] Because the inventors claimed more broadly than "time encoding," they did not comply with the written description requirement.

Finally, Acacia argues that the SOADB limitation must necessarily satisfy the written description requirement because it appears in the "original disclosure" and originally filed claim 1. (Opp'n at 94 n.33.) As explained in Section III(C) above, however, the fact that an inadequate description appeared in the original disclosure or claims does not excuse the failure to comply with

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[58] Even if the step of creating a SOADB was limited to "time encoding," it would still not be adequately described because the "time encoder" that performs the "time encoding" is not adequately described. *See supra* at Section VII(D)(1).

§ 112.

For all these same reasons, the asserted claims of the '992 and '863 patents are not enabled either. Moreover, because the specification does not even provide an enabling disclosure of the "time encoder" (*see supra* at Section VII(D)(2)), it cannot possibly enable creation of a "sequence of addressable data blocks" in ways that cover, but are not limited to, "time encoding."[59]

C. Claims 41 And 45 Of The '992 Patent And Claims 17-19 Of The '863 Patent Are Invalid Because The Specification Does Not Disclose Sending Information Other Than In Response To User Requests

Acacia agrees that method claims 41 and 45 of the '992 patent and method claims 17-19 of the '863 patent do not require that user requests be sent to the transmission system. (Opp'n at 95:13-19.) However, the only methods disclosed in the specification require that user requests be sent to the transmission system; the disclosed "transmission system" only processes and transmits information in response to user requests. As Defendants detailed in their motion papers:

> (i) every disclosed method of sending information from the transmission system requires that the transmission system first receive a user request. (*See* Mot. at 39:15-16.) The method of Fig. 3 requires it. (Col. 14:30-33). The method of Fig. 4 requires it. (Col. 15:20-22). And the method of Fig. 7 requires it. (Col. 19:21-24);
>
> (ii) the broadest statement of the invention in the specification refers to a "transmission and receiving system . . . in which the ***user controls*** the access and the playback of ***selected material***" (*see* Mot. at 39:19-24 (citing col. 1:6-10));
>
> (iii) the specification repeatedly emphasizes that the invention relates to satisfying user requests (*see* Mot. at 40:1-16);
>
> (iv) every prior art reference disclosed in the specification was distinguished based on the purported invention's user request capabilities, and the inventors relied on the user request capabilities to distinguish prior art during prosecution (*see* Mot. at 40:17-18, n.27);
>
> (v) the specification repeatedly and unambiguously says that the information processed by the transmission system is user "requested information" (*see* Mot. at 40:18-20);

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[59] Dr. Walter's opinion that general methods of addressing other than using time codes are known (*see* Opp'n at 94:8-95:2 (quoting 7/17/07 Decl. of Stephen M. Walters (Block Decl. Ex. 5) at ¶ 40)) is not relevant. As admitted by Acacia, none of those other methods would work in the claimed "transmission system."

(vi) the Sarnoff Report says the specification is directed to a "video-***on-demand***" system (*see* Mot. at 40:22-41:1 (emphasis added); and

(vii) Acacia's expert Mr. Weiss previously testified that the specification "describes a system [for] distribution . . . to receiving locations at the request of end users . . . often called video on demand," and that the specification is "fundamentally . . . about" "video on demand" (*see* Mot. at 41:1-4.)

Finally, consistent with this overwhelming and incontrovertible evidence, this Court itself has already held that "[e]very part of the specification clearly states an intent by the inventors that the 'transmission system' and the 'receiving system' process, store, send and receive the information specifically in response to 'users.'" (6th CCO at 4 n.5.) For all of these reasons, none of which Acacia disputes, claims 41 and 45 of the '992 patent and claims 17-19 of the '863 patent are invalid. These claims, which do not require user requests at all, impermissibly exceed the scope of the disclosed invention.

Acacia's response is remarkable for its audacity. Notwithstanding all the undisputed facts listed in (i)-(vii) above, Acacia contends that because the paragraph at col. 2:25-48 (listing components of the transmission system) allegedly does not *itself*, in that one paragraph, reference user requests, this somehow constitutes disclosure of an inventive method that does not require user requests. (Opp'n at 95:20-96:5.) There is simply no requirement that the "fundamental" aspects of a purportedly inventive method, its point of novelty, or the subject matter to which it is directed be recited in every single paragraph of the specification, including paragraphs which only list the components that implement that method. Certainly, failure to do so does not constitute disclosure of a ***different*** invention as Acacia alleges.

In this instance, however, the paragraph relied on by Acacia ***does*** recite and require user requests. The list of components at col. 2:25-48 is preceded by the statement that those components are provided "[t]o achieve the objects in accordance with the purposes of the present invention" that the inventors set forth immediately above at col. 1:57-2:15. Every single one of those objects is directed to satisfying user requests. For this additional reason, the paragraph relied on by Acacia cannot possibly constitute disclosure of a method that does not require user requests. The Court was correct when it said that "***[e]very part*** of the specification states an intent by the inventors that the 'transmission system' and the 'receiving system' process, store, send and receive the information specifically in response to 'users.'" (6th CCO at 4 n.5.)[60]

Acacia similarly relies on originally filed claim 1 (Opp'n at 96:11-17), which lists the same components that are listed in the specification at col. 2:25-48. (*See* Block Decl. Ex. 3, docket no. 324-2, at claim 1 (p. 21).) The fact that these components were listed in an originally filed claim does not any more describe a method without user requests than the list of these components in the originally filed specification. Acacia's reliance on originally filed claim 1 is thus misplaced for the same reasons described above with respect to its reliance on the paragraph at col. 2:25-48. Tellingly, every originally filed ***method*** claim does require a user request. (*Id.* at claim 18-21 (p. 26 -27).) It was only much later that the inventors decided to try to expand their claimed methods beyond user requests.

Acacia also says that the list of components recited at both col. 2:25-48 and originally filed claim 1 does not contain any component "capable of receiving a user request." (Opp'n at 95:24-25, 96:15-16.) Obviously, the inventors disagreed with Acacia, because, as explained above, they expressly stated that those components implemented the user-request objects of the invention (col. 2:25-28), and further described the source material library (*see* col. 2:62-66, 18:53-56, Fig. 7 block 412), the compressed data library (col. 11:25-26), and the "transmitter means" (col. 13:40-45) as all responding to user requests.[61] Even if Acacia is correct, however, and the inventors were wrong when they said that these components satisfy the user-request objects of the invention and receive user requests, all that would mean is that they disclosed an inoperative embodiment. That would not constitute disclosure of a ***method*** that does not include a user request.[62]

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[60] Acacia ignores this ruling, but relies on the Court's construction of "transmission system" "as not including any component capable of receiving a user request." (Opp'n at 96:6-10.) That reliance is misplaced, because the Court categorically ***never*** said that in either form or substance. It is similarly difficult to understand Acacia's reliance on the Court's finding that claim 1 of the '992 patent does not require a user request. (Opp'n at 96:18-97:3.) Because it is an apparatus claim, it would not and could not contain the method step of receiving a user request, but it is unclear how that helps Acacia.

[61] The fact that originally filed claim 7 adds yet another component capable of receiving user requests to the list (*see* Opp'n at 96 n.35) is irrelevant.

Finally, even if the inventors were somehow affirmatively attempting to describe a transmission method that does not require user requests, by simply not including "user request" in every sentence of their specification, they utterly failed. For example, there is no description even of how information gets selected for transmission other than based on user requests, much less the "detailed identity" of a transmission system that operates without user requests.

For all of the above reasons, claims 41 and 45 of the '992 patent and claims 17-19 of the '863 patent are invalid for failure to comply with the § 112 written description and enablement requirements. For these same reasons, the claims are invalid for failure to comply with the § 112 ¶ 2 requirement that the inventors set forth "the subject matter which the applicant regards as his invention." *See* 35 U.S.C. § 112 ¶ 2. The inventors regarded their invention to be a "transmission system" and "receiving system" that provided user-request capabilities, but that is not what they claimed.

D. Claims 41 And 45-46 Of The '992 Patent Are Invalid Because The Specification Does Not Disclose A Transmission System That Transmits Information To "Remote Locations" That Do Not Have A Receiving System

Claims 41 and 45-46 of the '992 patent require sending information from the transmission system to "one [and only one] of the remote locations."[63] (Col. 25:4-5). The Court has defined "remote locations" to mean "positions or sites distant in space from the transmission system" (3rd

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[62] Mr. Weiss's opinion that originally filed apparatus claim 1 is an "indicator" that the inventors "included a method that did not require a request in advance of transmitting content" (Weiss Decl. ¶ 141) must be disregarded – it is just legal argument. The legal analysis he performs to reach that conclusion, including something resembling claim differentiation (*id.* at ¶ 142), is outside the scope of his technical expertise.

[63] The Court construed "one" remote location to mean "a single remote location." (3rd CCO at 31:9-17.) Sending to two or more remote locations is not covered by the claims.

CCO at 12:3), and the parties agree that a remote location need not have a "reception system" or any other type of receiving device. (Opp'n at 97:10-14.) Because the specification does not disclose a transmission from a transmission system that is not received by a receiving system, much less transmission to "one" and only "one" remote location that does not have a receiving system, these claims are invalid under § 112. Acacia does not explain where in the specification the inventors disclosed that transmission to one remote location that does not have any type of receiving device whatsoever is part of their invention, or why the inventors could have believed that transmitting to a vacuous remote location would have been a useful thing to do.

As Defendants explained in their motion papers (Mot. at 42:13-43:2):

(i) the specification says that ***all*** transmissions from the transmission system are to reception systems (col. 15:33-37 (emphasis added));

(ii) the broadest statement of the invention in the specification says that it "relates generally to an audio and video transmission and ***receiving system***" (col. 1:6-7);

(iii) every configuration of the invention depicted in the figures (Figs. 1a, 1b, 1c, 1d, 1e, 1f, and 1g) requires the transmission system to send information to a reception system;

(iv) the output from every one of the transmission system's transmitters and transceivers depicted in Fig. 2b is shown going "to customer's receiving system";

(v) every method disclosed in the specification requires sending information from the transmission system to a reception system (col. 4:1-3, 14:3-5, 16:56-58, 19:24-27); and

(vi) even the title of the Yurt patents is "Audio and Video Transmission and ***Receiving System***."

Acacia does not directly dispute any of these facts. Instead, although the specification is clear when read holistically that there is a reception system at every remote location to which the transmission system directs information, Acacia cites snippets of sentences which do not expressly say this and asks the Court to interpret these out-of-context snippets as the disclosure of a completely different invention whereby a transmission system transmits information to one empty remote location having no way to receive the information. The Court should reject this invitation to legal error.

Indeed, the words relied on by Acacia are taken so out of context that even the immediately surrounding words make it clear that there is a reception system at the remote location. For example, it is clear from the text quoted by Acacia from col. 2:25-48 (Opp'n at 98:3-6) that the "transmitter means" that sends the information to "a specific one of the remote locations" is in the transmission system that is part of the "transmission and ***receiving system***" referenced in the quoted text. (Opp'n at 98:4.) Thus, the referenced "transmitter means" transmits ***to the receiving system***. Moreover, using a mean-plus-function analysis, that "transmitter ***means***" refers to, *inter alia*, the transmitters and transceivers depicted in Fig. 2b, each of which sends information to a "customer's receiving system."[64] For both these reasons, there is a receiving system at the remote location.

The same is true of the passage Acacia relies on from col. 15:61-65. (Opp'n at 98:16-19.) The sentence in the specification immediately following the one provided by Acacia makes it clear that the "transmitter means 122" is in the "transmission system" piece of "[t]he transmission and ***receiving system***," and therefore sends the information to the "receiving system" piece. (Col. 15:65-67). Moreover, the referenced "transmitter ***means*** 122" again includes the transmitters and transceivers depicted in Fig. 2b, which send information to a "customer's receiving system." This excerpt too, then, requires that there be a receiving system at the remote location.

The passage from col. 2:49-61 relied on by Acacia (*see* Opp'n at 98:10-14) is the description of a "distribution method." Because it is the description of a method, the structure of the "reception system" is not identified, but the functions performed by the reception system are identified – "receiving," "buffering," and "playing back the buffered information in real time at a time requested by the user." (*Id.* at 98:13-14.) The same is true of originally filed method claim 18 (Opp'n at 98:23-99:4), which requires these precise same reception system functions to be performed. (Block

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[64] The components listed in originally filed claim 1, also relied on by Acacia (Opp'n at 98:19-22), are the same as those listed at col. 2:25-48, including the "transmitter ***means***." Thus, the same reasoning applies as to why that "transmitter means" must transmit to a receiving system.

Decl. Ex. 3, docket no. 324-2, at claim 18 (p. 26).)[65] Therefore, in both instances there must be a reception system at the remote location to perform these reception system functions. Claims 41 and 45-46 of the '992 patent, by way of contrast, do not require either sending the information to a reception system or performing the functions of a reception system after the information is sent.

Next, Acacia says that the specification discloses that the "remote location" to which the "transmission system" transmits can have a playback device, such as a television, instead of a receiving system. (Opp'n at 99:5-20.) Even if that were true, it would be of no help to Acacia, because claims 41 and 45-46 of the '992 patent do not call for the transmission system to transmit to a receiving system, a playback device, or any type of receiving device whatsoever. Thus, even if the specification did disclose that a transmission system can transmit directly to a playback device at a remote location, these claims would still be invalid, because they do not require that any type of device be present at the remote location.

In fact, however, the specification ***does not*** disclose that a transmission system can transmit directly to a playback device. The transmission system always transmits to the receiving device, and it is the receiving system that plays the information back on a playback device. (*See* col. 17:67-18:37). The methods of Figs. 3, 4 and 7 relied on by Acacia (Opp'n at 99:13-20) each separately make it clear that the transmission system transmits to the receiving system, not the playback device. For example, the method of Fig. 3 ends with an order placed on the transmission queue (col. 14:45-48 (step 3110)), and the specification says that ***all*** orders on the transmission queue are sent to the receiving system (col. 15:33-37). The same is true of the methods of Fig. 4 (col. 15:3-35), and of

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[65] Acacia's reliance on originally filed claims seems to be predicated on its belief that claim elements (or the failure to include claim elements) in originally filed claims provide their own written description and enablement. That is not the case. "If a purported description does not meet the requirements of the statute, the fact that it appears as an original claim or in the specification does not save it. A claim does not become more descriptive by its repetition, or its longevity." *Enzo*, 323 F.3d at 968-69. Thus, even if these originally filed claims did not included reception systems, that would have been of no help to Acacia.

Fig. 7 (col. 19:21-24).[66] As Acacia's own expert said, the transmission system is not useful without the reception system, because a playback device cannot play back the transmitted information without the reception system to decode what the transmission system coded. (Weiss Decl. ¶¶ 116-117.)[67]

Acacia's final argument is that the specification teaches that the transmission system can transmit to receiving systems using satellite communications, and "[p]ersons of ordinary skill in the art would have understood that such transmitters broadcast information generally to all remote locations within a geographic area, whether or not a receiving system exists at any particular remote location." (Opp'n at 100:2-4 (citing Fig. 2, 16:62-68, 17:12-24).) This, too, is of no use to Acacia. Both the text of the specification (*see*, *e.g.*, col. 16:53-68, 17:12-24), and the figures (*see*, *e.g.*, Fig. 2b) teach that the transmission via satellite is to a receiving system. At best, what the disclosure of satellite transmission teaches is that the transmission system transmits to a remote location that has a reception system and, incidently, ***also*** transmits to other remote locations. That cannot support claims 41 and 45-46 of the '992 patent because: (i) those claims cover transmissions that are not received by a receiving system at all; and (ii) those claims require transmission to ***one*** remote location, and there is no disclosure of a transmission to ***one*** remote location that does not have a receiving system.

In sum, the inventors did not describe the nonsensically useless method of transmitting to one, empty remote location which claims 41 and 45-46 of the '992 patent cover. Those claims are therefore invalid under § 112.

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[66] Acacia also relies on the passage at col. 12:24-27 (Opp'n at 99:18-20), but that too requires that distribution be performed by the transmission system's "distribution manager" (col. 12:21-24), which only transmits to receiving systems (col. 15:33-37).

[67] Mr. Weiss's opinion that the inventors were in "possession" of the step of transmitting to one of a plurality of remote locations (Weiss Decl. ¶ 146) should be disregarded because it is conclusory and unsupported, and because "possession" is not the correct standard for compliance with the written description requirement. *See supra* at Sections V and III(A).

E. Claims 17-19 Of The '863 Patent Are Invalid Because The Specification Does Not Disclose A Distribution Method In Which Compressed Data Is Not Stored In The Transmission System

As the Court previously observed (6th CCO at 8:15-26), the specification says that compressed data "***must***" be stored in the "compressed data library 118" ("CDL 118") of the transmission system before transmission to the reception system can occur. (Col. 6:35-39). Every disclosed method requires storage in the CDL 118 before the transmission system transmits to the receiving system, and Acacia admits that a transmission system cannot operate without storing information in the CDL 118 before transmitting it. (Opp'n at 101:5-8.) Because, as Defendants explained in their motion papers (Mot. at 43:9-44:10), claims 17-19 of the '863 patent broadly cover methods in which data is compressed and immediately transmitted by the transmission system without first storing it in the CDL 118, those claims are invalid under § 112.[68]

Acacia's principal response is that these claims do require storage in CDL 118 because the step of transmitting occurs "from a transmission system." Therefore, Acacia says, the transmitting step must be performed by the transmission system, and a transmission system necessarily stores information in the CDL 118 before transmitting it. (Opp'n at 100:21-101:8.)[69] Like the similar argument it made with respect to the "sequence of addressable data blocks" limitation (*see supra* at Section IX(B)), this argument turns the written description requirement on its head. It is precisely because these claims cover methods performed by a transmission system that are not described in the specification and cannot be performed by the disclosed transmission system that they are invalid.

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[68] Acacia complains that nothing in those claims requires the information to be immediately sent by the transmission system without first storing it. (Opp'n at 100:14-16.) Assuming *arguendo* that is true, the claims are still broad enough to cover such immediate transmission. That is why they are invalid – the scope of the claims is not coextensive with the scope of the disclosure as required by § 112. *See supra* at Section III(D).

[69] This argument contradicts the argument Acacia later makes that the first claim 17 step of "formatting" is ***not*** performed by a transmission system, even though that step is performed "at" a transmission system (and even though Acacia stipulated that the formatting step ***is*** performed by a transmission system). (Opp'n at 104 n.40.)

The Court cannot judicially rewrite the claims to add a step of storing in a compressed data library simply because there is no written description of a transmission system that does or can perform only the steps that are recited in the claims. *See Phillips*, 415 F.3d at 1327-28; *Rhine*, 183 F.3d at 1345.

Acacia also says that claims 17-19 of the '863 patent require storage in a CDL 118 because they call for storage in a ***reception system*** (not in a transmission system) and because, even though the specification never refers to "storage 203" in the reception system as a "compressed data library," Mr. Weiss allegedly says it is one.[70] (Opp'n at 101:9-19.) Even if all this is true, it is of absolutely no help to Acacia. The specification says that the information ***"must"*** be stored in the CDL ***118*** which is in the ***transmission system***, not the reception system. Moreover, every disclosed method requires storage in the CDL 118 of the transmission system and, as Acacia admits, a transmission system cannot transmit information without first storing it in CDL 118. Because claims 17-19 of the '863 patent do not require storage in the CDL 118 of the transmission system before the transmission system transmits to the reception system, those claims are invalid. The fact that the claims call for storage in the reception system does nothing to save them.

Finally, Acacia relies on the fact that originally filed claim 22 does not recite a step of storing in a CDL 118 of a transmission system. (Opp'n at 101:20-102:4.) However, that claim is an ***apparatus claim*** that sets forth the components of a ***receiving system***, not a transmission system. (Block Decl. Ex. 3, docket no. 324-2, at claim 22 (p. 28).) Such a claim would not and could not contain a ***step*** of storing in the CDL 118 of a ***transmission system***. Certainly, the claim does not constitute disclosure of a method of transmitting information to a reception system without first storing it in the CDL 118 of the transmission system.

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[70] In fact, Mr. Weiss does not say that "storage 203" is a "compressed data library." What he says in the paragraph relied on by Acacia (Weiss Decl. ¶ 122) is that "storage 203" "corresponds" to the CDL 118 in that it "complements the functionality" of CDL 118. Not only does storage 203 not perform the processing that a CDL 118 performs, it does not even reverse the processing performed by a CDL 118. (*Id.*)

However, even if, somehow, original ***reception system apparatus*** claim 22 did set forth a ***transmission system method*** that does not include storage in CDL 118, claims 17-19 of the '863 patent would still lack adequate written description because the specification does not describe a transmission system that is capable of carrying out that method. The fact that an inadequate description appeared in the original disclosure or claims does not excuse the failure to comply with § 112. *See supra* at Section III(C).

F. Claim 46 Of The '992 Patent Is Invalid Because The Specification Does Not Disclose A User Request For Information Without A User-Inputted Selection Of the Reception System To Which The Information Is To Be Sent

As explained in Section IX(C) above, every method disclosed in the specification requires that a user request for information be sent to the transmission system before the transmission system processes and sends the information to a reception system. However, the specification requires even more; it requires that the user's request to the transmission system include the location of the reception system to which the information should be sent. The method of Fig. 3 requires it. (Col. 14:30-33). The method of Fig. 4 requires it. (Col. 15:20-22). And the method of Fig. 7 requires it (Col. 19:21-24). As Defendants further explained in their motion papers, the inventors relied on this capability to distinguish prior art. (Mot. at 44:13-24.)[71] Because claim 46 of the '992 patent does not require that the "requests from users" include user-input identification of the "reception system" to which the information is to be sent, it is invalid for being broader than the invention disclosed.

Acacia responds that the Court has already determined that "'[t]he specification discloses a configuration that does not require a user to select a particular location.'"[72] (Opp'n at 102:26-103:12

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[71] Because ***every*** disclosed method requires that the user request include a location selected by the user, Acacia's observation that one of the passages from the specification Defendants relied on (*see* col. 5:10-21) applies only to "direct connection configurations" is of no probative value. (Opp'n at 103 n.39.) The specification does not say that non-direct connection configurations work any differently in this regard.

[72] Acacia's plea that the Court not consider this motion (Opp'n at 102:17-25) barely even merits a response. The point of the unusual procedure by which Defendants provided

(continued...)

(quoting 1st CCO at 5:15-21).) Acacia's reliance on this Order demonstrates that it does not understand the issue the Court was resolving, and what the Court actually decided.

The Court was asked early in the case by Acacia and the Round 1 Defendants to construe the term "remote locations" (plural). The Round 1 Defendants asked the Court to construe "remote locations" to mean "***more than one*** location selected by the user." (1st CCO at 4:12-15 (emphasis added).) The Court rejected the Round 1 Defendants' construction because, *inter alia*, the "airwave communication channels" embodiment of Fig. 1g, which the Court noted still transmits "***requested*** material" (1st CCO at 5:16-18), transmits that "requested material" to users other than the user that "requested" it. In other words, while the embodiment of Fig. 1g does transmit to ***a*** location selected by the requesting user, all of the location***s*** (plural) to which it transmits were not selected by that user. Thus, the Court found there was no basis to construe the term "remote locations" to mean "***more than one*** location selected by the user." The Court did not say or decide anything that contradicts the specification's requirement that user requests include a location to which the information is to be sent; the issue of whether user requests must include a location was not before the Court.[73]

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[72] (...continued)
Acacia with an advance list of the motions Defendants intended to make was so Acacia could identify in advance which motions it would not oppose, thereby obviating the need for Defendants to brief those motions. Acacia has not agreed to stipulate to this motion, so identifying it in advance would have served no purpose. Acacia identifies no prejudice it would suffer from the Court's consideration of this motion (other than, of course, the prejudice associated with the Court's granting of the motion).

[73] Acacia's contention that the specification discloses embodiments in which no user requests are made at all (Opp'n at 103:13-16) is meritless for the reasons explained in Section IX(C) above.

X. EACH ASSERTED CLAIM OF THE '992 AND '863 PATENTS IS INVALID FOR CLAIMING METHOD STEPS THAT ARE NOT DESCRIBED, OR ARE INADEQUATELY DESCRIBED, IN THE SPECIFICATION

A. Claims 17-19 Of The '863 Patent Are Invalid Because The Specification Does Not Describe Or Enable "Inputting An Item Having Information Into The Transmission System"

Claims 17-19 of the '863 patent recite the step of "inputting an item having information into the transmission system" (the "Inputting Step"), which the Court has construed to mean "putting physical items containing audio information or video information or both into the transmission system." (4th CCO at 12:10-12.) For all of the reasons identified in Defendants' motion papers (Mot. at 45:15-48:4), including the Court's previous rulings, the parties' stipulations, Acacia's own previous affirmative arguments and judicial admissions regarding the failings of the specification, and the plain language of these claims, Defendants fully expected Acacia to stipulate that these claims were invalid. Regrettably, Acacia instead chose to oppose the motion by attempting to rewrite the claims, rewrite written description law and even rewrite history.

The Inputting Step is part of the "formatting step" of claim 17 (*see* '863 patent, col. 22:39-41 ("wherein the formatting step comprises [the Inputting Step]")), which in turn is performed "at a central processing location" (*see* '863 patent, col. 22:23-24 ("formatting . . . at a central processing location")). The Court construed "central processing location" to mean a "transmission system." (4th CCO at 6:18-20.) Thus, because the Inputting Step must be performed "***at a***" "transmission system," it has always been evident to all of the parties, including Acacia, that the step is performed ***by the*** transmission system.[74] The parties therefore stipulated to this almost three years ago, and have conducted all the subsequent claim construction proceedings with that understanding. The following paragraph is from the parties' July 21, 2006 stipulation:

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[74] It is this very same reasoning that Acacia itself relies on to conclude that another one of the claim 17 "formatting steps," that of "formatting . . . as a sequence of addressable data blocks" (*see* '863 patent, col. 22:44-45), is performed by the transmission system. (Opp'n at 92:1-23.) Acacia also says that the step of "transmitting. . . ***from the*** transmission system" (*see* '863 patent, col. 22:25-27) must be performed ***by the*** transmission system. (Opp'n at 100:21-101:8.)

> 6. In Claim 17 of the '863 patent, the "formatting step" includes, but is not limited to, the steps of:
>
> ***(a) "inputting an item having information into the transmission system;"***
> (b) "assigning a unique identification code to the item having information;"
> (c) "formatting the item having information as a sequence of addressable data blocks;"
> (d) "compressing the formatted and sequenced data blocks."
>
> These steps are part of the step of "formatting items of audio/video information as compressed digitized data at a central processing location." While the parties disagree on the meaning of "central processing location," ***the parties agree*** that the transmission system is located at the central processing location and ***that the formatting steps, including steps (a) - (d) listed above, are performed by the transmission system.***

(*See* Benyacar Decl. Ex. H, docket no. 293-9, at ¶ 6 (emphasis added).)[75] The Court has already determined (4th CCO at 23:15-20, 23-26 (quoted by Defendants, Mot. at 46:3-11)), and Acacia does not dispute, that the specification does not describe a transmission system (or any structure at all) that can perform the Inputting Step. For this reason alone, Defendants' motion should be granted.

In spite of the plain language of the claims, Acacia's stipulation and the course of the last three years of claim construction proceedings, Acacia now says, for the very first time, that the Inputting Step does not have to be performed by a transmission system. It speculates that the Court rejected the parties' stipulation based on the fact that the Court's construction of the Inputting Step does not include the requirement that it be performed by a transmission system. (Opp'n at 104:20-22, n.40.) Acacia's speculation notwithstanding, the Court never said that it rejected the parties' stipulation. The parties agreed that all of the "formatting" steps, including the Inputting Step, had to be performed by a transmission system, entered into a stipulation to that effect, and submitted that stipulation to the Court. (*See* Benyacar Decl. Ex. H, docket no. 293-9, at ¶ 6; Benyacar Reply Decl.

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[75] In Defendants' memorandum in support of its summary judgment motions, Defendants incorrectly cited to ¶ 5 pertaining to claim 14 of the '863 patent. (*See* Mot. at 45:17-22.)

Ex. B (9/8/06 Hr'g Tr.) at 92.) Consequently, there was no need for the Court to include this in its claim construction order.

The Court should reject Acacia's attempt to renege on its claim construction stipulation. After three years of claim construction proceedings conducted with the understanding that the Inputting Step must be performed by a transmission system, Acacia should not now be permitted to change its position simply because it read Defendants' summary judgment motion and realized the claims are invalid. This Court addressed a similar issue in *JSR Corp.* v. *Tokyo Ohka Kogyo Co.*, where a patentee attempted to renege on a claim construction stipulation after the defendant moved for summary judgment of invalidity:

> JSR essentially proposes a construction that it *never before* identified or disclosed and implores the Court to adopt JSR's latest definition . . . . The Court is not inclined to alter a stipulated claim construction that has been operative for **nine months** simply because JSR has, upon receipt of TOK's summary judgment motion, recognized that its prior attempt to construe the claim scope broadly inevitably leads to a holding of invalidity in view of the prior art . . . .
>
> * * *
>
> JSR made the strategic decision to agree to a broad construction of the term, and it now essentially asks the Court for permission to renege on its agreement and to amend the Joint Claim Construction Statement to avoid invalidity. But TOK and the Court relied on the stipulated construction. The parties and the Court abandoned a timely claim construction hearing, and TOK prepared and filed its summary judgment motion. The Court finds that, to ignore the stipulated construction and to consider a never before identified construction of the term in the '104 patent would encourage the "vexatious shuffling of positions" that the patent local rules were designed to avoid.

2001 U.S. Dist. LEXIS 24959, at *16-18 (N.D. Cal. Sept. 13, 2001) (Ware, J.) (emphasis added). Here, the Court and the parties relied on the stipulation for ***three years***. Acacia's attempt to change its position now, after three years of claim construction proceedings based on its stipulation have concluded, is far more a "vexatious shuffling of positions" than this Court refused to allow in *JSR*.

Nonetheless, even assuming *arguendo* that the claims do not require the Inputting Step to be performed by a transmission system, the specification still does not adequately describe that step, because it does not describe that step ***at all***. As the Court has held, "the written description is devoid of any discussion of an apparatus ***or process*** for 'inputting' those items into the source material library." (4th CCO at 23:16-18 (emphasis added).) There is not even any dispute about that. Acacia says in its opposition papers that "[i]t is true that the disclosure of the Yurt Patents does not use the specific words or present drawings which explicitly state or depict that an item of information is input into the 'transmission system' or, more specifically, is input into the 'source material library' of the 'transmission system.'" (Opp'n at 105:6-9.) The Inputting Step is simply not described in the specification at all, either as performed by a transmission system or otherwise.

Acacia's only response to this fatal deficiency is its contention that the specification inherently discloses "that the item having information must first have been input (*i.e.*, put into) the source material library." (Opp'n at 106:4-12.) Acacia plainly misunderstands the inherency doctrine and the Federal Circuit's holding in *Tronzo v. Biomet, Inc.*, 156 F.3d 1154 (Fed. Cir. 1998), on which it relies. The inherency doctrine does not vitiate the statutory written description requirement as Acacia suggests. As the Federal Circuit said in *Tronzo*, claimed subject matter is inherently disclosed only if it is necessarily present ***in the specification***. "In order for a disclosure to be inherent . . . the missing descriptive matter must necessarily be present ***in the parent application's specification*** . . . ." 156 F.3d at 1159 (emphasis added).[76] In other words, something actually disclosed in the specification must necessarily refer to the subject matter claimed, such that the inventor necessarily disclosed it as being part of his invention. An inventor cannot later claim methods as his invention that he did not disclose simply because those methods are necessary precursors to what the inventor did disclose.

For example, assume an inventor disclosed a method by which a human drives from point A to point B in a car. Even if the specification does not expressly say that the driver steps on the gas pedal of the car, the inventor might be able to claim that step because it is inherent in his disclosure of driving the car. In other words, the disclosure of driving a car constituted disclosure that stepping on the gas pedal was part of the invention because it must necessarily occur as part of driving the car.

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[76] Acacia mistakenly says *Tronzo* can be found at "948 F.2d at 1268." (Opp'n at 106:8.)

However, the inventor would not be entitled to claim a method that includes manufacturing the car, even though that is a necessary precursor to the disclosed method of driving the car. Manufacturing the car is not "inherent" in any actual disclosure in the specification as required by *Tronzo* as it was not described by the inventor as being part of the invention.

So it is with the Inputting Step. There is no step actually disclosed in the specification which necessarily includes the Inputting Step. The fact that the Inputting Step is allegedly a necessary precursor to the methods the inventors did disclose (Opp'n at 106:8-12) did not give them the right to claim it as if it was part of their invention. That is exactly what the written description requirement is designed to prevent.

For all of these reasons, the Inputting Step is not adequately described as a matter of law. As Defendants discussed in their motion papers, Acacia is judicially estopped from arguing otherwise, because it successfully argued that the Inputting Step is not described ***at all*** in convincing the Court to change its construction of the first "storing" step of claim 41 of the '992 patent. (Mot. at 46:16-48:2.) Acacia's response is that it never took the position that the specification does not describe inputting a physical object into the transmission system. Rather, it says, it "was only contending that the use of the two terms 'inputting' and 'storing' in the claims means that these terms should be construed so as to have different meanings . . . ." (Opp'n at 105 n.41.) Acacia's previous arguments speak for themselves: Defendants will simply quote some of the arguments it made and let the Court determine for itself whether Acacia was "only contending" that the Court should construe two different words to have different meanings:

> Construing "storing" to mean "placing" is . . . ***inconsistent with the specification***. (5/18/07 Acacia Br., docket no. 237, at 22:21-23 (emphasis added).)

> In fact, when describing and depicting an embodiment of the distribution method (claim 41 is a method claim) [and so are claims 17-19 of the '863 patent], the patentees state that the first step of the method "involves retrieving the information for selected items in the source material library 111" . . . . The patentees depicted this method in the flow chart of Figure 7, in which the first step shown is "retrieve information for selected items." ***In other words, according to the patent specification, the method does not begin with the placement of any item into the source material library***... (*Id.* at 23:1-6 (emphasis added).)

Counsel's statements at oral argument were similar:

> Mr. Dorman: If we go to figure 7, and if we go to figure 7 in the patent, which is beside figure 5, it starts "retrieve" at the very top. The first [step] is retrieving. ***So there's no discussion about how, how information gets placed into a source material library***.
>
> If we go to figure 2(a) that talks about, about the transmission system, look at the far left side of that. ***There's no arrow going into source material library. Source material library is where things start from***. This transmission system speaks of, of only things being maintained there that are retrieved from it. ***There's no arrow going in there***.
>
> * * *
>
> So this is a description of the transmission system that is, that is – ***all that is being disclosed isn't that, as how things are being stored or put in. It's just that they're there***. They're available. They're holding them.

(Benyacar Decl. Ex. J, docket no. 293-11, at 202:12-25; 203:12-16 (emphasis added).) Acacia was clearly doing more than "contending that the use of the two terms 'inputting' and 'storing' in the claims means that these terms should be construed so as to have different meanings . . . ."

Because Acacia was able to convince the Court to change its construction of the first "storing" step of claim 41 of the '992 patent based on its argument that the Inputting Step is not described in the specification, Acacia is judicially estopped from asserting a different position now with respect to different claims. (*See* Mot. at 46:16-48:2.)

For all of these reasons, claims 17-19 of the '863 patent are invalid because the specification does not adequately describe the Inputting Step. For the same reasons, those claims are not enabled. Moreover, for the reasons described in Section VII above, the specification does not contain an enabling disclosure of even a "transmission system" that can perform the functions actually ascribed to it in the specification. It cannot possibly contain an enabling disclosure of a "transmission system" that can perform additional functions, such as the Inputting Step, that are not described in the specification at all.

B. Claims 17-19 Of The '863 Patent Are Invalid Because The Specification Does Not Describe Or Enable "Assigning A Unique Identification Code To The Item Having Information"

According to the specification, the identification encoder assigns identification codes to the information retrieved from the physical objects stored in the source material library, not to the physical objects themselves. (*See* Mot. at 48:13-49:2.) Acacia does not dispute this – if it did, it would doom claim 41 of the '992 patent, which requires "assigning a unique identification code ***to the retrieved information***." (Col. 24:61-62 (emphasis added)). Therefore, claims 17-19 of the '863 patent, which require "assigning a unique identification code ***to the item having information***," ('863 patent, col. 22:42-43) (emphasis added)) lack written description. The specification does not describe assigning a unique identification code to physical objects.

Acacia has no relevant response. First, without explaining their relevance to its argument, Acacia recites passages from the specification that, like the passages recited in Defendants' motion papers, say that the identification code is assigned to the information (not to the physical object):

> (i) The "item" referred to in the passage ". . . the item must be stored in at least one compressed data library 118, and given a unique identification code by identification encoder 112" (Opp'n at 107:23-108:1 (citing col. 6:35-39)) must refer to the information, and not the physical object, since only information (and not videotapes, books and the like) is stored in the compressed data library; and
>
> (ii) The "items" referred to in the passage "[t]he items stored in source material library 111 and encoded by identification encoder 112 may be in either analog or digital form" (Opp'n at 108:3-4 (citing col. 6:62-64)) must also refer to the information (and not the physical object), because only information can be in "analog or digital form."

Not only do these excerpts not help Acacia, they further demonstrate that the specification does not describe the step of assigning an identification code to a physical object in claims 17-19 of the '863 patent.

Relying on Mr. Weiss's testimony,[77] Acacia then says that those skilled in the art were aware

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[77] Because Mr. Weiss's opinions are based on his incorrect understanding that "it is not required that techniques well known in the industry to which a patent applies be included

(continued...)

of techniques for assigning identification codes to physical objects. (Opp'n at 108:5-12.) Even if true, it is irrelevant. The step of assigning identification codes to physical objects is not described in the specification at all, much less as a step in a method of "distributing audio/video information (the preamble of claim 17)" or as performed by a "transmission system" as claims 17-19 require.[78] The fact that those skilled in the art might have known it is possible to perform steps in addition to those the inventor disclosed as being part of the invention does not somehow constitute disclosure of those steps, and it does not give the inventor the right to claim those steps as though they were part of his/her invention.[79] *See Lockwood*, 107 F.3d at 1572 (finding that a description that would render the claimed invention obvious is not sufficient to comply with the written description requirement).

Finally, for all these reasons, the step of "assigning a unique identification code to the item having information" is not enabled. Moreover, as explained in Section VII(B)(2) above, the identification encoder, which assigns identification codes (col. 2:30-34), is not enabled even to perform the function of assigning identification codes to information. It cannot possibly be enabled to perform the undisclosed function of assigning those codes to physical objects.

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77 (...continued) in the specification," his incorrect understanding that such common knowledge equates to "inheren[cy]," and his incorrect understanding that "possession" is the test for written description (Weiss Decl. ¶ 151), his opinion must be disregarded. *See supra* at Sections V and III(A).

78 The parties have stipulated that the step of "assigning a unique identification code to the item having information" is performed by the transmission system. (*See* Benyacar Decl. Ex. H, docket no. 293-9, at ¶ 6, quoted in full, *supra* at 121:3-11.)

79 Acacia's contention that dependent claims 18 and 19 of the '863 patent do not require that the identification code be applied to physical objects (Opp'n at 107 n.47), even though claim 17 from which they depend does, is baseless. A dependent claim cannot alter the claim from which it depends; it can only add limitations to it. *See Pfizer Inc. v. Ranbaxy Labs. Ltd.*, 457 F.3d 1284, 1291-92 (Fed. Cir. 1992). In fact, claims 18 and 19 do not attempt to change claim 17. Claim 18 says that the information in the physical item to which the identification code is assigned is "blocks of digital data," and claim 19 says that information is "an analog signal."

C. Claims 17-19 Of The '863 Patent Are Invalid Because The Specification Does Not Describe Or Enable A Receiving System That Is "Local" With Respect To A Subscriber Receiving Station

The Court construed "local distribution system" in claims 17-19 of the '863 patent to mean "a reception system . . . located geographically close to subscriber receiving stations which are coupled to the reception system." (4th CCO at 8:7-8.) As Defendants explained in their motion papers, the concept of the reception system being "geographically close" to subscriber receiving stations is not in the specification at all. (Mot. at 49:10-50:8.) Claims 17-19 are therefore invalid under § 112.

While Acacia's response is less than clear, it seems to suggest that because the Court construed "local" pursuant to its plain meaning, the written description requirement must of necessity be satisfied. (Opp'n at 108:24-109:12.) That is a *non-sequitur*. As Defendants recounted in their motion papers, the Court construed "local" pursuant to its plain meaning because "[t]he phrase 'local distribution system' is not used in the written description or the prosecution history." The Court had no intrinsic evidence to guide its construction. (Mot. at 49:18-21 (citing 4th CCO at 7:24-25).) It is precisely that failure of the inventors to disclose the concept of a "local distribution system" that constitutes a written description violation.

Acacia also seems to rely on the fact that the specification discloses "cable head ends," and that those skilled in the art would allegedly recognize that cable head ends are local to subscribers. (Opp'n at 109:13-26.) Assuming *arguendo* that is true, it is also of no help to Acacia. An inventor is not permitted to disclose a species and then later claim any genus into which the species falls. If an inventor wants to claim the genus, the applicable characteristics of the genus must be disclosed in the specification.

For example, if an inventor discloses writing with a pencil, he may be able to claim the genus of writing instruments, because the characteristics of that genus were disclosed. The inventor would not, however, be entitled to claim the genus of objects weighing less than five pounds or the genus of objects having a diameter of less than 20 inches, even though a pencil is a species of both of those genera, because the characteristics of those genera were not disclosed. *Purdue*, 230 F.3d at 1327 ("What the '360 patentees have done is to pick a characteristic possessed by two of their formulations, a characteristic that is not discussed even in passing in the disclosure, and then make it the basis of claims that cover not just those two formulations, but any formulation that has that characteristic. This is exactly the type of overreaching the written description requirement was designed to guard against.").

The inventors of the Yurt patents disclosed a cable head end, and later added claims covering all "local distribution systems," even though the attribute of locality is not disclosed in the specification at all. "This is exactly the type of overreaching the written description requirement was designed to guard against." *Id.*[80]

For these same reasons, "local distribution system" does not comply with the § 112 enablement requirement. Moreover, because a "local distribution system" is a "reception system," it is not enabled for the reasons described in Section VIII above. And, as if all these grounds for non-enablement were not enough, Mr. Weiss provides yet another.

The alleged example of a "local distribution system" disclosed in the specification is a reception system at a cable head end. (Opp'n at 109:15-16.) Claims 17-19 are directed to "using the stored compressed, ***digitized data*** to transmit" from the local distribution system "to at a plurality of subscriber receiving stations . . . ." ('863 patent, col. 22:35-38 (emphasis added)), a step which obviously covers sending digitized data. As Mr. Weiss testified, however, "[a]s of January 1991 . . . [t]here was not yet commercial development of digital distribution of television signals over cable systems, but the necessary equipment was in development." (Weiss Decl. ¶ 157.) The fact that the specification does not describe any of the technology necessary to distribute digital signals over cable systems, combined with the fact that the industry had not yet developed the necessary technology, conclusively demonstrates that the specification does not contain an enabling disclosure.

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[80] Because a "local distribution system" is a "reception system" (*see* 4th CCO at 8:1-2), it also lacks written description for the reasons described in Section VIII above.

Finally, "local distribution system" is indefinite, because there is no way to tell how close to the subscriber receiving stations the reception system has to be in order to be considered "geographically close." Tellingly, while Acacia argues that the Court effectively decided this issue already (which, for the reasons discussed above, it did not) and urges the Court not to consider it,[81] Acacia never actually explains how one would be able to determine whether or not a reception system is geographically close to a subscriber receiving station. That is because there is no way to know, and that is why "local distribution system" is indefinite.[82]

D. Claims 41 And 45-46 of the '992 Patent Are Invalid Because The Specification Neither Describes Nor Enables "Storing Items Having Information In A Source Material Library"

As Defendants recounted in their motion papers (Mot. at 50:8-51:4), "storing items having information in a source material library" was construed by the Court, at Acacia's urging, to mean the active step of "retaining." Such retaining "often includes retaining the media in an environment having controlled temperature and humidity – sometimes with robotic machinery to load and unload the media for reading when necessary. . . ." (5/18/07 Weiss Decl., docket no. 239, at ¶ 19.) The problem, of course, is that this "storing" step must be performed by a "transmission system" (col. 24:54-57), and as the Court has already determined, there is no component of a transmission system that is capable of performing this step. "[T]he only component discussed in the specification is the 'source material library itself.' However, the 'source material library'" cannot perform this function because it "is only described as containing a collection of items having information." (5th CCO at 17

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81 Acacia's position that Defendants were not permitted to raise this issue now should be rejected for the reasons discussed above at note 72.

82 To the extent Mr. Weiss is opining that a "local distribution system" is a reception system that is closer to the subscriber receiving station than the transmission system is to the subscriber receiving station (Weiss Decl. ¶ 154), that opinion must be disregarded, as it contradicts the Court's claim construction. "Closer to the subscriber receiving station than the transmission system" is not the plain meaning of "local" on which the Court relied when construing "local distribution system," and it is not a concept that is disclosed in the specification.

n.17.) Therefore, the claim step of "storing items having information in a source material library" does not comply with § 112.

Acacia's answer is that the specification says that the transmission system performs this function, and that alone is enough to comply with the written description requirement because the claims are not limited to "how" the transmission system performs this function. (Opp'n at 111:3-11.) As explained several times above, though, that is not the law. Section 112 required the inventors to provide the "detailed identity" of a "transmission system" that can perform the steps the claims require it to perform, even if the claims are not limited to that disclosed structure. *Rochester*, 358 F.3d at 923, 927 (goal of finding a COX-2 selective inhibitor insufficient disclosure; patent needed to disclose actual compound that performed this function); *Enzo*, 323 F.3d at 968. The failure to describe a transmission system that can perform the function of "storing items having information in a source material library" constitutes the absence of a legally sufficient description. *See supra* at Section III(A).

For these same reasons, the step of "storing items having information in a source material library" is not enabled. While Acacia responds by relying on Mr. Weiss's testimony regarding the "source material library" (Opp'n at 111:12-17 (citing Weiss Decl. ¶¶ 58-64)), the source material library is not enabled for the reasons explained in Section VII(A)(2) above.[83]

E. Claims 41 And 45-46 of the '992 Patent Are Invalid Because The Specification Neither Describes Nor Enables "Retrieving The Information In The Items From The Source Material Library"

For the reasons described in Defendants' motion papers (Mot. at 51:5-52:16) and in Section VII(A)(1)(b) above, the specification does not adequately describe the step of "retrieving the information in the items from the source material library." Other than the statement that this function is performed by the inadequately-described and indefinite "identification encoder" (col. 2:31-33), the specification provides no information about this step at all.

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[83] Acacia contends that "in discussing the possibility of a motion on this step" in the 5th CCO, the Court "did not discuss an enablement motion." (Opp'n at 111:12-13.) In fact, however, the Court did discuss an enablement motion in the very sentence from that Order relied on by Acacia. (*See* 5th CCO at 17:5-6 ("The Court leaves ***enablement*** or definiteness for consideration later if a motion addressing the issue is brought before the Court.") (emphasis added).)

Acacia first says that the bare statement in the specification and an originally filed claim that the identification encoder performs the "retrieving" function is alone enough to comply with the written description requirement. (Opp'n at 111:24-112:12.) Of course, that is untrue. As explained in Sections III(A) and (C) above, § 112 required disclosure of the "detailed identity" of what the transmission system (and particularly the identification encoder) that performs this function ***is***. Just disclosing that the inventors wished they had a device to perform this function is not enough, and the fact that the inadequate description appeared in the specification and an originally filed claim does not excuse the failure to comply with § 112. *Enzo*, 323 F.3d at 968-69.

Next, Acacia relies on Mr. Weiss's opinion that the "source material library" would have been implemented using the "latest available equipment," including the digital telecine "that depended on an operator to load and thread ('lace') the film onto the projection portion of the system and to similarly load other sorts of devices for other types of media." (Weiss Decl. ¶ 148 (relied on by Acacia, Opp'n at 113:1-5).) As explained in more detail in Section VII(A)(1) above, this opinion contradicts both the specification and the Court's claim constructions for a number of independent reasons. For example: (i) the "source material library" does not include the "latest available equipment" – according to the specification and as construed by the Court, it is merely a "a collection of original sources of information" (1st CCO at 25:15-16); (ii) according to the specification, and as Acacia has previously conceded, the telecine is ***not*** in the "source material library" (col. 7:35-43; Benyacar Reply Decl. Ex. A (9/7/06 Hr'g Tr.) at 162-166); (iii) humans are not part of the "transmission system" pursuant to the Court's construction (6th CCO at 11:13-22), and cannot constitute part of a claimed device; and (iv) the specification does not disclose a human performing any claimed function of the transmission system, including the "retrieving" function. For all of these reasons, Mr. Weiss's opinion should be disregarded.

As Defendants asserted in their motion papers, the specification cannot possibly contain an adequate written description of a "transmission system" that performs the "retrieving" function. That function is ascribed to the "identification encoder" in the specification, and the Court has already found "identification encoder" to be indefinite because, *inter alia*, it is not adequately described. (Mot. at 51:14-20.) Acacia's response to that is, if nothing else, interesting. While Acacia itself cites the excerpt from the specification which ascribes the "retrieving" function to the "identification encoding means" (Opp'n at 111:27-112:2), it says that the Court did not list "retrieving" as one of the functions of the identification encoder in the 2nd CCO, and thereby suggests that the Court intended to judicially rewrite the specification. (Opp'n at 113:13-22.) Defendants suspect the Court had no such intention, particularly in view of the fact that the Court said the functions it was listing were "among others" performed by the identification encoder (2nd CCO at 15:13-15), and the fact that the Court had previously recognized that it is the "identification encoder" that must perform the retrieving function (1st CCO at 12:19-22, 13:2-6.) Defendants assume that if the Court's intention was to judicially rewrite the specification, it would not have done so *sub silentio*.

Not only does the specification not describe an identification encoder that can perform the "retrieving" step, it does not even describe a component of a transmission system that can trigger the start of this retrieval. As the specification excerpt relied on by Acacia discloses, "retrieving the information for selected items in the source material library 111 [occurs] upon a request by a user. . . ." (Col. 18:53-56 (cited by Acacia, Opp'n at 112:4-6)). For the reasons described in Section VII(A)(1)(b) above, however, no mechanism of the "transmission system" is disclosed that can process user requests for items in the "source material library" and use those requests to trigger retrieval. While Acacia responds that claim 41 of the '992 patent does not require user requests, that response is irrelevant. Section 112 required the inventors to provide the "detailed identity" of a "transmission system" that can perform the claimed "retrieving" function, which includes the manner in which retrieval is initiated. According to the specification, retrieval is initiated upon a user request for an item in the "source material library." Because the inventors did not describe a transmission system that can process user requests to the "source material library," they did not, for that independent reason, adequately describe a transmission system that can perform the "retrieving" function.

Finally, there is yet another independent reason why the "retrieving" step is not adequately described. As Defendants explained in their motion papers (Mot. at 52:5-13), claim 41 of the '992 patent requires that information be retrieved from a plurality of physical "item**s**" (col. 24:59-60), and that the information retrieved from those item**s** be treated as a single unit (assigning a single identification code to it, compressing it as a unit, storing it in a single file, etc.). However, the specification does not describe such a process. Acacia responds by saying that the specification only describes assigning an identification code to information retrieved from a single physical item. (Opp'n at 114:8-17.) That response proves Defendants' case, as it conclusively demonstrates that the specification does not adequately describe the claimed method step whereby information retrieved from a plurality of physical "item**s**" is assigned a single identification code.

Acacia also relies on the Court's construction of apparatus claim 1 of the '992 patent as support for its position that the Court has judicially rewritten method claim 41 to change "item***s***" to "item." (Opp'n at 114:3-7.) In the 1st CCO on which Acacia relies, however, the Court was not addressing the issue of whether the identification code was assigned to information from only one physical object or from multiple physical objects, because that issue was not presented to the Court by the parties. The Court was deciding only what "unique identification code" meant. (*See* 1st CCO at 14:14-17.) Again, if the Court's intention was to judicially rewrite the claims of the '992 patent to address issues that were not even before the Court, Defendants assume it would not have done so *sub silentio*.

For all of these reasons, the claimed step of "retrieving the information in the items from the source material library" is not adequately described in the specification. For these same reasons, and for the reasons described in Sections VII(A) and (B) above with respect to the "source material library" and the "identification encoder" (both of which are involved in the step of "retrieving"), the specification does not contain an enabling disclosure of this step either.

F. Claim 46 Of The '992 Patent Is Invalid Because The Specification Neither Describes Nor Enables "Generating A Listing of Available Items"

Claim 46 of the '992 patent requires that the "transmission system" perform the step of "generating a listing of available items." (Col. 25:25-28). The specification, however, does not describe the performance of this step at all, much less as performed by a transmission system.

In response, Acacia cites to numerous passages from the specification, but none of them teaches this step. For example, the passage at col. 12:10-21 (Opp'n at 115:1-5) describes searches users perform on the "remote order processing and item database 300," ***not the transmission system***. The sentence immediately preceding the passage relied on by Acacia says, "[p]referably, access of a requested item ***via the remote order processing and item database 300*** operates as follows" (col. 12:8-10), and the text quoted by Acacia itself confirms this. (Op. at 115:3-4 ("'The remote order processing and item database 300 would then be searched . . . .'") (quoting col. 12:15-17).) As can be seen in Fig. 1c, the "remote order processing and item database 300" is separate from, not part of, the transmission system. It is only after the user selects the desired information that the "remote order processing and item database 300" sends that user request to the transmission system. (Col. 12:21-24). This passage does not describe any functions performed by the transmission system, and therefore cannot be support for the "generating" step of claim 46.

Moreover, this passage does not teach generation of a list of the "available items" at all. It presumes that such a list already exists such that the user can search that list using search criteria in order to identify "matching items."[84] The same is true of the specification excerpt at col. 15:3-22 relied on by Acacia (Opp'n at 115:7-15) – The "database of available titles" already exists from which the user selects the "desired item." (Col. 15:5-10, 20; Opp'n at 115:11-14.)

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[84] To the extent Acacia is suggesting that the search results themselves are the "available items," it is mistaken. The "available items" refers to all the items the user has the option of selecting. As Mr. Weiss says, the "available items" is the "copy of the database that listed the items available through the system . . . ." (Weiss Decl. ¶ 159.) This list is generated either after the items that can be requested exist in the database, or after it is known what items will be stored in the database. (5/18/07 Weiss Decl., docket no. 239, at ¶¶ 27-28.)

Finally, Acacia relies on the fact that the specification says the "item database master" can be updated. (Opp'n at 115:16-17.) The cited passage is actually indecipherable: "The item database master may reside in the system controller computer 1123 ***where may be is*** updated . . . ." (Col. 11:54-55). However, even assuming that this does mean that the item database master is updated, that is still not a description of generating a "listing of available items." At best, the quoted passage would describe updating an existing list. And in all events, that "updating" is not performed by the transmission system, so it cannot possibly support the claim 46 "generating" step, which must be performed by a transmission system.

For all of these reasons, the specification does not adequately describe a transmission system performing the step of "generating a listing of available items."[85] For these same reasons, the specification does not contain an enabling disclosure of this step.

XI. EACH ASSERTED CLAIM IS INVALID FOR INDEFINITENESS

The parties agree that all of the asserted claims are indefinite based on one or more of the Court's constructions of "transmission system," "identification encoder" and "sequence encoder," as well as Acacia's stipulation that the asserted claims are indefinite based on these constructions. (Mot. at 54:1-24; Opp'n at 119:6-16.) The remainder of this Section XI will therefore be directed solely to other reasons why the asserted claims are indefinite.

A. Claims 17-19 Of The '863 Patent Are Indefinite Because The Step Of Transmitting "To At A Plurality of Receiving Systems" Is Indefinite

As Defendants explained in their motion papers (Mot. at 54:24-57:3), claim 17 of the '863 patent includes the step of transmitting "***to at*** a plurality of subscriber receiving stations . . . ." ('863 patent, col. 22:35-38). There is no dispute that this phrase, with the two prepositions "to" and "at" right next to each other, was mistakenly written. As Acacia's counsel stated, "It's clearly a mistake and it wasn't intended . . . ." (Benyacar Decl. Ex. I, docket no. 293-10, at 93:20-21.)

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[85] The absence of any disclosure regarding this "generating" step or how it relates to the methods set forth in the specification is presumably what led the Court to ask for guidance as to when exactly this "generating step" would occur. (3rd CCO at 33:12-21.) Because the step is not described in the specification, there is no way to tell.

The problem is, there is no way to know what ***was*** intended. The applicants could have meant either

> (i) "to at least one of a plurality. . ." (the way claim 14 of the '863 patent is written), such that they mistakenly omitted the words "least one of." If this is how the claim had been written, it would have been broad enough to cover transmitting to one and only one subscriber receiving station.

OR

> (ii) "to ~~at~~ a plurality . . .", such that they mistakenly added the word "at." If this is how the claim had been written, it would have required transmitting to at least two subscriber receiving stations – unlike option (i) above, it would not cover sending to only one such receiving station.

Acacia's counsel admitted that both of these options are "equally plausible," that both are supported by the specification, that the specification provides no guidance as to which option was intended and that, indeed, the claim has a different meaning based on which option is selected. (*See* Mot. at 55:3-56:2.) The "to at" limitation therefore renders claim 17 of the '863 patent, and claims 18 and 19 which depend from it, indefinite.

Other than the legal conclusion that the "to at" limitation renders the claims indefinite, Acacia does not dispute any of the above. Instead, it says the Court should not try to correct the claim at all (which would be impossible to do, because there is no way to know what was intended), but should instead construe the claim as it was mistakenly written. While Acacia accuses Defendants of misrepresenting its position in this regard, that was not their intention. In view of the Court's expression of disbelief when Acacia said this at oral argument (as recounted in Defendants' motion papers, Mot. at 56 n.38), Defendants are just surprised that Acacia is continuing to press this position.

The Court should reject Acacia's approach for a number of reasons. First and foremost, it is not really asking the Court to construe the claim as it is actually written, because as written it is gibberish. Instead, it asks the Court to take Mr. Weiss on his word that those skilled in the art would understand the "to at" limitation to mean what Acacia says it should mean. (Opp'n at 120:7-11; Weiss Decl. ¶ 172.) However, Mr. Weiss's opinion in this regard is entitled to no weight. All he does is state a bare conclusion that those skilled in the art would understand "to at a plurality" to mean "to a plurality." (Weiss Decl. ¶ 172.) Mr. Weiss thus selects "equally plausible" option (ii) above with no explanation whatsoever as to why those skilled in the art would not select the other "equally plausible" option.[86]

Even if Acacia really was asking the Court to construe the claims as mistakenly written, the Court would have to reject that approach, just as the Federal Circuit has done. In *Novo Indus., L.P. v. Micro Molds Corp.*, for example, the district court picked one of several possible corrections for a mistakenly written claim and noted that the selected correction still worked even if "one ignores that error" and construes the claim as mistakenly written. 350 F.3d 1348, 1353 (Fed. Cir. 2003). The Federal Circuit reversed, and held that the claim was indefinite because "the nature of the error is not apparent from the face of the patent." *Id.* at 1357.

As all parties admit, the "nature of the error" with the "to at" limitation "is not apparent from the face of the patent" either. Claim 17 of the '863 patent, and claims 18-19 which depend from it, are therefore indefinite.

B. Claims 41 And 45-46 Of The '992 Patent Are Indefinite Because The Claimed Steps Can Never Be Completed

As Defendants recounted in their motion papers (Mot. at 57:9-17), the Court held that each step of claim 41 of the '992 patent "must commence before the succeeding step commences, *and the antecedent step must finish before the succeeding step can finish.*" (3rd CCO at 29:17-26.) Because the step of "storing items having information in a source material library" is the first step of claim

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[86] Curiously, while Mr. Weiss does not rely on this in forming his opinion, he notes that the words "to" and "at" ***are*** used together in one place in the specification, in the context of sending "***to at least one*** remote location." (Weiss Decl. ¶ 171.) Still, he chose not to select "equally plausible" option (i) above.

41, that step must be completed before any other step of claim 41 can be completed.

The Court also originally construed this storing step (at Acacia's request) to mean "placing physical items . . . into" the "source material library" (3rd CCO at 30:20-25), a discrete act that has a discrete beginning and a discrete end. The sequence of the steps worked fine. Obviously, the step of placing a physical item containing information into the "source material library" must be completed before the transmission system can do anything to the physical item or the information therein.

At some point, though, Acacia realized that there was no written description support for the step of placing physical items into the source material library. It therefore moved for reconsideration, and asked the Court to change its construction of "storing" from "placing physical items . . . into" the "source material library" to "retaining physical items." (5/18/07 Acacia Br., docket no. 237, at 20:16-23.) Defendants opposed Acacia's reconsideration request on the grounds that, *inter alia*, "retaining" is not an active method step disclosed as having a discrete beginning and end. (7/18/07 Round 3 Defs.' Opp'n to Pl.'s Mot. for Recons., docket no. 246, at 34:1-36:2.) However, because there was no written description support for "placing into," the Court changed its construction as Acacia asked. (5th CCO at 15:1-17:9.)

This new construction of "storing" creates other problems with the claims, however. One of these problems is that the steps of claim 41 (and its dependents) can never be completed, because the "retaining" step does not get completed before the other steps of the claims are completed. The specification does not disclose a method whereby a physical item "retained" in the "source material library" is removed before the succeeding claim 41 step of "retrieving the information in the items from the source material library" is completed.

Acacia's answer is that the specification says the "source material library" is "for temporary storage of items ***prior to conversion and storage in a compressed data library means***." (Opp'n at 122:11-16 (citing col. 5:66-6:7) (emphasis added).) This does not constitute disclosure of a method having a discrete step of removing the physical item from the "source material library." Even if it did constitute such disclosure, however, it teaches that the physical item must remain in the "source material library" until the information retrieved therefrom is compressed and stored in the compressed data library. Under no circumstances can it support the claim 41 requirement that the physical item be removed from the "source material library" before the step of "retrieving the information in the items from the source material library" is completed.[87]

In sum, the specification does not teach a step of removing the physical item from the "source material library" at all, much less before the step of "retrieving" is completed as required by claims 41 and 45-46 of the '992 patent. However, to the extent the specification teaches anything at all, it is that the physical item must remain in the "source material library" at least until the information in that item is compressed and stored in the compressed data library. Thus, even reading the specification in such a way as to give Acacia the benefit of every doubt, claims 41 and 45-46 are still indefinite because the steps of those claims cannot be completed:

> (i) the claim 41 step of "retrieving the information in the items from the source material library" cannot be completed until the antecedent step of "storing" is completed; BUT
>
> (ii) according to the specification, the "storing" step cannot be completed until the "retrieving" step is completed and the retrieved information is processed and stored in the compressed data library.[88]

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[87] Acacia relies on Mr. Weiss's declaration for its contention that "once the information is retrieved, there would be no further need for the source material to be retained" (Opp'n at 122:27-123:1.) For the reasons described above, that contradicts the specification. Moreover, Mr. Weiss says two contradictory things – he first says that "once the data representing an item had been removed from the Source Material Library, processed, ***and stored in the Compressed Data Library***, there would be no further need in the Source Material Library for the source material from which the data representing the item was retrieved" (Weiss Decl. ¶ 174), and in the very same paragraph says that the "storing" step is finished "when the process of retrieving the data representing the item has been completed, as there would be no further need for the source material." (*Id.*) As a threshold matter, only opinions consistent with the specification can be considered. *See supra* at Section V. Moreover, claim 41 would still be indefinite under his latter contention, because claim 41 requires that the storing step be completed ***before*** the "retrieving" step is completed, not after that step has "been completed."

[88] If Acacia later were to argue successfully that the Court already determined that claim 41 is definite because, in effect, it already construed the claim to require removal of the physical item from the "source material library" before the "retrieving" step is completed,

(continued...)

C. The '992 Claim 45 Step Of "Separately Storing A Plurality Of Files" Renders Claims 45-46 Indefinite[89]

As Acacia correctly says, "[c]laim 45 of the '992 patent adds the step of 'separately ***storing a plurality of files***, each including compressed, sequenced data blocks' to the claim 41 step of '***storing, as a file***, the compressed, formatted and sequenced data blocks' . . . ." (Opp'n at 123:6-8 (emphasis added).) For reasons Defendants have previously explained (8/14/06 Round 3 Defs.' Resp. to Acacia's Post-Hearing Mem. Regarding '992 Patent Claims 45 and 46, docket no. 200, at 2:8-5:8), the information stored in the claim 45 "storing" step must be the same information referenced in the claim 41 "storing" step – the information that was retrieved from items in a source material library, coded, formatted, sequenced and compressed in accordance with the steps of claim 41. Because claim 45 improperly attempts to ***alter*** the claim 41 "storing" step from storing the information "as a [one] file" to storing "a plurality of files," it is invalid. Dependent claims can only add limitations to independent claims; they cannot ***change*** the independent claims. *Pfizer*, 457 F.3d at 1291-92. Defendants will not repeat those arguments here.

Instead, Defendants will focus here on Acacia's argument in its opposition that claim 45 does not alter claim 41 because the information stored by the claim 45 "storing" step is different information than the information stored in the claim 41 "storing" step. (Opp'n at 124:14-125:2.) According to Acacia, the information stored by the claim 45 storing step was not processed by the "transmission system" at all, even though the information is being stored in the compressed data library of the transmission system. (Weiss Decl. ¶ 176 (stating that the information stored in claim 45 "presumably came through another processing path").) In other words, because the steps of

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[88] (...continued) then claims 41 and 45-46 are invalid for failure to comply with the written description requirement. That method is not described or suggested in the specification.

[89] The Court previously held that claim 45 was "arguably indefinite" because "of the fact that there is no description of storage in multiple files . . . ." (3rd CCO at 33:9-12.) However, the Court declined to formally rule on the matter because no formal § 112 motion had been made. (5th CCO at 17:16-18.) Now, such a motion has been made.

claim 41 must occur in sequence (3^{rd} CCO at 29:17-26), Acacia says that claim 45 is directed to the following method steps performed in sequence:

1) storing items having information in a source material library;

2) retrieving the information in the items from the source material library;

3) assigning a unique identification code to the retrieved information;

4) placing the retrieved information into a predetermined format as formatted data;

5) placing the formatted data into a sequence of addressable data blocks;

6) compressing the formatted and sequenced data blocks;

7) storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code ***AND separately storing different compressed, sequenced (but not formatted) information from a different, unknown source in a plurality of files***; AND

8) sending at least a portion of ***the file*** to one of the remote locations.

(*See* Opp'n at 124:20-125:2.) There is no such method disclosed in the specification. The specification does not describe a method whereby information is processed by all of the transmission system components 111-117 in sequence, and at the very moment the information is to be stored in the compressed data library, different information from an unknown source, not processed by the transmission system, suddenly enters the transmission system and is stored in the compressed data library.[90] Thus, if Acacia is correct and claim 45 is in fact directed to the above method, that claim, and claim 46 which depends from it, are invalid for failure to comply with the written description requirement.

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[90] Contrary to Acacia's contention (Opp'n at 124:3-13.), apparatus claim 6 of the '992 patent certainly does not support this method. All that claim says is that there is a compressed data library that is capable of storing a plurality of files. (Col. 21:13-18). It does not describe a method where files from an unknown source are stored in the compressed data library at the very same time that the information processed by the transmission system is stored in the compressed data library. In indiscriminately trying to convert apparatus claim 6 into a method claim, the applicants recited an insolubly ambiguous method that is not described in the specification. As the Court already held, the claim 6 "attribute of being capable of storing a plurality of files does not lend itself to conversion to a manipulative step." (3^{rd} CCO at 33 n.12.)

In addition, if the information stored by claim 45 is not the information processed by the transmission system in the preceding steps of claim 41, then there is no requirement that the information stored by claim 45 be information that has been processed by a transmission system at all. Indeed, claim 45 requires only that the information be "compressed" and "sequenced" (col. 25:44), whereas the information referenced in the claim 41 storing step is "compressed, ***formatted***, and sequenced" (col. 25:1). There is no description in the specification of storing information in the compressed data library that was not processed by any transmission system. Under Acacia's reading, claims 45-46 would be invalid for this additional reason.

Finally, claims 45-46 would be also be indefinite because step (8) of the Acacia method set forth above requires sending a portion of "***the*** [one] file" to one remote location, but step (7) requires storing many files. There is no way to know which of the files stored in step (7) is to be sent to the remote location in step (8).

D. Claim 46 Is Indefinite Because There Is No Way To Know Which One File Is Sent By The Transmission System In Response To Claim 46's Multiple User Requests

As Defendants explained in their motion papers (Mot. at 58:3-10), in addition to all the other reasons dependent claim 46 is invalid under § 112, it is also indefinite because it calls for retrieving data blocks corresponding to "request***s*** from user***s***" (col. 25:31-32 (emphasis added)), but claim 41, from which 46 indirectly depends, calls for sending "a portion of the [one] file" to "one" remote location (col. 25:4-5 (emphasis added)). It is impossible to determine how the data blocks retrieved by claim 46 in response to a plurality of user requests from a plurality of users relates to the single file that is sent to the single "remote location" in claim 41. How, and why, is one file sent to one remote location (claim 41) in response to a plurality of requests from a plurality of users (claim 46)? Acacia's response does not answer any of these questions – instead, it parses the meaning of claim 46 but ignores its relationship to claim 41. (Opp'n at 125:12-24.)

Indeed, Acacia's reading of claim 46 to mean that "'stored formatted data blocks containing the particular content requested by ***users*** [plural] *were to be retrieved* from the ***files*** [plural] containing the requested items or parts thereof.'" (Opp'n at 125:22-24 (quoting Weiss Decl. ¶ 181) (emphasis added)) contradicts claim 41. Claim 41 requires "sending at least a portion of ***the*** [one] file" to only ***one*** remote location. (Col. 25:4-5 (emphasis added)). If Acacia is correct that claim 46 is altering the requirements of claim 41 that ***one*** file be sent to ***one*** remote location, then claim 46 is invalid because dependent claims cannot alter the claims from which they depend. *Pfizer,* 457 F.3d at 1291-92. In addition, "were to be retrieved" is not a step of a method; if the claim were actually written that way, it would be invalid for a number of additional reasons under 35 U.S.C. §§ 101, 112, etc.

CONCLUSION

For the reasons set forth above and in Defendants' motion papers, it is respectfully requested that the Court grant summary judgment to Defendants declaring and adjudging all of the asserted claims to be invalid under 35 U.S.C. § 112 for each and every one of the separately articulated reasons identified.

Respectfully submitted,

Dated: April 3, 2009

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ECF CERTIFICATION

Pursuant to General Order No. 45, § X.B., the filing attorney attests that he has obtained concurrence regarding the filing of this document from the other signatory to the document.